

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

GILBERT P. HYATT,
Plaintiff,

v.

UNITED STATES PATENT AND
TRADEMARK OFFICE, et al.,
Defendants.

Case No. 1:18-cv-00546-TSE-MSN

**Plaintiff's Response in Opposition
to Defendants' Motion To Dismiss**

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- Count VIII.Injunctive Relief for the ’263 Application
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Introduction

On August 1, the United States District Court for the District of Columbia issued a decision finding that three of Plaintiff Gilbert Hyatt's patent applications contained patentable subject matter and therefore ordering the U.S. Patent and Trademark Office to issue Mr. Hyatt three patents, with more than 80 claims, to which he was entitled under law. The only material difference between those three applications and his hundreds of similar, contemporaneously-filed applications languishing before the PTO is that Mr. Hyatt was able to obtain a fair and impartial review on the merits of those applications. The PTO, meanwhile, declared in that same litigation that it intends to reject every single one of his pending applications, and its ongoing actions are actually far worse than that: rather than simply reject his applications, and allow Mr. Hyatt to obtain judicial review on their merits, the agency has put them into administrative purgatory from which it intends no escape—ever. Its “Hyatt Unit,” a team of examiners with the mission of blocking Mr. Hyatt's applications from issuance or even final action that might lead to issuance, has contrived a series of Hyatt-specific policies designed to bury Mr. Hyatt's applications in endless administrative proceedings and frustrate any progress. The PTO's plan for resolving Mr. Hyatt's applications is for Mr. Hyatt, who is 80, to die. Mr. Hyatt learned these things as a result of discovery into PTO's treatment of his applications authorized by the D.C. District Court.

Mr. Hyatt did not bring this suit to challenge the PTO's undue delay. He is challenging the PTO's decision that it will never issue him another patent, no matter the merit of his applications and his entitlement under law, and its action to withhold the lawful examination of his applications' merit and the issuance of patents to which he is entitled by law. Mr. Hyatt has a clear right to issuance of patents on his meritorious claims or, at a minimum, to fair, neutral, and timely examination of those claims in accordance with the Patent Act and the Due Process Clause. The PTO has a clear duty to issue him patents to which he is entitled. And this Court has the authority to order the PTO to carry out those obligations. That is the primary relief that Mr. Hyatt seeks in this action, and the PTO's Motion To Dismiss (“MTD”) has almost nothing to say about it, instead

mischaracterizing his claims as run-of-the-mill challenges to unreasonable agency delay.

Mr. Hyatt also seeks more specific relief. In carrying out its unlawful decision to deny Mr. Hyatt's rights, the PTO imposed millions of dollars in fees on Mr. Hyatt. Although Mr. Hyatt cannot obtain compensation for the wrongs that the PTO has done to him, or for the millions in professional expenses that it wrongfully forced him to incur, he is entitled as specific relief to a refund of the fees that it unlawfully collected, and the Administrative Procedure Act authorizes that limited relief. He also seeks compensation under the Takings Clause for two applications that the PTO unlawfully bottled up for decades until there was no potential patent term remaining. And he asks the Court to compel the issuance of claims in another application that have been, following complete examination and an administrative appeal, in a position for issuance since 2003 and on which the PTO refused to take any action since then until Mr. Hyatt filed this suit. Mr. Hyatt is entitled to these limited remedies, and the Court has the authority to order them.

Background

A. The PTO Makes a Decision Never To Issue Another Patent To Mr. Hyatt

Plaintiff Gilbert P. Hyatt is an accomplished engineer, scientist, and inventor, with nearly 75 patents to his name that cover technology from computer memory architecture to sound and speech processing. Compl. ¶¶ 9, 14. Mr. Hyatt also is the owner and inventor of nearly 400 other patent applications currently pending before the PTO, many of which the PTO has recently forced into abandonment status. Compl. ¶ 15. His applications have been pending before the agency for decades, in some cases for over 40 years. Compl. ¶ 15.

In the mid-1990s, then-PTO Commissioner Bruce Lehman took aim at so-called "submarine patents," which are those with early filing dates covering technology that was widely adopted at the time of issuance. Compl. ¶¶ 16, 27. Commissioner Lehman testified before Congress that these so-called submarine patents were "pure and simple, an extortion game," and directed the PTO to put a stop to them. Compl. ¶¶ 16, 28. On the false notion that Mr. Hyatt was a "submariner," the PTO determined not to issue any more patents to Mr. Hyatt. Compl. ¶¶ 17–18. It has carried out that mandate over the past two decades through a series of approaches, beginning

with delay and more recently acting to mire Mr. Hyatt's application in administrative purgatory.

The PTO's end game, according to former PTO personnel, is for Mr. Hyatt to either give up or die. Compl. ¶¶ 22–25. To that end, the PTO has established a special Art Unit, which PTO personnel refer to as the “Hyatt Unit,” to devise and implement specialized policies the PTO applies only against Mr. Hyatt so as to bury him in pointless administrative proceedings and ultimately block final agency action on Mr. Hyatt's applications that would be subject to judicial review. Compl. ¶¶ 21, 228–370 (detailing operations of the Hyatt Unit). As a result, Mr. Hyatt has no possibility of receiving the timely, fair, and impartial consideration of his applications to which he is entitled by law. Compl. ¶¶ 293–95.

1. The PTO Delays Examination of Mr. Hyatt's Applications

The PTO has executed its campaign of preventing the issuance of any patents to Mr. Hyatt in several different ways over the decades. Through approximately 2013, the PTO's primary tactic was delay. Compl. ¶ 20. The Supervisory Patent Examiner who purportedly supervised the examination of Mr. Hyatt's applications described them as being “on hold.” Compl. ¶¶ 162–91. To help put the applications “on hold,” the PTO secretly assigned Mr. Hyatt's patent applications to so-called “Phantom Art Units,” which placed them outside the PTO's procedurally regular mechanisms for ensuring that examination proceeded in a procedurally regular manner. Compl. ¶¶ 152–67. The PTO also secretly assigned Mr. Hyatt's patent applications to management personnel who do not examine applications so as to remove them from the dockets of examiners, who are generally required to act on applications in a timely fashion. Compl. ¶¶ 180–86. In some instances, the PTO formally suspended examination of Mr. Hyatt's applications, issuing approximately 2,200 6-month suspensions. Compl. ¶¶ 172–77. And in other instances, the PTO simply took no action to advance examination of Mr. Hyatt's applications for years at a time, without issuing a suspension. Compl. ¶ 178–79. During this period of delay, the PTO assigned nearly 100 of Mr. Hyatt's applications to a single examiner in addition to his normal workload, leaving him to examine those applications in his personal time without additional pay. Compl. ¶¶ 192–97; Case No. 09-1872, Trial Tr. at 60:8–15 (D.D.C. Oct. 6, 2017 AM Session).

Nor could a patent examiner actually cause the issuance of Mr. Hyatt's applications as patents, because they were all subject to the secret "Sensitive Application Warning System" program, or "SAWS." Compl. ¶¶ 99–129. In the words of one examiner, "the powers to [sic] be" would not allow the issuance of a Hyatt patent. Compl. ¶¶ 88–93. When an application reached the Board of Patent Appeals and Interferences,¹ the PTO engaged in *ex parte* communications with the Board to notify it that Mr. Hyatt's applications were blocked from issuance, Compl. ¶¶ 107, 119–21. After seeing that Mr. Hyatt was exercising his right to obtain district court review of Board decisions, the PTO stopped filing Examiner's Answers in his appeals and thereby prevented them from proceeding, putting 80 appeals in a state of limbo that the D.C. District Court called "never never land." Compl. ¶¶ 130–41. Prior to that, when the PTO had participated in the administrative appeal process and Mr. Hyatt prevailed, the PTO had a policy of "recycling" the applications by resuming prosecution rather than issue them, according to a senior PTO official. Compl. ¶¶ 130–49. And in four cases where Mr. Hyatt's patent applications slipped through cracks of the PTO's policy and were issued by examiners who found that Mr. Hyatt was entitled to a patent, the PTO withdrew them from issuance under suspicious circumstances that involved the direct participation of the PTO Director and Commissioner of Patents. Compl. ¶¶ 65–87.

