

UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA

GILBERT P. HYATT,

Plaintiff,

v.

JOSEPH MATAL,

Defendant.

Civil Action No. 05-2310 (RCL)

Civil Action No. 09-1864 (RCL)

Civil Action No. 09-1869 (RCL)

Civil Action No. 09-1872 (RCL)

**Plaintiff's Motion to De-Designate PTO Documents as Protected**

Plaintiff Gilbert P. Hyatt moves the Court to de-designate as “Protected” documents under the parties’ Stipulated Protective Order the following document ranges: PTO15-0000001 through PTO15-0004803; PTO15-0023599 through PTO15-0023701; PTO16-0000001 through PTO16-0000155; PTO16-0000177 through PTO16-0000232; PTO16-0000235 through PTO16-0000242; PTO16-0000266 through PTO16-0000305; PTO16-0000334; PTO16-0000336 through PTO16-0000361; PTO16-0000387 through PTO16-0000407; PTO16-0000410 through PTO16-0000592; PTO16-0000594 through PTO16-0000633; PTO16-0000643; PTO16-0000649 through PTO16-0000752; PTO16-0000758 through PTO16-0001207; PTO16-0001277 through PTO16-0001285; PTO16-0001323 through PTO16-0001325; PTO16-0001328 through PTO16-0001584; PTO16-0001601 through PTO16-0001642; PTO16-0001653 through PTO16-0001818; PTO16-0002012 through PTO16-0002510; PTO16-0002557 through PTO16-0002648; PTO16-0002655 through PTO16-0002656; PTO16-0002659 through PTO16-0002680.

The Court should order that the PTO’s claim of protection for these documents is improper, and the PTO should be ordered to produce new versions which no longer contain any “Protected” labeling.

The facts and law supporting this Motion are set forth in the accompanying Memorandum of Law, exhibits thereto, and other materials of record in this case. A proposed order granting the requested relief is also attached.

This motion is being publicly filed with redactions, with a version being filed under seal without the redactions. Exhibits 5 and 6 to this motion are also being filed under seal.

I hereby certify that I met and conferred with the counsel for Defendant in good faith to resolve this issue, but the parties were unable to reach any resolution of the matter absent resolution from the Court.

Dated: November 7, 2017

Respectfully submitted,

/s/ Paul M. Levine

Andrew M. Grossman (D.C. Bar No. 985166)

Paul M. Levine (D.C. Bar No. 999320)

Baker & Hostetler LLP

1050 Connecticut Ave., N.W., Suite 1100

Washington, D.C. 20036

(202) 861-1697

agrossman@bakerlaw.com

pmlevine@bakerlaw.com

*Attorneys for Plaintiff Gilbert P. Hyatt*

**Certificate of Service**

I hereby certify that on November 7, 2017, I electronically filed the foregoing Motion, and all supporting materials, with the Clerk of the Court by using the Court's ECF system. All counsel of record were served by the Court's ECF system, with any under sealing findings served on counsel of record via email.

/s/ Paul M. Levine  
Paul M. Levine

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**ECF**

**[Proposed] Order**

Upon consideration of Plaintiff's Motion to De-Designate PTO Documents as Protected, the Memorandum of Law in Support and exhibits, the Response and Reply thereto, and the entire record, it is hereby

ORDERED that Plaintiff's Motion is GRANTED; and it is further

ORDERED that Defendant has improperly designated as "Protected" the following documents it produced: PTO15-0000001 through PTO15-0004803; PTO15-0023599 through PTO15-0023701; PTO16-0000001 through PTO16-0000155; PTO16-0000177 through PTO16-0000232; PTO16-0000235 through PTO16-0000242; PTO16-0000266 through PTO16-0000305; PTO16-0000334; PTO16-0000336 through PTO16-0000361; PTO16-0000387 through PTO16-0000407; PTO16-0000410 through PTO16-0000592; PTO16-0000594 through PTO16-0000633; PTO16-0000643; PTO16-0000649 through PTO16-0000752; PTO16-0000758 through PTO16-0001207; PTO16-0001277 through PTO16-0001285; PTO16-0001323 through PTO16-0001325; PTO16-0001328 through PTO16-0001584; PTO16-0001601 through PTO16-0001642; PTO16-0001653 through PTO16-0001818; PTO16-0002012 through PTO16-0002510; PTO16-0002557 through PTO16-0002648; PTO16-0002655 through PTO16-0002656; PTO16-0002659 through PTO16-0002680; and it is further



ORDERED that Defendant shall re-produce these documents without any  
“Protected” or similar labeling within two weeks of the date of this order.

SO ORDERED.

Date: \_\_\_\_\_, 2017

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Royce C. Lamberth  
United States District Judge

UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA

GILBERT P. HYATT,

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Civil Action No. 05-2310 (RCL)  
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**Memorandum of Law in Support of Gilbert P. Hyatt's Motion to De-Designate PTO  
Documents as Protected**

The United States Patent and Trademark Office ("PTO") seeks to maintain the blanket confidentiality protection for documents it produced in discovery, some of which were shown in open Court and introduced into evidence during the prosecution laches trial. Its attempt to do so is wholly improper. Federal agencies, absent a specific exemption, are not entitled to claim confidentiality over their documents—particularly documents that have been produced via discovery in litigation.

But this is what the PTO seeks to do for essentially every document it produced in response to Gilbert P. Hyatt's document requests, which were bulk-designated without regard to whether they had been previously disclosed publicly. These documents included House bills, communications the PTO had with third parties, court rulings, news articles, and documents introduced into evidence at trial. Only when Mr. Hyatt complained about the PTO's mass designation of documents under the parties' Stipulated Protective Order did the PTO make some de-designations, albeit extremely limited ones.