Throughout this period, Mr. Hyatt attempted to counter the PTO's strategy of delay by filing over one thousand petitions for action on his application and requests for status updates. Compl. ¶ 202. In most instances, the PTO dismissed those petitions on grounds that Mr. Hyatt's applications were already "special" and therefore entitled to expedition under PTO policy, and falsely represented that examiners would be instructed that they were "appropriate for expedited action." Compl. ¶ 204.

2. The PTO Establishes the "Hyatt Unit" To Prevent Issuance of Any Patents to Mr. Hyatt

After many years of delay, in 2012 the PTO changed tactics and reconstituted Art Unit 2615 as what it internally calls the "Hyatt Unit," a group of approximately a dozen patent

¹ Since succeeded by the Patent Trial and Appeal Board. Both are referred to herein as the "Board."

responded, and the examiners let the cases sit.” Compl. ¶¶ 268, 310. The Hyatt Unit’s lack of productivity forced high-level PTO Officials to remove Mr. Hyatt’s applications from PTO performance metrics, [REDACTED]. Compl. ¶¶ 308, 310–31. [REDACTED]

[REDACTED]

[REDACTED] Compl. ¶¶ 313–14.

3. PTO Officials’ Displays of Personal Bias Against Mr. Hyatt Reflect the Agency’s Bad Faith Towards Him

The PTO’s bad faith examination of Mr. Hyatt’s patent applications is further evidenced by the bias that its officials regularly display against him. For example, Richard Hjerpe, the supervisory patent examiner then charged with overseeing examination of all Mr. Hyatt’s patent applications, openly mocked Mr. Hyatt to high-level PTO management personnel who he believed shared his disdain for Mr. Hyatt. Compl. ¶¶ 53–56. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Compl. ¶ 63. One Hyatt Unit examiner circulated decades-old news articles about Mr. Hyatt’s divorce to the entire Hyatt Unit, including its manager, Mr. Morse, on the PTO computer system during business hours. Compl. ¶ 58. Hyatt Unit examiners also exchange emails disparaging Mr. Hyatt. Compl. ¶ 60. And officials from the PTO Director in the mid-1990s, to the patent examiners signing office actions in the Hyatt Unit, have regularly disparaged Mr. Hyatt by labeling him a “submariner”—and when one’s profession is inventing, as is Mr. Hyatt’s, this is tantamount to defamation in his profession. Compl. ¶¶ 27–52.³

4. In Litigation, Mr. Hyatt Learns, and PTO Confirms, that the Agency Has Determined Not To Issue Him Another Patent

Before the PTO acted to bottle up Mr. Hyatt’s applications in the agency by blocking his

³ Based on post-filing investigation, Mr. Hyatt has reason to believe that the Hyatt Unit examiners regularly disparage him in other ways and could, if necessary, make additional allegations detailing that disparagement.

administrative appeals, several applications were rejected and made it to federal court under 35 U.S.C. § 145 after a final decision by the Board. Three were at issue in a series of cases (the “Section 145 Cases”) that went to trial before the D.C. District Court (Hon. Royce Lamberth). *See Hyatt v. Iancu*, Case Nos. 05-2310 (D.D.C.); 09-1864 (D.D.C.), 09-1872 (D.D.C.).

After its summary judgment motions were denied in significant part, the PTO sought to use the Section 145 Cases as a vehicle for putting an end to all of Mr. Hyatt’s pending applications by obtaining a finding of prosecution laches—that is, that he had engaged in unreasonable and unexplained delay amounting to an egregious abuse of the patent system. Compl. ¶¶ 371–72. Mr. Hyatt, in turn, sought and obtained limited discovery that he used to obtain evidence of the PTO’s bad faith in its treatment of him and handling of his applications. Compl. ¶¶ 384–85. To limit Mr. Hyatt’s use of such evidence from 2003 to 2013 at trial, the PTO conceded that Mr. Hyatt should not be held responsible for delays during that period. Compl. ¶ 386. The court rejected the PTO’s laches defense at the close of its case, on the ground that the agency had not met its burden of identifying unreasonable and unexplained delay by Mr. Hyatt. Compl. ¶ 388.

The court’s “Laches Opinion” decision issued on August 1, 2018. ECF No. 223, Case No. 09-1872, 2018 WL 3654777 (D.D.C.). The court observed that it was “particularly telling...that many of Mr. Hyatt’s applications spent an inordinate time in a proverbial Never-never Land, during which he was not allowed under PTO’s procedures to prosecute his applications further,” *id.* at *5, that the PTO by admission “shoulders responsibility for the delay” in examination between 2003 and 2012, *id.* at *14, that the PTO’s hostile response to Mr. Hyatt’s exercise of his right to seek judicial review of its actions was “somewhere between vexing and outright galling,” as “[i]t takes a certain chutzpah for a government agency to chafe against citizens seeking to vindicate their rights through lawfully available means,” *id.* at *15 n.14, and that the PTO “repeatedly disclaimed any attempt at all to show Mr. Hyatt intended to obstruct the patent system,” *id.* at *17 n.19.

In a separate “Merits Opinion,” the court concluded that Mr. Hyatt’s applications contained patentable subject matter and ordered the PTO to issue Mr. Hyatt three patents containing more than 80 claims. ECF No. 225, Case No. 09-1872, 2018 WL 3656071 (D.D.C.). Notably, those three

applications are similar to and share specifications with many of the simultaneously-filed applications that remain mired before the PTO. Laches Opinion at *13, 18.

Notwithstanding the potential merit of Mr. Hyatt's pending applications, the PTO publicly confirmed in the Section 145 Cases, as part of its laches argument, that it does not intend to allow any of them to issue. In motion papers and in open court, it stated unequivocally that it intends to reject "all of his [Mr. Hyatt's] pending applications at the USPTO." Compl. ¶¶ 376–79.

5. Mr. Hyatt Seeks Relief from the PTO's Decision Not To Issue Him Another Patent

Mr. Hyatt was aware of the PTO's delay and previously sought relief from the PTO's undue delay on certain of his applications. But it was not until discovery in the Section 145 Cases in 2017, and the investigation that it prompted him to undertake, that he finally understood the extent of the PTO's bad faith, particularly with regard to the Hyatt Unit's policies, ongoing course of conduct, and purpose. Compl. ¶ 4; *see, e.g.*, Compl. ¶ 272 *et seq.* (Hyatt-specific policies disclosed in discovery).

Accordingly, Mr. Hyatt has brought this suit for relief from the PTO's unlawful decision that it will not issue him further patents to which he may be entitled and its denial of his rights under the Patent Act and Due Process Clause, which is what he seeks in Counts IV, V, and VI. He also seeks, in Count III, a refund of the fees that the PTO imposed on him through carrying out its unlawful determination and denial of his rights.

B. The PTO's Actions Regarding the '263, '450, and '669 Applications

In addition to challenging PTO's bad faith, unlawful actions and policies, and violation of his rights across all of his patent applications, Mr. Hyatt has included claims regarding three specific patent applications where he has alleged an entitlement to particular relief: application nos. 08/456,263 (the '263 Application), 08/599,450 (the '450 Application), and 08/762,669 (the '669 Application).

1. The '263 Application

Mr. Hyatt filed the '263 Application in May 1995. Compl. ¶ 407. After back-and-forth

examination on the '263 Application from May 1995 through March 1998, the examiner entered what is known as a “restriction requirement” in the application, on grounds that it included multiple distinct inventions that belonged in their own separate applications, and rejected certain other claims. Compl. ¶¶ 407–26. After Mr. Hyatt petitioned for review of the restriction requirement, the PTO determined that there were three so-called “linking claims” among the rejected claims and that the restriction requirement would be withdrawn if Mr. Hyatt prevailed in overcoming the rejections of any of those claims. Compl. ¶¶ 433, 437, 442.

Mr. Hyatt then sought mandamus to compel the PTO to withdraw the restriction requirement, which the PTO successfully opposed by representing to the court that, “if the Board reverses the rejection of the linking claims, then the restriction requirement will be withdrawn....” Compl. ¶ 447. After the Court dismissed the action on that basis, Compl. ¶ 448, Mr. Hyatt prevailed before the Board on most of the linking claims in June 2003, placing numerous claims in condition for allowance. Compl. ¶ 453. Not only did the PTO fail to honor its representations to the Court, but the supervisor responsible for overseeing Mr. Hyatt’s applications stated that this application, among others, was “on hold.” Compl. ¶ 457. During this period, the '263 Application qualified as “special,” because it had been “pending for more than 5 years,” and was therefore entitled to expedited action and advancement out of turn. Compl. ¶ 459. The PTO also admitted that it subjected the '263 Application to the secret SAWS program so as to block its issuance. Compl. ¶ 469.

Mr. Hyatt has paid a total of \$19,738.00 in fees for the processing of the '263 Application. Compl. ¶ 470. The PTO’s Motion to Dismiss represents (at 11 & Ex. 2) that on June 27, 2018, fifteen years after its last office action and two months after Mr. Hyatt brought this action, the PTO mailed an office action in the '263 Application. In Counts VII, VII, and IX, Mr. Hyatt seeks relief from the PTO’s unlawful refusal to issue the allowed claims contained in the '263 Application.

2. The Expired Applications: The '450 and '669 Applications

Mr. Hyatt filed the '450 Application on January 16, 1996, and it includes claims directed to an image system for continuous display of moving three dimensional images. Compl. ¶¶ 471–

72. Mr. Hyatt filed the '669 Application on December 9, 1996, and it includes claims directed to image processing architecture. Compl. ¶¶ 515–16. Because the '450 and '669 Applications were filed between June 8, 1995, and May 28, 2000, they were eligible for patent terms of 20 years from filing, without any possibility of term adjustment for PTO delay. Compl. ¶ 567. That meant that the last possible date that the inventions in the '450 Application could receive patent protection was January 16, 2016, and the last possible date that the inventions in the '669 Application could receive patent protection was December 9, 2016. Compl. ¶¶ 571, 573.

The '450 Application was in active examination from January 16, 1996, until February 26, 2002, when the PTO mailed an office action including non-final rejections. Compl. ¶¶ 479–87. Between February 2002 and October 2013, Mr. Hyatt filed 19 information disclosure statements, Compl. ¶¶ 488, 491, 495, responded to the non-final rejection, Compl. ¶ 489, and petitioned four times for action on the application, Compl. ¶¶ 493, 496, 498, 501. During this time, the PTO's only actions were to dismiss his first petition, Compl. ¶ 494, and to suspend examination of the application six separate times, Compl. ¶¶ 497, 499, 500, 502–04. In October 2013, with just over two possible years remaining on the term of any patent that issued from the '450 Application, the PTO restarted prosecution from square one and issued Requirements identical to those it had issued in Mr. Hyatt's other applications containing extensive boilerplate inapplicable to '450 Application and demands that made no sense in light of its substance. Compl. ¶¶ 505–06, 581–84. Since issuing the Requirements, the PTO has taken no action on the merits of the '450 Application. Compl. ¶ 507. Mr. Hyatt has paid a total of \$12,885.00 in fees for the processing of the '450 Application. Compl. ¶ 513.

The '669 Application was in active examination from December 9, 1996, until March 3, 2004, when the PTO issued an office action containing non-final rejections. Compl. ¶¶ 524–35. Between March 2004 and October 2013, Mr. Hyatt filed seven information disclosure statements, Compl. ¶¶ 536, 539, 540, 542, amended his application with new drawings, Compl. ¶ 537, responded to the non-final rejections, Compl. ¶ 538, amended his claims, Compl. ¶ 540, and petitioned twice for action on the merits, Compl. ¶¶ 544, 547. The only action that the PTO took

during this nine-year period was to suspend examination of his application six times, Compl. ¶¶ 543, 545, 546, 548–50, and it failed to respond to both of his petitions, Compl. ¶ 547. As with the '450 Application, in October 2013, with just over three possible years remaining on the term of any patent that issued from the '669 Application, the PTO restarted prosecution from scratch and issued the same Requirements to which it had subjected his other applications containing extensive boilerplate inapplicable to the '669 Application and demands that made no sense in light of its substance. Compl. ¶¶ 551–52, 581–84. The PTO issued a single office action, containing non-final rejections, between October 2013 and December 9, 2016. Compl. ¶ 558. Mr. Hyatt paid \$9,150 in fees for the processing of the '669 Application. Compl. ¶ 562.

The PTO's failure to issue a patent on the '450 and '669 Applications within 20 years of filing precluded Mr. Hyatt from ever receiving protection for the patentable inventions claimed in them. Compl. ¶ 6. These applications are, therefore, referred to in this motion collectively as the "Expired Applications." Compl. ¶ 6. In Count I of this action, Mr. Hyatt seeks a refund of the fees that the PTO imposed on him with respect to the Expired Applications, and Count II seeks just compensation for the PTO's taking of his property with respect to those applications.

Argument

I. The Court Possesses Subject Matter Jurisdiction Over Mr. Hyatt's Claims

The PTO incorrectly casts (at 12–22) a number of its merits challenges to Mr. Hyatt's claims, such as issue preclusion, as matters of subject matter jurisdiction. But the only ones that potentially implicate subject matter jurisdiction concern its sovereign immunity with respect to Mr. Hyatt's refund and takings claims, and those are addressed below, along with the PTO's merits arguments.⁴ All of Mr. Hyatt's claims arise under the Constitution or laws of the United States and

⁴ The PTO does not appear to argue that sovereign immunity bars Mr. Hyatt's claims other than for takings and refunds; any such argument would be untenable, given that APA Section 702's sovereign-immunity waiver, 5 U.S.C. § 702, encompasses all claims that "seek[] non-monetary relief based on the agency's official acts." *Delano Farms Co. v. California Table Grape Com'n*, 655 F.3d 1337, 1349 n.6 (Fed. Cir. 2011) (holding that "section 702 waives immunity for equitable actions alleging that an agency 'acted or failed to act'"); *see also Chamber of Commerce of U.S. v. Reich*, 74 F.3d 1322, 1328 (D.C. Cir. 1996) ("The APA's waiver of sovereign immunity applies

are therefore within the Court’s 28 U.S.C. § 1331 jurisdiction. In addition, the Court has jurisdiction under 28 U.S.C. § 1361 over Mr. Hyatt’s claims “in the nature of mandamus to compel an officer or employee of the United States or any agency thereof to perform a duty owed to the plaintiff.”

II. The Court May Provide Mr. Hyatt Relief from the PTO’s Unlawful Decision Not To Issue Him Another Patent and Withholding of Action Required by Law

The PTO has determined that it will not issue Mr. Hyatt another patent, no matter his entitlement to one. Whether that decision is viewed as a rule or as unlawful withholding of the duties required of the PTO under the Patent Act and Due Process Clause, this Court has authority to provide Mr. Hyatt relief from it.

A. Mr. Hyatt Has Plausibly Alleged that the PTO Has Determined To Deny His Statutory and Constitutional Rights

The PTO halfheartedly contends (at 27–29) that Mr. Hyatt has not plausibly stated a claim for relief with respect to the PTO’s treatment of his applications. In pleading those claims, Mr. Hyatt was cognizant of the need for “detailed factual allegations” that go beyond a “the defendant-unlawfully-harmed-me accusation,” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009), and so provided overwhelming factual detail of the PTO’s challenged policy and action.