The PTO still persists in designating as "Protected" documents introduced into evidence (such as Patent Application Location Monitoring ("PALM") records and Steve

Kunin's invoices and contract), all of Mr. Hyatt's PALM records, Mr. Hyatt's payment records to the PTO, emails containing news clippings, petition decisions regarding Mr. Hyatt's patent applications that have already been publicly released, and emails regarding Mr. Hyatt's patent applications. Beyond the PTO's inability to claim confidentiality over these documents generally, the PTO's specific claims to confidentiality are specious. If anyone is entitled to claim protection for these documents, it is Mr. Hyatt, not the PTO.

The PTO, the party that has the burden to justify that its documents are entitled to protection, cannot do so. Therefore, this Court should order that the PTO's claim of protection is improper, and should order the PTO to produce new versions which no longer contain any "Protected" labeling.

### **Factual and Procedural Background**

The PTO produced email correspondence, PALM records, financial records regarding Mr. Hyatt's payments, congressional bills, communications with Congress, documents produced in response to Freedom of Information Act ("FOIA") requests, granted patents, and other documents responsive to Mr. Hyatt's requests for production of documents in addition to the administrative file histories for Mr. Hyatt's patent applications. The PTO bulk-designated all of these additional documents (other than the administrative file histories), produced with Bates-numbers prefixed "PTO15" or "PTO16," as protected under the Protective Order (with extremely limited exceptions).<sup>1</sup>

When Mr. Hyatt challenged the PTO on its overly broad confidentiality designations, the PTO refused to de-designate these records because "[t]hese productions

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<sup>1</sup> The PTO16 documents largely consist of the PTO email correspondence regarding Mr. Hyatt's patent applications, while the PTO15 documents largely consist of the remaining materials identified above.

primarily reflect internal documents and communications of the USPTO, which are not generally available to the public.” Ex. 1 (Sep. 7, 2017 email from Philip Warrick to Paul Levine). In response, Mr. Hyatt informed the PTO that it designated as protected congressional bills, materials produced under the Freedom of Information Act regarding the Sensitive Application Warning System (“SAWS”) program, other communications with Congress and third parties outside of the PTO, and even published patent applications. Mr. Hyatt also explained that the PTO, as a government agency, has no right to claim confidentiality over its internal communication absent some applicable privilege, such as a deliberative process privilege. Ex. 1 (Sep. 7, 2017 email from Paul Levine to Philip Warrick).

The PTO later admitted it had over-designated documents as confidential and promised to review its productions to identify which documents should not have been designated protected, but indicated its “review would take some time,” and that the issue could be mooted by the upcoming trial where it acknowledged its materials could be publicly disclosed. Ex. 1 (Sep. 8, 2017 email from Philip Warrick to Paul Levine). In follow-up communications after trial, Mr. Hyatt again sought to have the PTO de-designate the PTO15 and PTO16 productions. Mr. Hyatt explained that most of the PTO15 documents were already released publicly or concern Mr. Hyatt’s patent applications and should not have been protected (except, of course, for any protections Mr. Hyatt wishes to ascribe to these materials). Mr. Hyatt also identified a number of PTO16 documents that were used in open Court during his Opening Statement (without objection) that no longer were entitled to protection under the Protective Order; the remaining PTO16 documents “constitute[d] agency records that, but for any protections afforded to Mr. Hyatt, would otherwise be

publicly discloseable” and were, therefore, not entitled to protection under the Protective Order.<sup>2</sup> Ex. 2.

The PTO subsequently provided its list of documents that should not be designated as protected, which de-designated a subset of the PTO15 and PTO16 documents comprising about a total of 40 different documents and sets (such as Mr. Hyatt’s granted patents). Although Mr. Hyatt had identified documents shown in open Court, the PTO refused to concede that protection had been waived: “[w]e disagree that the USPTO has waived any protections regarding these documents” other than those contained on its list. Ex. 3.

The parties then met and conferred (pursuant to paragraph 16 of the Protective Order), but could reach no further resolution to the dispute for the following ranges of documents: PTO15-0000001 through PTO15-0004803; PTO15-0023599 through PTO15-0023701; PTO16-0000001 through PTO16-0000155; PTO16-0000177 through PTO16-0000232; PTO16-0000235 through PTO16-0000242; PTO16-0000266 through PTO16-0000305; PTO16-0000334; PTO16-0000336 through PTO16-0000361; PTO16-0000387 through PTO16-0000407; PTO16-0000410 through PTO16-0000592; PTO16-0000594 through PTO16-0000633; PTO16-0000643; PTO16-0000649 through PTO16-0000752; PTO16-0000758 through PTO16-0001207; PTO16-0001277 through PTO16-0001285; PTO16-0001323 through PTO16-0001325; PTO16-0001328 through PTO16-0001584; PTO16-0001601 through PTO16-0001642; PTO16-0001653 through PTO16-0001818;

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<sup>2</sup> In fact, Mr. Hyatt’s counsel communicated with counsel for the PTO about whether it wished to seek confidentiality protection for the materials that Mr. Hyatt displayed in open court in his opening statement, but the PTO’s position at that time was that it wanted all court proceedings without exception to be on the public record. PTO counsel made similar statements in the context of portions of the 700 family specification that Mr. Hyatt had treated as a trade secret and wished to obtain protection for at trial. *See* Trial Tr. 68:25–71:25 (Oct. 10, 2017 A.M. Session) (“The proceedings are too important.”).

PTO16-0002012 through PTO16-0002510; PTO16-0002557 through PTO16-0002648; PTO16-0002655 through PTO16-0002656; PTO16-0002659 through PTO16-0002680. *See* Ex. 3.