The policy and action that Mr. Hyatt challenges in Counts IV–VI is the PTO’s determination not to issue him further patents irrespective of the merits of his applications and its concomitant withholding of lawful examination, and ultimately the issuance of patents, to which he is entitled by the Patent Act and Due Process Clause. *See* Compl. ¶¶ 622, 630–31, 634–35. The PTO reasonably does not dispute that such a decision would be unlawful,⁵ only (at 28) whether

to any suit whether under the APA or not.”). That includes claims seeking to enjoin unconstitutional government conduct. *We the People Found., Inc. v. United States*, 485 F.3d 140, 142–43 (D.C. Cir. 2007); *Simmat v. US Bureau of Prisons*, 413 F.3d 1225, 1231–33 (10th Cir. 2005) (holding that Section 702 waives immunity over “a claim for an injunction, based on the federal courts’ equity jurisdiction, to enforce the dictates of the [Constitution]”).

⁵ Among other things, the PTO lacks the substantive rulemaking authority necessary to adopt such a rule. *See Merck & Co. v. Kessler*, 80 F.3d 1543, 1549–50 & n.6 (Fed. Cir. 1996). Such a rule also

Mr. Hyatt has plausibly alleged it.

Mr. Hyatt’s detailed allegations meet his burden to “plead[] factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.” *Iqbal*, 556 U.S. at 678. The Complaint details the PTO’s actions and tactics over a period of years, and still ongoing, to block issuance of any patents to which Mr. Hyatt may be entitled. It recounts numerous examples of PTO officials describing this decision, Compl. ¶¶ 19, 45–48, 96–98, 148, as well as the PTO’s own statements in court that it does not intend to issue any of Mr. Hyatt’s applications, *id.* ¶¶ 376–77. It recounts numerous statements by PTO officials identifying why the PTO adopted this decision, because it determined that he is an abusive “submariner” who is not entitled to patents. Compl. ¶¶ 16–18, 29–48, 51; Compl. ¶ 51 (PTO ██████████ ██████████ a software utility called the “Submarine Tracker”). And it recounts statements by PTO officials concerning Mr. Hyatt’s expected demise. Compl. ¶¶ 23–25.

The Complaint details numerous specific actions by the PTO evidencing and carrying out this decision, all cited in the Background Section above. That includes, solely with respect to the current Hyatt Unit, all of Mr. Morse’s instructions to its examiners to reject and object to Mr. Hyatt’s applications, ██████████, its procedurally irregular actions to force Mr. Hyatt’s applications into abandonment, its continuing actions to block his administrative appeals, ██████████ ██████████” its matter-of-course denial of routine requests like claim cancellation, its sitting on his petitions challenging all of its unlawful actions, and its representation before a federal district court that it intends to deny *all* of Mr. Hyatt’s applications. To be clear, this list is not exhaustive: the Complaint includes hundreds of specific allegations, over dozens of pages, recounting the Hyatt Unit’s actions to bury Mr. Hyatt and his applications and hundreds of additional allegations demonstrating that those actions are just the latest manifestation of the PTO’s longstanding policy to deny Mr. Hyatt

violates the Patent Act and Fifth Amendment’s Due Process Clause, both of which are enforceable through APA claims, *Webster v. Doe*, 486 U.S. 592, 603 (1988), and injunction claims.

further patents. And, as for whether the PTO would adopt a secret policy to block Mr. Hyatt's applications, the PTO *has admitted to doing so in the recent past*, through SAWS flags and their equivalent that prevented examiners from issuing Mr. Hyatt's applications. Compl. ¶¶ 99–118.

Even if some Hyatt-specific practices permitted by the Patent Act could be justified by the PTO's view of the complexity or quantity of Mr. Hyatt's applications or claims, that does not explain why the PTO blocked examiners from issuing Mr. Hyatt's applications; why it took the unusual step of withdrawing from issuance applications that examiners determined were meritorious and then sat on those applications for years without action; why it [REDACTED]; why it penalized him by applying to his applications rules that it had already determined were inapplicable; why it made rejections that it recognized to be unnecessary or unwarranted; why it doubled-up rejections with identical-in-substance objections to force Mr. Hyatt to overcome both in administrative proceedings that it has dragged out for years; why it started over with examination for applications that had only two or three years of possible remaining term, subjected them to boilerplate Requirements that ignored their material differences from Mr. Hyatt's other applications, and then ran out the clock on them; why it decided, while examination remained ongoing, that it intends to reject every single claim in every single one of Mr. Hyatt's applications; and why the Hyatt Unit's head has never given a moment's thought to the prospect that one of his examiner's might identify allowable subject matter in one of Mr. Hyatt's applications. These allegations are not "merely consistent with" the PTO's liability, *Iqbal*, 556 U.S. at 678. The reason for these actions is that the PTO made a decision not to issue another patent to Mr. Hyatt, no matter his entitlement.

B. Prospective Relief Is Available Under the APA and the Court's Equitable and Mandamus Authority

The PTO's contention (at 17–20) that the Court is powerless to remedy the PTO's decision not to issue Mr. Hyatt any further patents is incorrect. Obviously, if the PTO published a final rule in the *Federal Register* providing that "Gilbert Hyatt is ineligible for patents," this Court would have authority to set it aside. 5 U.S.C. § 706(2). That the agency committed the additional

procedural violation of failing to undertake notice and comment⁶ before it adopted that very rule does not shield it from judicial review and deprive Mr. Hyatt of a remedy.

The same is true under APA Section 701(1)'s and the Court's equitable and mandamus authority. Section 701(1) provides that a reviewing court "shall—(1) compel agency action unlawfully withheld or unreasonably delayed." A claim may proceed under this provision on a showing that "an agency failed to take a *discrete* agency action that it is *required to take*." *Norton v. S. Utah Wilderness All.*, 542 U.S. 55, 64 (2004). The case law therefore draws a distinction between a court order that an agency "take action upon a matter" that is not discretionary, which Section 706(1) authorizes, and an order "directing *how* it shall act" in exercising its discretion, which Section 706(1) does not authorize. *Id.* (quotation marks omitted). *See also Simmat*, 413 F.3d at 1231–33 (explaining that similar relief is available through "a claim for an injunction, based on the federal courts' equity jurisdiction" under 28 U.S.C. § 1331, as Mr. Hyatt pleaded in Count V).

The Complaint alleges a violation of non-discretionary duties to act provided in the patent statute: the PTO "shall cause an examination to be made of the application and the alleged new invention" and issue a patent "if on such examination it appears that the applicant is entitled to" one. 35 U.S.C. § 131. The PTO has no discretion on that question: an applicant satisfying the statutory criteria "shall be entitled to a patent," *id.* § 102, and may ultimately obtain one on *de novo* review by a court, *id.* § 145. The Complaint alleges that the PTO has decided not to issue further patents to Mr. Hyatt and that the "examination" it is conducting of his pending application is sham directed at carrying out that decision rather than assessing Mr. Hyatt's entitlement to issuance of patents. Mr. Hyatt seeks an order compelling the PTO to undertake its non-discretionary duty to examine his applications and issue the patents to which he is entitled, not one directing the PTO's discretion in carrying out those mandatory duties.

That relief is well supported by precedent. Section 706(1) "carried forward" the principles of mandamus, *Norton*, 542 U.S. at 63, and mandamus "lies...where the exercise of judgment and

⁶ *See* 35 U.S.C. § 2(b)(2)(A) (requiring the PTO to undertake notice-and-comment rulemaking).

discretion are involved and the officer refuses to decide, provided that, if he decided, the aggrieved party could have his decision reviewed by another tribunal.” *Comm’r of Patents v. Whiteley*, 71 U.S. 522, 534 (1866). Thus, in *Whiteley*, the Supreme Court recognized the PTO’s duty “to examine the application” for a patent and reach a judgment either rejecting or allowing claims can be enforced by a writ of mandamus. *Id.* at 533–34. The Court there did not affirm a mandamus order requiring such an examination only because the commissioner had already fully examined *and* disallowed a patent, and “the [petitioner] had a right, under the statute, to appeal.” *Id.* at 533. Here, the PTO has withheld from Mr. Hyatt an “examination and the exercise of judgment, with their proper fruit,” *id.*, and thereby frustrated Mr. Hyatt’s right to appeal adverse determinations on his applications. *Cf.* Laches Decision at 30 n.14 (describing the PTO’s retaliation against Mr. Hyatt for exercising his right to challenge its actions in court as “somewhere between vexing and outright galling”).

Contrary to the PTO’s mischaracterization (at 17), Mr. Hyatt does not “concede that the agency has been acting on his applications.” Mr. Hyatt alleged in detail that the PTO’s paper-pushing is contrary to its non-discretionary duty to lawfully examine Mr. Hyatt’s applications so as to identify and issue any patents to which he is entitled. This Court’s discussion of the difference between inefficient examination and non-action on non-discretionary duties is apposite:

[I]f the administrative record showed that the 80 patent applications in issue were currently in limbo before the Appeal Board awaiting examiners’ answers that might never come, then plaintiff might have a claim that the PTO was failing to cause his applications to be examined. Similarly, if the administrative record showed that the 80 patent applications in issue were currently languishing in an ongoing state of suspension, then plaintiff might have a claim that the PTO was failing to cause his applications to be examined....

Indeed, if the administrative record showed that plaintiff’s applications were currently in a state of ongoing, unreasonable suspension, an order enjoining—and thereby constraining—further unwarranted suspensions might be appropriate and would have the effect of compelling an examination upon the expiration of the suspensions.

Hyatt v. U.S. Patent & Trademark Office, 146 F. Supp. 3d 771, 782, 785 (E.D. Va. 2015). The PTO has changed its tactics of late—shifting from delay to Potemkin “examination”—but the scenario

identified by the Court is the same: Mr. Hyatt's applications are trapped in a state of limbo, with lawful examination and issuance never to come. The PTO's unsupported assertion (at 18) that it "has demonstrated good faith efforts to honor its commitment to action on Mr. Hyatt's applications" is unable, at this stage, to overcome Mr. Hyatt's plausible allegations to the contrary.

The PTO also argues (at 18) that, because it has discretion in "what actions to take," it is consequently immune from a judicial order remedying its "*failure to act*." "But discretion in the manner in which the duty may be carried out does not mean that the [government] does not have a duty to perform a 'discrete action' within the meaning of § 706(a) and *SUWA*." *Vietnam Veterans of Am. v. Cent. Intelligence Agency*, 811 F.3d 1068, 1079 (9th Cir. 2016). As Judge McConnell explained, "the fact that an official's duty entails some discretion does not necessarily shield him from mandamus." *Simmat*, 413 F.3d at 1235. He continued, quoting Chief Justice Taft: "Mandamus issues to compel an officer to perform a purely ministerial duty. It cannot be used to compel or control a duty in the discharge of which by law he is given discretion. The duty may be discretionary within limits. He can not transgress those limits, and if he does so, he may be controlled by injunction or mandamus to keep within them." *id.* (quoting *Work v. United States ex rel. Rives*, 267 U.S. 175, 177 (1925)).

On that basis, Courts regularly reject arguments identical to PTO's here. *See, e.g., Vietnam Veterans*, 811 F.3d at 1078–79 (rejecting argument that Army's discretion precluded court from ordering it to warn volunteers of risks of participating in experiments); *Firebaugh Canal Co. v. United States*, 203 F.3d 568, 577–78 (9th Cir. 2000) (same, with respect to drainage requirement); *Meina Xie v. Kerry*, 780 F.3d 405, 408 (D.C. Cir. 2015) (same, with respect to agency's failure to issue required regulations).

Like failure to issue regulations, the PTO's action to deny Mr. Hyatt additional patents and banish his applications into administrative purgatory is a violation of its non-discretionary duties, even though the PTO has some discretion in *how* to conduct a lawful examination. And, of course, it has *no discretion* on whether to issue applications that contain patentable subject matter.

C. APA Review Is Available of the PTO's Decision To Deny Mr. Hyatt's Rights and Withholding of Action To Which He Is Entitled by Law

The PTO's arguments (at 12–17) regarding displacement of APA remedies and finality miss the mark because Mr. Hyatt is not challenging particular actions that the PTO has taken in his applications, but the PTO's decision not to issue him another patent and its withholding of lawful examination, and ultimately the issuance of patents, to which he is entitled.⁷

1. Displacement. The Patent Act's judicial review provisions, 35 U.S.C. §§ 141, 145, permit review, respectively, of the Board's decision on the merits of a patent application and of an applicant's entitlement, again on the merits, to a patent. Neither provides for review of the PTO's adoption of a *de facto* or *de jure* rule that it will not issue Mr. Hyatt further patents. *See* 5 U.S.C. § 551 (broadly defining “rule”). Accordingly, APA review does not “duplicate existing procedures for review of agency action.” *Bowen v. Massachusetts*, 487 U.S. 879, 903 (1988), and so is not displaced by those provisions.

The result is the same if Mr. Hyatt's claims are viewed as challenging the PTO's action to unlawfully withhold the examination and issuance of patents that the PTO has a statutory duty to perform. *See* 35 U.S.C. § 131 (PTO “shall cause an examination to be made of the application”); *id.* § 102 (“A person shall be entitled to a patent....”). The carve-out from APA review for agency action as to which there is an “adequate remedy in court,” 5 U.S.C. § 704, “should not be construed to defeat the central purpose of providing a broad spectrum of judicial review of agency action.” *Bowen*, 487 U.S. at 903. A statutory remedy is not adequate when it is “not of the same genre as a special statutory procedure for review of agency action.” *El Rio Santa Cruz Neighborhood Health Ctr., Inc. v. U.S. Dep't of Health & Human Servs.*, 396 F.3d 1265, 1275 (D.C. Cir. 2005) (quotation marks omitted). The Patent Act's “specific procedures allowing a patent applicant to appeal PTO rejections of patent claims,” *Pregis Corp. v. Kappos*, 700 F.3d 1348, 1358 (Fed. Cir. 2012), are not of the same genre as an APA remedy requiring the PTO to examine patent claims so that it makes

⁷ The PTO's displacement and finality arguments are applicable only to the APA claims and not Mr. Hyatt's claims for injunctive relief under the Court's equitable authority and for mandamus.

a final decision and issues any patents to which an applicant may be entitled. There is no reason to infer from a process allowing review of final rejections of claims any intent by Congress to foreclose judicial review of a distinct decision to unlawfully withhold final allowance or rejection of claims. *See U.S. Army Corps of Engineers v. Hawkes Co.*, 136 S. Ct. 1807, 1816 (2016).

Moreover, the Patent Act's review processes are not "adequate" because Mr. Hyatt has no recourse to them when the PTO has chosen not to permit final merits determinations on his applications. *See Sackett v. E.P.A.*, 566 U.S. 120, 127 (2012) (finding that process the plaintiffs "cannot initiate" to be inadequate). The process the PTO claims affords an adequate remedy is the very process that Mr. Hyatt has alleged is being manipulated to deny court review. *See Cohen v. United States*, 650 F.3d 717, 732 (D.C. Cir. 2011) (concluding that a tax refund action was an inadequate remedy for a challenge to the very mechanisms that were a prerequisite to a tax refund action).