### Argument

Federal government agencies who claim confidentiality over their records should receive added scrutiny absent an express basis for doing so. Federal records are presumed subject to public disclosure absent a specific exemption prohibiting it. *E.g.*, *Dep't of State v. Ray*, 502 U.S. 164, 173 (1991) (explaining FOIA “pierce[s] the veil of administrative secrecy and...open[s] agency action to the light of public scrutiny.”) (citation omitted); *see also Burka v. HHS*, 87 F.3d 508, 515 (D.C. Cir. 1996) (“[R]equested material must be disclosed unless it falls squarely within one of nine exemptions carved out of the Act.”) (citations omitted). More importantly, the confidentiality protection that is available for public documents must be considered in light of FOIA because a document that Mr. Hyatt could obtain through FOIA cannot be “confidential” under the parties’ protective order. In that regard, FOIA specifically exempts from production documents not available to parties in discovery: “inter-agency or intra-agency memorandums or letters that would not be available by law to a party other than an agency in litigation with the agency” are exempted from disclosure. 5 U.S.C. § 552(b)(5) (FOIA Exemption 5). “As indicated by its language, the parameters of Exemption 5 are determined by reference to the protections available to litigants in civil discovery; if material is not ‘available’ in discovery, it may be withheld from FOIA requesters.” *Burka*, 87 F.3d at 516 (refusing agency request to withhold materials based upon Rule 26(c)(7)); *accord Hall v. C.I.A.*, 881 F. Supp. 2d 38, 67 (D.D.C. 2012).

Simply put, the fact that the PTO produced the documents in discovery in this matter demonstrates that they are not subject to any exemptions under FOIA.<sup>3</sup> The only basis the PTO has for designating any documents as “Protected” is the PTO’s statutory obligations to protect applicant information. 35 U.S.C. § 122. To the extent that protection is afforded to Mr. Hyatt, it is he—not the PTO—that is entitled to determine the scope of the protection. And because the documents disclosed by the PTO in this litigation would be produceable in response to a FOIA request, none of those documents are entitled to any protection.

But even if the PTO could protect its documents under the Stipulated Protective Order, they have done so here in an impermissible mass-designation—which it largely persists in doing even after being requested to revisit its designations. “Parties frequently abuse Rule 26(c) by seeking protective orders for material not covered by the rule.” *In re Violation of Rule 28(D)*, 635 F.3d 1352, 1358 (Fed. Cir. 2011); *see also Jepson, Inc. v. Makita Elec. Works, Ltd.*, 30 F.3d 854, 860 (7th Cir. 1994) (explaining that use of confidentiality designations to protect non-confidential information was improper); *John Does I-VI v. Yogi*, 110 F.R.D. 629, 632–34 (D.D.C. 1986) (requiring party to demonstrate justification for confidentiality designations); *Manual for Complex Litigation* § 11.432 n.134 (4th ed. 2004) (“The designation of a document as confidential should be viewed as equivalent to a motion for a protective order and subject to the sanctions of Federal Rule of Civil Procedure 37(a)(4), as provided by Rule 26(c).”). As one court explained,

Simply, when parties agree to a blanket protective order, do not show—*specifically*—that the documents subject to the protective order will contain sensitive information whose disclosure will cause harm, and retain the right to

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<sup>3</sup> The PTO, when it believed it was appropriate to do so, asserted its applicable privileges (including the deliberative process privilege) to restrict Mr. Hyatt’s ability to take discovery. *See* Ex. 7 (PTO Document Responses claiming deliberative process privilege); PTX-18 & Ex. 9 (PTO Interrogatory Responses claiming deliberative process privilege).

decide which of these documents they will exclude from discovery, then they abuse Rule 26(c) by converting to their own use the inherent discretion that belongs to the Court. This scenario describes what the parties have done here.

*Maxchief Investments Ltd. v. Plastic Dev. Grp., LLC*, No. 3:16-CV-63, 2017 WL 710956, at \*4 (E.D. Tenn. Feb. 22, 2017) (citation omitted).

The parties' Stipulated Protective Order (*e.g.*, ECF No. 31 in 09-cv-01869) provides, in pertinent part, that protected materials consists of information that

is not generally known to others or readily available to the public and which the Producing Party or the Receiving Party (i) would not normally reveal to third parties except in confidence or has undertaken with others to maintain in confidence; or (ii) believes in good faith is protected by a right to confidentiality or privacy under federal or state law or any other applicable privilege, right, or law related to confidentiality or privacy.

Protective Order ¶ 1. After being alerted to a challenge to a document designated as "Protected" and an attempt to resolve the matter informally, the party claiming protection "shall bear the burden of establishing good cause for the 'Protected' designation" in any court challenge. *Id.* ¶ 17. Information does not qualify for protection if it becomes available to the general public after its production. *Id.* ¶ 7(a).

**A. PTO Documents Referenced in Open Court**

Mr. Hyatt introduced into evidence PTX-85, 87, and 88, the PALM database records for the 08/431,639, 08/457,211, and 08/472,062 patent applications. These documents correspond to PTO15-0001331–37, PTO15-0002237–45, and PTO15-0004606–14, all of which the PTO contends are still entitled to protected status despite their use in open Court and admission into evidence during trial.<sup>4</sup>

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<sup>4</sup> Documents previously provided to the Court as exhibits in the prosecution laches trial, whether introduced into evidence or not, are also referenced herein by their exhibit number in that trial. However, those documents can be provided to the Court if so requested.