Finality. The PTO's decision not to issue further patents to Mr. Hyatt—whether viewed as a rule itself or the withholding of action—constitutes final agency action. The APA defines "agency action" broadly to "include[] the whole or a part of an agency rule, order, license, sanction, relief, or the equivalent or *denial thereof*, or failure to act." 5 U.S.C. § 551(13) (emphasis added). As for the first *Bennett* factor, Mr. Hyatt has plausibly alleged that decision "mark[s] the consummation of the agency's decisionmaking process," *Bennett v. Spear*, 520 U.S. 154, 178 (1997), given that it has guided the PTO's actions over a period of years and is not subject to any procedure for agency reconsideration or review. The resources that the PTO has marshalled to implement that decision indicate that it is not "merely tentative or interlocutory nature." *Id.*; *see also Hawkes*, 136 S. Ct. at 1814–15 (enough that, although decisions could be revisited, they "typically" were not). As for the second factor, Mr. Hyatt has plausibly alleged that the PTO's decision determines Mr. Hyatt's "rights," *Bennett*, 520 U.S. at 178, in that it denies his entitlement to the procedural and substantive rights provided by the Patent Act, up to and including the issuance of patents.

Accordingly, the PTO's decision constitutes final agency action subject to APA review.⁸ The PTO concludes otherwise (at 14–16) only by again mischaracterizing Mr. Hyatt's claims as challenging one or more “examination decisions” taken in his applications.

D. The APA Authorizes Mr. Hyatt's Refund Claims Because They Seek “Relief Other than Money Damages”

The PTO's assertion (at 24) that Mr. Hyatt's requests for refunds of the fees that the PTO imposed on him during its course of unlawful conduct is “truly unprecedented” reflects only its unawareness of the applicable precedent.

Mr. Hyatt's refund claims (Counts I and III) concern the same conduct as Mr. Hyatt's prospective-relief claims (Counts IV, V, and VI), as well as the PTO's unlawful actions to terminate the Expired Applications. Both claims seek a refund of fees that the PTO wrongfully imposed on Mr. Hyatt in connection with its decision not to issue him further patents. They challenge final agency action for the same reasons described above. *See supra* § II.C. In addition, the action challenged in Count III is final because the PTO constructively denied the Expired Applications, by running out any potential patent term. *Friedman v. Fed. Aviation Admin.*, 841 F.3d 537, 541–42 (D.C. Cir. 2016) (finding as much, in far more ambiguous circumstances). The PTO's argument (at 16) that, before bringing this claim, Mr. Hyatt should spend tens of thousands of dollars to prosecute the Expired Applications to final action (which would, in any instance, never come if the PTO has its way) before seeking a refund is ludicrous.

As for the viability of these claims, the required waiver of sovereign immunity can be found in APA Section 702, which provides that the United States (including its agencies and officers) is amenable to actions “seeking relief other than money damages” when no “other statute that grants consent to suit expressly or impliedly forbids the relief which is sought.” 5 U.S.C. § 702. In other

⁸ Any suggestion by the PTO (like at 15) that its decision to deny Mr. Hyatt further patents amounts to a mere policy statement should be rejected out of hand. That decision does not leave “the agency and its decisionmakers free to exercise discretion.” *Ctr. for Auto Safety v. Nat'l Highway Traffic Safety Admin.*, 452 F.3d 798, 806 (D.C. Cir. 2006) (quotation marks omitted). Instead, it “establish[es] binding norms or agency actions that occasion legal consequences that are subject to review.” *Id.*

words, the provision “retains the defense of sovereign immunity only when another statute expressly or implicitly forecloses injunctive relief.” *Schnapper v. Foley*, 667 F.2d 102, 108 (D.C. Cir. 1981). “[T]he recovery of specific property or *monies*” paid to the government is not “money damages,” because it is not compensatory and therefore not “damages.” *Bowen v. Massachusetts*, 487 U.S. 879, 893 (1988) (quoting *Larson v. Domestic & Foreign Commerce Corp.*, 337 U.S. 682, 688 (1949)) (emphasis in original). Such “specific remedies are not substitute remedies at all, but attempt to give the plaintiff the very thing to which he was entitled.” *Id.* at 895 (quotation marks omitted).

The PTO attempts to distinguish *Bowen* by arguing that no statute specifically entitles Mr. Hyatt to a refund, but *Bowen*’s conception of “specific relief” has been routinely applied in circumstances where the government wrongfully collected funds. For example, *America’s Community Bankers v. FDIC* explained that, if an FDIC assessment on banks was unlawful, the banks were entitled “to get their money back.” 200 F.3d 822, 830 (D.C. Cir. 2000). And *Allied-Signal, Inc. v. U.S Nuclear Regulatory Com’n*, 988 F.2d 146, 151 (1993), which held that an agency rule imposing fees on “UF₆ converters” was inadequately supported, recognized that, if the rule were vacated, the agency “would need to refund all 1990 OBRA fees collected from those converters.” Likewise, the Ninth Circuit in *Wileman Bros. & Elliott, Inc. v. Espy* held that “a refund of improper assessments is the appropriate remedy for prevailing handlers” who had challenged a USDA marketing program. 58 F.3d 1367, 1385–86 (9th Cir. 1995) (citing other cases holding as much); *see also id.* at 1386 (identifying “a refund of the specific assessments that were taken from the handlers” as “a remedy which we have repeatedly indicated would be available” to parties prevailing in such challenges); *Cal-Almond v. Department of Agriculture*, 14 F.3d 429, 438 (9th Cir. 1993) (holding that “a sufficient remedy for handlers who prevail in their administrative petitions is a refund of any assessments found not to have been due”); *Steele v. United States*, 200 F. Supp. 3d 217, 223–24 (D.D.C. 2016) (recognizing jurisdiction over APA claim for refund of fees unlawfully collected by IRS); *Holly Sugar Corp. v. Veneman*, 355 F. Supp. 2d 181 (D.D.C. 2005), *rev’d on other grounds*, 437 F.3d 1210 (D.C. Cir. 2006) (refund of overcharged interest paid

to government); *Zellous v. Broadhead Assocs.*, 906 F.2d 94, 96 (3d Cir. 1990) (refund of allegedly excessive rent charged by HUD).

Like in those cases, Mr. Hyatt does not seek any *compensation*—for his wasted time, enormous professional expenses, loss of business opportunities, etc.—but *equitable relief* in the form of a refund of the fees that the PTO imposed on him in connection with its unlawful action. If the PTO’s decision to deny Mr. Hyatt further patents was unlawful, then Mr. Hyatt is entitled to that relief. None of the cases that the PTO cites (at 26–27) for their general language concerning Tucker Act jurisdiction involved a simple refund of monies wrongfully collected by the government, for the reason that the Tucker Act does not give the Court of Federal Claims jurisdiction to hear such claims. *See Bowen*, 487 U.S. at 904–05 (rejecting identical argument and explaining that “the Court of Claims has no power to grant equitable relief”).

The PTO’s unsupported argument (at 25) that provisions of 35 U.S.C. § 41 authorizing the PTO to refund fees in certain circumstances displaces ordinary APA review overlooks that *Bowen* rejected a similar argument, explaining that only a “‘special and adequate review procedure’ . . . will oust a district court of its normal jurisdiction under the APA.” 487 U.S. at 904. To the extent that the PTO is arguing that those provisions “expressly or impliedly forbid[] the relief which is sought,” 5 U.S.C. § 702, that argument would be meritless. The “presumption favoring judicial review of administrative action” only “may be overcome by specific language or specific legislative history that is a reliable indicator of congressional intent.” *Block v. Cmty. Nutrition Inst.*, 467 U.S. 340, 349 (1984). But the statutory text contains no indication of congressional intent to foreclose judicial review, such as a “reticulated remedial regime” that itself includes some other pathway for judicial review. *See Fornaro v. James*, 416 F.3d 63, 66 (D.C. Cir. 2005) (emphasizing importance of such features). Instead, 35 U.S.C. § 41 merely authorizes the PTO to provide refunds in certain circumstances, without saying anything about administrative claims-processing or judicial review. (And the Patent Act’s judicial review provisions concerning applications, 35 U.S.C. §§ 141, 145, are plainly inapplicable.). At most, this is a situation “where substantial doubt about the congressional intent exists,” and so “the general presumption favoring judicial review of

administrative action is controlling.” *Block*, 467 U.S. at 349; *see also Stark v. Wickard*, 321 U.S. 288 (1944) (applying that presumption where, like here, there was otherwise “no forum” in which such a claim could be brought).

E. Issue Preclusion Does Not Shield The PTO’s Challenged Action From Judicial Review

The PTO’s suggestion (at 20–22) that issue preclusion arising from *Hyatt v. U.S. Patent and Trademark Office*, No. 1:14-cv-01300-TSE (E.D. Va.) (the “Undue Delay Suit”), bars any of Mr. Hyatt’s claims here is based on a mischaracterization of what was litigated in that case and a misstatement of what Mr. Hyatt seeks here. Where that case involved PTO’s actions unduly delaying prosecution of 80 applications, this one challenges the PTO’s decision that it will not issue further patents to Mr. Hyatt. Contra the PTO (at 20), Mr. Hyatt does not “seek[] the same relief again upon the same grounds.”⁹

The PTO contends that issue preclusion should apply to the Court’s holding in the Undue Delay Suit that “the remedy for unreasonable delay under § 706(1) is action, not preferential treatment,” and that the Court would therefore not supervise the PTO’s expedience in processing Mr. Hyatt’s applications. MTD at 21 (quoting 146 F. Supp. 3d at 785). The Court considered “whether the current state of affairs—in which agency action is ongoing—warrants mandamus.” *Undue Delay Suit*, 146 F. Supp. 3d at 782. And it found that, “[b]ecause the law merely requires that the PTO cause an examination to be made, and because the administrative record reflects that examinations are currently and actively underway, aided by the Requirements, no further constraint is warranted.” *Id.* at 785. That, the PTO argues, supports dismissal.

Its argument is misplaced. The Court recognized, in the Undue Delay Suit, that mandamus-type remedies are appropriate to correct an agency’s “abuse of power.” 146 F. Supp. 3d at 784 (quotation marks and alteration omitted). This action is not an undue delay suit or mere challenge to an agency’s abuse of discretion, but an attempt to check an agency’s wholesale abuse of power

⁹ The PTO labels that case the “Hyatt Requirements Suit,” but the Court recognized that Mr. Hyatt “expressly disavows that he is challenging the substance of the Requirements in this litigation,” 146 F. Supp. 3d 771, 779 n.17 (E.D. Va. 2015).

to crush the rights of an individual. The remedial questions presented in the two cases are different, and the Court's determination that a particular remedy was not warranted there does not control Mr. Hyatt's relief on the very different claims he presents here—claims that he could not have brought in that earlier suit because he lacked the factual basis to assert them. In other words, the Court's finding in the Undue Delay Suit that no further relief was warranted after the PTO ceased its undue delay does not control what remedy may be appropriate if the Court ultimately finds unpersuasive any future representation by the PTO that, going forward, it really and truly intends to respect Mr. Hyatt's rights.

The PTO's argument concerning remedies is also premature, because the question of remedies lies in the future and has nothing to do with the validity of Mr. Hyatt's claims, which is all that is at issue at this stage. The Court can undoubtedly provide some remedy if Mr. Hyatt proves the merits of his claims challenging the PTO's decision not to issue him further patents—for example, it could set aside that action or order the PTO to stop withholding the lawful examination and issuance of patents to which he is entitled. Whether further relief is appropriate to ensure that the PTO ceases its abuse of Mr. Hyatt can and should be decided with or subsequent to the merits of his claims.

III. Mr. Hyatt's Takings Claim Is Supported by an Applicant's Well-Recognized Property Right in His Patent Applications

Contrary to the PTO's arguments (at 23–24), Mr. Hyatt's takings claim is properly brought in this venue and supported by Mr. Hyatt's well-recognized property interest in his applications.

A. This Court May Hear Mr. Hyatt's Takings Claim

The PTO contends (at 24) that this Court lacks jurisdiction over Mr. Hyatt's claim under the Fifth Amendment's Takings Clause with respect to the expired applications because Congress has waived the government's sovereign immunity only when such cases are brought under the Tucker Act or Little Tucker Act, which require suits to be brought in the Court of Federal Claims or district where the plaintiff resides, respectively.

But when the government has appropriated property without undertaking condemnation

proceedings (i.e., an “inverse condemnation”), a cause of action may be maintained under the Takings Clause itself. The Supreme Court held as much in *Jacobs v. United States*, 290 U.S. 13, 16 (1933), explaining that such claims are “based on the right to recover just compensation for property taken by the United States for public use” and arise directly under the Fifth Amendment, so that “[s]tatutory recognition was not necessary.” See also *Kirby Forest Industries, Inc. v. United States*, 467 U.S. 1, 5 & n.6 (1984) (explaining that, when property has been taken by the federal government, “[t]he owner’s right to bring such a suit [for just compensation] derives from the self-executing character of the constitutional provision with respect to condemnation” (quotation marks and alterations omitted)). Indeed, the Supreme Court has expressly rejected the argument by the federal government that “the Constitution does not, of its own force, furnish a basis for a court to award money damages against the government.” *First English Evangelical Lutheran Church of Glendale v. Los Angeles Cty., Cal.*, 482 U.S. 304, 316 n.9 (1987). Instead, it explained, its precedents “make clear that it is the Constitution that dictates the remedy for interference with property rights amounting to a taking.” *Id.*; see also *id.* at 316 (citing those precedents).¹⁰

As *Jacobs* and its progeny provide, Mr. Hyatt’s takings claim arises directly under the Takings Clause, which itself authorizes suit against the federal government. Accordingly, his claim falls under this Court’s 28 U.S.C. § 1331 jurisdiction and is subject to the general venue provisions of 28 U.S.C. § 1391. As the Defendants reside in this district, venue here is proper. 28 U.S.C. § 1391(e)(1).

B. The PTO Took Mr. Hyatt’s Property Right in His Patent Applications

The PTO’s action to deprive Mr. Hyatt of all possible patent term on the Expired Applications effectuated a taking of Mr. Hyatt’s property, entitling him to just compensation under

¹⁰ Tucker Act jurisdiction over such constitutional claims is concurrent. “Although we have occasionally called the Court of Federal Claims’ jurisdiction over such [money-damages] claims ‘exclusive,’ its jurisdiction is only exclusive over claims which no other federal court has the authority to hear. If there is an independent source of subject-matter jurisdiction over a claim against the United States, and some waiver of sovereign immunity other than the Tucker Act, a plaintiff is free to proceed in district court.” *Wyodak Res. Dev. Corp. v. United States*, 637 F.3d 1127, 1130 (10th Cir. 2011) (citation omitted).

the Fifth Amendment's Taking Clause. The PTO contends (at 23), however, that Mr. Hyatt had no property right at all.

It is, of course, well established that patents are property. *E.g.*, 35 U.S.C. § 261 (“[P]atents shall have the attributes of personal property.”); *Consol. Fruit-Jar Co. v. Wright*, 94 U.S. 92, 96 (1877) (“A patent for an invention is as much property as a patent for land.”). Moreover, patents are subject to the requirements of the Takings Clause no less than any other property: “[A patent] confers upon the patentee an exclusive property in the patented invention which cannot be appropriated or used by the government itself, without just compensation, any more than it can appropriate or use without compensation land which has been patented to a private purchaser.” *Horne v. Dep’t of Ag.*, 135 S. Ct. 2419, 2427 (2015) (quoting *James v. Campbell*, 104 U.S. 356, 358 (1882)); *see also McKeever v. United States*, 14 Ct. Cl. 396, 422 (1878) (impermissible to “destroy[] the [exclusive patent] right in whole or in part by appropriating it to the purposes of government without complying with that other condition of the Constitution, the making of ‘just compensation’”). A patent application entitles an applicant to issuance of a patent on any patentable subject matter, 35 U.S.C. § 102, and is therefore property to the extent that it claims patentable subject matter.