The PTO repeated the same practice with the PTO16 documents, refusing to concede that documents already shown in Court are no longer entitled to protection. PTO16-0000182 (PTX-615), 0000348 (PTX-272), 0000740 (PTX-115), 0000765 (PTX-119), 0000837 (PTX-124), 0001126 (PTX-131), 0001325 (PTX-133), and 0001562 (PTX-140) were all shown during Mr. Hyatt's Opening Statement without objection from the PTO. Ex. 4 (Hyatt Opening Statement PowerPoint). The PTO also considers documents introduced into evidence, such as the invoices of the PTO's expert, Mr. Kunin, as still worthy of confidentiality protection (even though they were never entitled to such protection). PTO16-0001558–59 (PTX-139), 0002557–59 (PTX-152). And another document introduced into evidence, Mr. Kunin's contract with the PTO, is a Federal government contract that is available via FOIA request and whose information is readily available on the internet. PTO16-0001543–57 (PTX-138); see <http://tinyurl.com/yaez4dly>; <http://tinyurl.com/y6wuvlwn> (detailing that Mr. Kunin's law firm has received \$227,000 in contract awards from the Department of Commerce). The PTO continues to assert protection even over documents it has designated as exhibits, like its "Continuity Map" shown in open Court (DX-255, located at PTO16-0002917–20) and prior iterations thereof (e.g., PTO16-0000177 & PTO16-0001375–84).

Simply put, the PTO's claim of protection as to these documents is frivolous. See *Cobell v. Norton*, 213 F.R.D. 16, 24 (D.D.C. 2003) (determining conversations no longer privileged when recited in open court).

## **B. PALM Documentation**

Beyond the specific PALM documents introduced into evidence, the PTO contends the entirety of Mr. Hyatt's PALM records, located at PTO15-0000003–4803 (PTX-084) and

PTO15-0023602–731 (PTX-098), are subject to confidentiality protection. They are not. These records contain nothing more than a description of the individual filings made in Mr. Hyatt’s patent applications, certain key status changes reflecting major events in a patent application, assignment of the Group Art Unit, location information, and a listing of examiners assigned to any application. *See* Trial Tr. 6:10–8:25 (Oct. 10, 2017 A.M. Session) (describing features of PALM records). The PTO is not entitled to designate these PALM records, in full, as protected—if anything, only Mr. Hyatt is entitled to protection for these records because the records pertain to his patent applications.

The same is true for PTO15-0000001 (PTX-082) and PTO15-0023599 (attached under seal as Exhibit 5), which are spreadsheets relating to PALM entries made by the PTO. PTO15-0000001 (PTX-082) tracks the PTO employees involved with Mr. Hyatt’s patent applications and was produced by the PTO in response to Hyatt Interrogatory No. 1. *See* Ex. 9 at Response 1. PTO15-0023599 tracks alterations made by the PTO to the PALM records and was produced by the PTO in response to Hyatt Interrogatory No. 6. *See* Ex. 9 at Response 6.<sup>5</sup> The assignment of certain employees and/or art units to Mr. Hyatt’s applications and the PTO’s changes to Mr. Hyatt’s PALM records do not contain any confidential material beyond the protections the PTO affords to Mr. Hyatt.

In short, these PALM records simply record the actions of the PTO in handling Mr. Hyatt’s patent applications. For this reason, the PTO has previously produced PALM information in response to a FOIA request. *See Huntington v. U.S. Dep’t of Commerce*, 234 F. Supp. 3d 94, 102 (D.D.C. 2017) (producing documents from PALM system regarding

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<sup>5</sup> Ex. 9 is the PTO’s Responses to Mr. Hyatt’s Interrogatories Nos. 1–7 and was admitted into evidence.

applications generally). The PTO's claim of confidentiality as to these materials is inappropriate and legally indefensible.

**C. Official Gazette, "Submarine Detector," Hyatt Payment Documents, and Other Non-Email Records**

The remaining documents in the PTO15 series do not qualify for protection under the Protective Order, as well:

- PTO15-00014462-68 (PTX-266): These documents address the withdrawal from issue of two of Mr. Hyatt's patent applications. All but two pages were already published in the PTO's *Official Gazette*; the remaining two pages consist of [REDACTED] but containing no other material worthy of protection.
- PTO15-0014469-70 (PTX-095): This document is a two-page screenshot of the PTO's "Submarine Detector" website. There is nothing on the face of this document that appears to consist of any protected material.
- PTO15-0023600 (PTX-269), PTO15-0023732-953 (received in evidence as PTX-099), and PTO15-0023601 (attached under seal as Exhibit 6): These documents are spreadsheets tracking Mr. Hyatt's payments to the PTO, including debits and credits from his PTO depository account. Mr. Hyatt has already introduced PTX-099 into evidence. Only Mr. Hyatt, and not the PTO, is entitled to protect his fee payments to the PTO from further public dissemination. Indeed, Mr. Hyatt may even be entitled to production of these documents pursuant to the Privacy Act. 5 U.S.C. § 552a; 71 Fed. Reg. 38387-88 (July 6, 2006) (explaining that PTO Deposit Account Systems constitute a system of records for Privacy Act purposes).

As to the remaining documents (other than emails) Bates-stamped PTO16, the PTO appears to have made almost no effort to justify why any particular document is entitled to protection. Even a cursory review of the PTO's production demonstrates that the PTO is still asserting protection improperly over these documents. For example, the PTO claims protection over things such as a GATT/NAFTA Student's Handbook publication from the U.S. Department of Commerce (PTO16-00000001-84, available at DX-235, PTX-270.00001-84); multiple PTO Requests for Records Disposition Authority under NARA (PTO16-0000942-1125, available at PTX-273, PTX-274, PTX-275, PTX-276, PTX-277, and

PTX-278);<sup>6</sup> blank PTO performance appraisal materials for its examiners (*e.g.*, PTO16-0001693–1818, 0002012–2510, available at PTX-270.01702–1827 and PTX-270.02021–2519); and a petition decision from the PTO which (except for the application number) has already been publicly disclosed by the PTO (*compare* PTO16-0000923–39, available at PTX-270.00932–48, *with* <http://tinyurl.com/y9js7tyz>).