That a patent has not issued on an application does not deprive it of its status as property. Property rights in patentable inventions and patent applications are widely recognized in law, with literally hundreds of court decisions adjudicating the ownership of such rights. *E.g.*, *Tri-Star Elecs. Int’l, Inc. v. Preci-Dip Durtal SA*, 619 F.3d 1364, 1366 (Fed. Cir. 2010) (adjudicating ownership of patent application under Ohio law); *Regents Of Univ. Of New Mexico v. Knight*, 321 F.3d 1111, 1118 (Fed. Cir. 2003) (same, under New Mexico law). Patent applications are property for tax purposes. *E.g.*, *Comm’r v. Stephens-Adamson Mfg. Co.*, 51 F.2d 681, 682 (7th Cir. 1931). They can form the *res* of a trust. *Conway v. White*, 292 F. 837, 843 (2d Cir. 1923). They are property in bankruptcy proceedings. *Keen, Inc. v. Gecker*, 264 F. Supp. 2d 659, 662–63 (N.D. Ill. 2003); *Winchester v. Commissioner*, 27 B.T.A. 798, 801 (1933) (“It is now well settled that patent applications are property.”). And the Patent Act itself recognizes that an applicant and others may

have “ownership rights in the application,” 35 U.S.C. § 123(b), and that the “subject matter disclosed” and “claimed invention” in an application are subject to “ownership,” *id.* at § 102(c); *see also id.* at § 122(a); 37 C.F.R. § 3.73(a); (“The inventor is presumed to be the owner of a patent application...”). And the Supreme Court has found all manner of similar “intangible interests to be property for purposes of the Fifth Amendment’s Taking Clause.” *Ruckelshaus v. Monsanto Co.*, 467 U.S. 986, 1003 (1984) (so finding with respect to trade secrets); *see also Armstrong v. United States*, 364 U.S. 40, 44, 46 (1960) (materialman’s lien); *Louisville Joint Stock Land Bank v. Radford*, 295 U.S. 555, 596–602 (1935) (real estate lien); *Lynch v. United States*, 292 U.S. 571, 579 (1934) (valid contracts). In the same way that “[v]alid contracts are property, whether the obligor be a private individual, a municipality, a State or the United States,” so are valid patent applications, and the federal government may therefore not appropriate them. Could there be any serious doubt that, if the USDA seized a shell corporation the sole asset of which was a pending patent application for bioengineered soybean seeds, that seizure would constitute a taking?

The deprivation of patent term itself also constitutes a taking. “[G]overnment regulation of private property may, in some instances, be so onerous that its effect is tantamount to a direct appropriation or ouster—and that such ‘regulatory takings’ may be compensable under the Fifth Amendment.” *Lingle v. Chevron U.S.A., Inc.*, 544 U.S. 528, 537 (2005). In such claims, “the complete elimination of a property’s value is the determinative factor” because it is equivalent to a physical appropriation. *Id.* at 539–40. Mr. Hyatt has suffered such a taking: the PTO’s actions deprived him of all potential patent term on the Expired Applications, depriving them of all value.

The sole case on point cited by the PTO—its others state only general principles of takings—is not to the contrary. The plaintiff in *Giuliani v. United States*, 6 F. App’x 863 (Fed. Cir. 2001), contended that the government took his patent when it abandoned his application for failure to pay the issue fee, and the Federal Circuit affirmed dismissal of that claim on the basis “Congress has plenary power to impose conditions on the vesting of patent rights.” Here, by contrast, Mr. Hyatt has complied with all of the conditions on the vesting of patent rights imposed by Congress, including the payment of all required fees—that is undisputed at this stage. Nonetheless, the PTO

appropriated the entire value of his applications and any patents to which they entitled him. If the PTO disagrees on that point, it may, as a defense to liability, challenge Mr. Hyatt's compliance with the conditions for issuance, so that the Court may adjudicate the validity of Mr. Hyatt's property right. It cannot, however, press that defense at this stage.

IV. The Court Has Authority To Compel the PTO To Issue Allowed Claims in the '263 Application

The PTO's contention (at 29) that the Court lacks authority to order issuance of a patent through mandamus or the APA is incorrect. The Supreme Court has recognized that as the proper remedy where the PTO "fully exercised [its] judgment and discretion when [it] decided that the [petitioners] were entitled to a patent" but declined to issue the patent based on illegitimate considerations. *Butterworth v. United States*, 112 U.S. 50, 68 (1884). In that case, the PTO determined in an adversarial proceeding that a patent application should be allowed, but the losing party appealed to the Secretary of Interior who made the opposite determination, and the PTO declined to issue the patent "merely out of deference to the claim of the secretary." *Id.* The Court determined that the Secretary of Interior had no statutory authority to review the PTO's decision and found mandamus an appropriate remedy against the PTO because, once the judgment of patentability was rendered, issuance was "purely ministerial." *Id.*¹¹

The law is the same under the current statute, which provides that, "if on such examination it appears that the applicant is entitled to a patent under the law, the Director *shall* issue a patent therefore." 35 U.S.C. § 131 (emphasis added). No different than in 1884, the law today does not permit the PTO *not* to issue a patent *once* a determination of entitlement is made. *See also Massachusetts v. EPA*, 549 U.S. 497, 532–33 (2007) (concluding from statute requiring EPA to

¹¹ These claims challenge final agency action for the same reason as Mr. Hyatt's challenge to the PTO's decision to deny him further patents and lawful examination. *See supra* § II.C. The PTO having decided that it will withhold issuance of the '263 Application, Mr. Hyatt may challenge that unlawful withholding of duties imposed by law. Moreover, these claims are not moot (see MTD at 19) because Mr. Hyatt is not challenging the agency's undue delay, but its unlawful withholding of action—issuance of claims in a position for allowance—that the PTO continues to withhold.

regulate pollutants if in its “judgment” the pollutant contributes to air pollution not to allow EPA to decline regulations even after finding that a pollutant does contribute to air pollution because the word “‘judgment’ is not a roving license to ignore the statutory text”).

Here, as in *Butterworth*, the Complaint alleges that the PTO made patentability determinations in Mr. Hyatt’s favor for claims in the ’263 Application, but declined to issue a patent based solely on considerations alien to the Patent Act. *See, e.g.*, Compl. ¶¶ 65–98. In particular, the examiner found numerous claims to be allowable, and the Board reversed the examiner’s rejections on a number of additional claims, putting those claims and those allowed by the examiner in a condition for allowance and in position for issuance. *Id.* ¶¶ 453–54. Rather than perform its ministerial duty, the PTO placed the application on hold and subjected it to SAWS, so as to preclude its issuance. *Id.* ¶¶ 457–70. And the decision on patentability is not discretionary, either. *See, e.g., Mannington Mills, Inc. v. Congoleum Corp.*, 595 F.2d 1287, 1294 (3d Cir. 1979) (“The granting of the patents per se [is] in substance [a] ministerial activity.”); *Brenner v. Ebbert*, 398 F.2d 762, 764 (D.C. Cir. 1968) (“[The] issuance of a patent...is a relatively ministerial act; if the issue fee is timely tendered, the patent must issue.”). An applicant who satisfies the statutory criteria for patentability “shall be entitled to a patent,” 35 USC § 102, and the PTO’s decision on whether an application presents patentable subject matter is subject to *de novo* review, without any deference to the agency. *Kappos v. Hyatt*, 132 S. Ct. 1690, 1696 (2012); *id.* (rejecting PTO’s argument “that a district court should defer to the PTO’s factual findings”). Accordingly, if the PTO refuses to carry out its ministerial duties relating to the issuance of patents, the injured applicant may call on this Court to provide appropriate relief.

Conclusion

For the foregoing reasons, the Defendants’ Motion To Dismiss should be denied.

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Respectfully submitted,

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Certificate of Service

I hereby certify that on August 6, 2018, I electronically filed the foregoing Response in Opposition to Defendants' Motion to Dismiss with the Clerk of Court using the CM/ECF system, which will then send a notification of such filing (NEF) to the following:

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