#### **D. PTO Emails**

The PTO's claims of protection for emails fares no better. The PTO is simply not permitted to claim protection for documents because they are emails; emails constitute agency records subject to FOIA, so they are public records not entitled to protection if discloseable in discovery. *See Competitive Enter. Institute v. Office of Science & Tech. Policy*, 827 F.3d 145 (D.C. Cir. 2016) (holding that agency emails located in private account of agency head are subject to production under FOIA).

The PTO's specific claims to protection for its emails under the Protective Order shows those claims are specious. The PTO asserts protection for general emails with publicly available information, including emails containing news clips mentioning the PTO (PTO16-0000410–14, 0000478–79, available at PTX-270.00410–14, 00478–79); an email containing [REDACTED] (PTO16-0000421–22, available at PTX-270.00421–22); [REDACTED] (PTO16-0001663, available at PTX-270.01672)<sup>7</sup>; and, emails regarding its [REDACTED]

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<sup>6</sup> According to the PTO's Rule 30(b)(6) designee, all of these Requests for Records Disposition Authority are already public. Ex. 8, PTO 30(b)(6) Dep. Tr. at 65–70 (Aug. 21, 2017).

<sup>7</sup> The PTO still contends this “link” is confidential even though it removed the “Protected” designation from the article after receiving a letter from Mr. Hyatt objecting to the PTO's

(e.g., PTO16-0001664-92, available at PTX-270.01664-92), an initiative which is already publicly known (see <http://tinyurl.com/ybf2wjbd>). The PTO has not identified any protection to which these emails are entitled.

The PTO also continues to assert protection over materials regarding Gilbert Hyatt, many of which are already publicly known. These include emails from the PTO [REDACTED]

██████████ (e.g., PTO16-0000744, available at PTX-116); an email ██████████

(PTO16-0000747, available at PTX-270.00747); an email circulating [REDACTED]

██████████ (PTO16-0000626–27, available at PTX-636); and, emails ██████████

[REDACTED] (e.g., PTO16-0001568, available at PTX-270.01577). The PTO has further designated as protected emails

[REDACTED] (PTO16-0000202-3, available at PTX-270.00202-s3); emails regarding [REDACTED]

██████████ (e.g., PTO16-0000584, 0000759, 0000940–41, available at PTX-270.00584, PTX-270.00759, and PTX-270.00949–50), ██████████; and, an email ██████████

██████████ (PTO16-0000828, available at PTX-270.00828).

These examples are by no means exclusive, but reflect the PTO's bulk designation of materials under the Protective Order without any apparent regard for whether that material is actually worthy of protection, either under the Protective Order or under FOIA. The PTO

designations. *See* Ex. 2 (de-designating PTO16-0000156–63, available at <http://tinyurl.com/ybs44a95>).

was supposed to review the documents carefully and only assert supported designations prior to production, and the PTO was certainly required to do the same after Mr. Hyatt challenged its overly broad designation of materials. Instead of doing so, the PTO largely persisted with its bulk-designation tactics and essentially shifted the burden to Mr. Hyatt to demonstrate (via the instant motion) why the remainder were designated improperly. None of these documents are entitled to protection—the PTO, as a Federal agency, must open its “action[s] to the light of public scrutiny.” *Ray*, 502 U.S. at 173.

**Conclusion**

For the foregoing reasons, Mr. Hyatt's Motion should be granted, this Court should order that the PTO's claim of protection is improper, and should order the PTO to produce new versions which have no longer contain any "Protected" labeling.

Dated: November 7, 2017

Respectfully submitted,

/s/ Paul M. Levine

Paul M. Levine (D.C. Bar No. 999320)

Andrew M. Grossman (D.C. Bar No.  
985166)

Mark W. DeLaquil (D.C. Bar No. 493545)

Baker & Hostetler LLP

1050 Connecticut Ave., N.W., Suite 1100

Washington, D.C. 20036

(202) 861-1697

pmlevine@bakerlaw.com

agrossman@bakerlaw.com

*Attorneys for Plaintiff Gilbert P. Hyatt*

# Exhibit 1



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**From:** Warrick, Philip <Philip.Warrick@USPTO.GOV>  
**Sent:** Thursday, September 7, 2017 3:17 PM  
**To:** Levine, Paul M.  
**Cc:** Stewart, Coke; McBride, Robert; Grossman, Andrew M; DeLaquil, Mark  
**Subject:** RE: Hyatt v. Matal

Paul,

To clarify my previous email, we agree to re-designate any communications with third parties or otherwise publicly available documents, as these types of documents do not require “Protected” status under the protective orders. Although fact discovery has been closed for nearly two weeks, and while this issue could have been raised much earlier in the litigation, we would agree to review our PTO15 and PTO16 productions to identify and re-designate any such documents, including the SAWS materials previously released pursuant to a FOIA request (PTO15-0004804 through PTO150008916). This review will take some time, of course, particularly in view of the pretrial statements due tomorrow. If there are particular documents you believe to have been designated improperly, bringing such documents to our attention would expedite the process.

Regarding internal USPTO documents and communications produced in PTO16, for example, the parties agreed to the language defining “Protected” materials in the stipulated protective orders governing these cases, and we have relied on that protection in producing documents in this litigation. Contrary to your email, we have not determined that these materials could or should be produced to the public pursuant to a FOIA request, particularly because many of these documents relate to patent applications subject to the confidentiality requirements of Section 122. The fact that we have made these documents concerning Mr. Hyatt’s patent applications available to Mr. Hyatt himself subject to the protections of a court order does not imply that we would provide them to other members of the public. Indeed, Mr. Hyatt has argued for broad confidentiality protection for any materials related to his unpublished patent applications.

Again, to the extent you wish to use any “Protected” materials at trial, we understand the Court to have resolved that issue. If you disagree, please let us know.

Regards,  
Phil

---

**From:** Levine, Paul M. [mailto:pmlevine@bakerlaw.com]  
**Sent:** Thursday, September 07, 2017 12:42 PM  
**To:** Warrick, Philip  
**Cc:** Stewart, Coke ; McBride, Robert ; Grossman, Andrew M ; DeLaquil, Mark  
**Subject:** RE: Hyatt v. Matal

Phil-

Those were but a few examples. Also contained in the PTO15 series are Congressional bills, other communications with Congress, SAWS materials (which note in the production that they were released in June 2016, presumably pursuant to a FOIA request), and patents granted – all of which are available to the public. Claiming indiscriminately protection under the Protective Order for these materials is improper. And making us identify that these materials are not covered by the Protective Order is shifting the burden to us improperly.

As for the PTO16 series, the PTO (as a Government agency) has no right to claim confidentiality. In addition, you have produced each and every document to us without claiming deliberative process or any other privileges over them. The PTO thus has determined that these materials (except for protection to Hyatt as an individual, which is inapplicable in these litigation) could be produced pursuant to a FOIA request. There is no reason that the PTO should be entitled to protect such materials as confidential business processes in these circumstances.

Please let us know when you can discuss today.

Thanks,

Paul

---

**From:** Warrick, Philip [<mailto:Philip.Warrick@USPTO.GOV>]

**Sent:** Thursday, September 7, 2017 12:29 PM

**To:** Levine, Paul M. <[pmlevine@bakerlaw.com](mailto:pmlevine@bakerlaw.com)>

**Cc:** Stewart, Coke <[Coke.Stewart@uspto.gov](mailto:Coke.Stewart@uspto.gov)>; McBride, Robert <[Robert.McBride@USPTO.GOV](mailto:Robert.McBride@USPTO.GOV)>; Grossman, Andrew M <[agrossman@bakerlaw.com](mailto:agrossman@bakerlaw.com)>; DeLaquil, Mark <[mdelaquil@bakerlaw.com](mailto:mdelaquil@bakerlaw.com)>

**Subject:** RE: Hyatt v. Matal

Paul,

We agree that any documents constituting communications with third parties need not be designated as protected, including the two documents identified in your email. If you have identified other such documents, please let us know.

We do not agree, however, that the entirety of our PTO15 and PTO16 productions were improperly designated. These productions primarily reflect internal documents and communications of the USPTO, which are not generally available to the public, and which we generally maintain in confidence. According to the stipulated protective orders in these cases, "Protected" Material includes, among other things, "documents or things the Producing Party or Receiving Party believes in good faith is not generally known to others or readily available to the public and which the Producing Party or Receiving Party (i) would not normally reveal to third parties except in confidence or has undertaken with others to maintain in confidence." *E.g.*, Case No. 05-2310, ECF No. 40, ¶ 1. Should you disagree that this definition applies to specific documents within our production, please identify them so that we may consider your position.

We do agree that Mr. Hyatt may reference these documents – including those designated as "Protected" – in his communications with the USPTO. Furthermore, regardless of how any documents have been designated under the protective orders, Judge Lamberth already has ordered that the "trials in these cases will not be sealed," and that we "should expect evidence, hearings, and proposed findings of fact and conclusions of law to be available to the public." *E.g.*, Case No. 09-1864, ECF No. 132. As such, we understand that a "Protected" designation does not preclude the use of either party's documents at the trial, which will be open to the public.

Regards,  
Phil

---

**From:** Levine, Paul M. [<mailto:pmlevine@bakerlaw.com>]

**Sent:** Wednesday, September 06, 2017 10:38 AM

**To:** Warrick, Philip <[Philip.Warrick@USPTO.GOV](mailto:Philip.Warrick@USPTO.GOV)>

**Cc:** Stewart, Coke <[Coke.Stewart@uspto.gov](mailto:Coke.Stewart@uspto.gov)>; McBride, Robert <[Robert.McBride@USPTO.GOV](mailto:Robert.McBride@USPTO.GOV)>; Grossman, Andrew M <[agrossman@bakerlaw.com](mailto:agrossman@bakerlaw.com)>; DeLaquil, Mark <[mdelaquil@bakerlaw.com](mailto:mdelaquil@bakerlaw.com)>

**Subject:** RE: Hyatt v. Matal

Phil-

With respect to Mr. Hyatt's patent application files, that constitutes Mr. Hyatt's information. We can use the information in Mr. Hyatt's file histories as we see fit – it is the PTO who has to protect that information from disclosure.

Instead, we are specifically discussing the emails and other documents (beyond the patent application file histories) that the PTO produced in this case. Those materials were blanket designated by the PTO as protected without regards to whether they actually contain protected information. For example, the PTO designated as protected information materials it released to Congress (PTO15-0014802) and information it released to third parties (PTO15-0014804). The PTO has previously improperly redacted documents, such as PTO16-00000832, 834, and 837. These are just examples and not meant to be exclusive.

We are challenging every document outside the patent file histories, which should be the entirety of the PTO15 and PTO16 productions (except for Mr. Hyatt's payment information, which, again, is his information). The Confidentiality Order makes it incumbent upon the PTO to justify the basis for any designated document. It does not require Mr. Hyatt to demonstrate the basis for any challenge. There should be no debate that Mr. Hyatt can use these materials at the PTO, but the PTO is also not allowed to protect this information from further disclosure. Please advise when you are available to meet and confer to discuss further if you do not agree.

Paul

**Paul Levine**  
Partner

---

**BakerHostetler**

Washington Square  
1050 Connecticut Ave, N.W. | Suite 1100  
Washington, DC 20036-5304  
T +1.202.861.1606

pmlevine@bakerlaw.com  
bakerlaw.com



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**From:** Warrick, Philip [<mailto:Philip.Warrick@USPTO.GOV>]

**Sent:** Wednesday, September 6, 2017 10:17 AM

**To:** Levine, Paul M. <[pmlevine@bakerlaw.com](mailto:pmlevine@bakerlaw.com)>

**Cc:** Stewart, Coke <[Coke.Stewart@uspto.gov](mailto:Coke.Stewart@uspto.gov)>; McBride, Robert <[Robert.McBride@USPTO.GOV](mailto:Robert.McBride@USPTO.GOV)>; Grossman, Andrew M <[agrossman@bakerlaw.com](mailto:agrossman@bakerlaw.com)>; DeLaquil, Mark <[mdelaquil@bakerlaw.com](mailto:mdelaquil@bakerlaw.com)>

**Subject:** RE: Hyatt v. Matal

Paul,

Regarding your first request, the USPTO would agree to de-designate the entirety of the administrative records for Mr. Hyatt's patent applications if this would address his concerns. Please confirm.

Regarding your second request, it is difficult to respond without knowing which particular documents are at issue. Please identify the specific documents that you believe should be de-designated, and we will consider your request.

Regards,  
Phil

---

**From:** Levine, Paul M. [<mailto:pmlevine@bakerlaw.com>]

**Sent:** Tuesday, September 05, 2017 6:10 PM

**To:** Warrick, Philip <[Philip.Warrick@USPTO.GOV](mailto:Philip.Warrick@USPTO.GOV)>

**Cc:** Stewart, Coke <[Coke.Stewart@uspto.gov](mailto:Coke.Stewart@uspto.gov)>; McBride, Robert <[Robert.McBride@USPTO.GOV](mailto:Robert.McBride@USPTO.GOV)>; Grossman, Andrew M <[agrossman@bakerlaw.com](mailto:agrossman@bakerlaw.com)>; DeLaquil, Mark <[mdelaquil@bakerlaw.com](mailto:mdelaquil@bakerlaw.com)>

**Subject:** Hyatt v. Matal

Phil-

I am writing regarding the PTO's designation of nearly its entire record as "Protected." We believe that, notwithstanding these designations, that Mr. Hyatt can reference these documents in his communications with the PTO regarding the still pending issues in dispute. Please advise if the PTO disagrees.

In addition, we also believe that many of the designations, particularly (but not just those) relating to the email correspondence produced by the PTO were designated in an overly broad way. These materials, to the extent they do not reference applicants other than Mr. Hyatt (many of whom were already redacted), should not be labeled as Protected. Again, please advise if the PTO disagrees.

Let us know by close of business tomorrow so that we can discuss these issues and raise with the Court, if need be.

Paul

**Paul Levine**

Partner

---

**BakerHostetler**

Washington Square

1050 Connecticut Ave, N.W. | Suite 1100

Washington, DC 20036-5304

T +1.202.861.1606

[pmlevine@bakerlaw.com](mailto:pmlevine@bakerlaw.com)

[bakerlaw.com](http://bakerlaw.com)



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## Exhibit 2



Baker&Hostetler LLP

Washington Square, Suite 1100  
1050 Connecticut Avenue, N.W.  
Washington, DC 20036-5403

T 202.861.1500  
F 202.861.1783  
www.bakerlaw.com

Paul M. Levine  
direct dial: 202.861.1606  
pmlevine@bakerlaw.com

October 18, 2017

**VIA E-MAIL**

Philip Warrick  
U.S. Patent and Trademark Office  
Office of the Solicitor  
600 Dulaney Street  
Alexandria, VA 22314

*Re: Hyatt v. Matal*

Dear Counsel:

We write to address the PTO's overly-broad designations of material covered under the Protective Order. These materials largely concern Mr. Hyatt's patent applications and he should be entitled to use them freely, for any purposes he chooses to do so.

We believe that almost none of the documents produced with the Bates-number prefix "PTO15" are entitled to protection under the Protective Order. Many of the documents are obviously not entitled to protection, as you have previously indicated. *See* PTO15-004804 to 0014468; PTO15-0014471 to 14815. The remaining "PTO15" documents concern Mr. Hyatt's patent applications; any protections contained in those documents apply to Mr. Hyatt's patent applications and not any confidential PTO materials. *See* PTO15-0000001, 0000003-0004803, 14469, 23599, 23600-23731. Mr. Hyatt is therefore entitled to use these materials freely.

Mr. Hyatt should also be entitled to use the materials produced with the Bates-number prefix "PTO16" PTO16-0000182, 0000348, 0000740, 0000765, 0000837, 0001126, 0001325, and 0001562 were already used in open court during Mr. Hyatt's Opening Statement (without objection), so that any protection that may have existed has been waived and Mr. Hyatt is entitled to use these materials freely. As to the remaining productions Bates-numbered PTO16, we have previously raised these issues with the PTO before: those documents constitute agency records that, but for any protections afforded to Mr. Hyatt, would otherwise be publicly discloseable.

October 18, 2017

Page 2

The PTO has already confirmed that Mr. Hyatt can use these materials in other proceedings involving the PTO, and Mr. Hyatt is willing to redact these materials to protect any confidential materials pertaining to other applicants. However, please advise your position on which documents no longer are entitled to protection under the Protective Order, as detailed above. More importantly, please advise as to your position regarding whether the PTO intends to blanket designate the remaining documents as protected. Let us know no later than October 19, 2017 so that we can file the appropriate motion with the Court to resolve this issue, if you do not agree.

Sincerely,

A handwritten signature in dark ink, appearing to read "Paul M. Levine", with a stylized flourish at the end.

Paul M. Levine



## Exhibit 3

**From:** Warrick, Philip <Philip.Warrick@USPTO.GOV>  
**Sent:** Tuesday, October 24, 2017 2:06 PM  
**To:** Levine, Paul M.  
**Cc:** McBride, Robert; Stewart, Coke; DeLaquil, Mark; Grossman, Andrew M; Dang, Mai-Trang; McManus, Robert  
**Subject:** RE: Hyatt v. Matal

Paul,

I'm available anytime between 2:30 and 4:30 tomorrow afternoon. As previously agreed, we have reviewed the PTO15 and PTO16 productions and will de-designate and re-produce documents within the bates ranges identified below by early next week. Any other documents marked as "Protected" in the PTO15 or PTO16 productions, however, remain entitled to this designation pursuant to the Protective Orders as previously discussed. We disagree that the USPTO has waived any protections regarding these documents.

Regards,  
 Phil

Bates Range	Description
PTO15-0004804 - 8916	Collection of Documents Related to SAWS
PTO15-0008917 - 14461	75 Issued US Patents
PTO15-0014471 - 14801	H.R. 3309 Committee Hearing
PTO15-0014802	Dana Colarulli Email
PTO15-0014803	Dana Colarulli Email
PTO15-0014804	Gregory Morse Email
PTO15-0014805 - 14815	H.R. 6621
PTO16-0000156 - 163	The Surprising Story of the First Microprocessors
PTO16-0000164 - 165	Dennis Crouch Article
PTO16-0000166 - 170	Hal Wegner Commentary
PTO16-0000171 - 173	Dennis Crouch Article
PTO16-0000174	Dennis Crouch Article
PTO16-0000175 - 176	Dennis Crouch Article
PTO16-0000233 - 234	Dennis Crouch Email
PTO16-0000243 - 265	HeinOnline Download
PTO16-0000306 - 333	Memo Opinion in Case No. 03-108 (D.D.C.)
PTO16-0000335	Order in Case No. 03-901 (D.D.C.)
PTO16-0000362 - 364	AIPLA Email to David Kappos
PTO16-0000365 - 382	Politico Email to David Kappos
PTO16-0000383 - 386	AIPLA Email to David Kappos
PTO16-0000408 - 409	Dennis Crouch Article
PTO16-0000593	Tale of Two Patent Applications Shows How USPTO Changing
PTO16-0000634 - 639	IP Law360 Email to David Kappos
PTO16-0000640 - 642	Dennis Crouch Email

PTO16-0000644 - 648	IP Law360 Email to David Kappos
PTO16-0000753 - 757	AIPLA Email to David Kappos
PTO16-0001208 - 1276	Changes to Implement the Patent Business Goals
PTO16-0001286 - 1297	H.R. 6621
PTO16-0001298 - 1322	Questions for the Record for David J. Kappos
PTO16-0001326 - 1327	Hal Wegner Commentary
PTO16-0001585 - 1600	Memo Opinion in Case No. 1:13-cv-1535 (E.D. Va.)
PTO16-0001643 - 1650	Motion Filed in Case No. 2:14-cv-11 (D. Nev.)
PTO16-0001651 - 1652	Order in Case No. 2:14-cv-11 (D. Nev.)
PTO16-0001819 - 2011	Patent Examiner Performance Appraisal Plan
PTO16-0002511 - 2522	Agency Administrative Order 205-16
PTO16-0002523 - 2538	Records Management
PTO16-0002539 - 2545	Removal of Records and Other Documents
PTO16-0002546 - 2556	Managing Electronic Records
PTO16-0002649 - 2654	Westlaw Printout
PTO16-0002657 - 2658	Stephen Kunin Email

---

**From:** Levine, Paul M. [mailto:[pmlevine@bakerlaw.com](mailto:pmlevine@bakerlaw.com)]

**Sent:** Tuesday, October 24, 2017 1:28 PM

**To:** Warrick, Philip

**Cc:** McBride, Robert ; Stewart, Coke ; DeLaquil, Mark ; Grossman, Andrew M ; Dang, Mai-Trang ; McManus, Robert

**Subject:** RE: Hyatt v. Matal

Phil-

I am following up on the below. Can we speak tomorrow afternoon?

Paul

---

**From:** Levine, Paul M.

**Sent:** Thursday, October 19, 2017 11:31 AM

**To:** Warrick, Philip

**Cc:** McBride, Robert; Stewart, Coke; DeLaquil, Mark; Grossman, Andrew M; Dang, Mai-Trang; McManus, Robert

**Subject:** RE: Hyatt v. Matal

Phil-

We intend to have this issue resolved by the Court if the parties cannot agree. We have extensively discussed this matter before, so further discussion is unlikely to lead to an amicable resolution.

However, we can discuss on Monday next week. Enjoy your time off.

Paul

---

**From:** Warrick, Philip [mailto:[Philip.Warrick@USPTO.GOV](mailto:Philip.Warrick@USPTO.GOV)]

**Sent:** Wednesday, October 18, 2017 4:41 PM

**To:** Levine, Paul M. <[pmlevine@bakerlaw.com](mailto:pmlevine@bakerlaw.com)>

**Cc:** McBride, Robert <[Robert.McBride@USPTO.GOV](mailto:Robert.McBride@USPTO.GOV)>; Stewart, Coke <[Coke.Stewart@uspto.gov](mailto:Coke.Stewart@uspto.gov)>; DeLaquil, Mark <[mdelaquil@bakerlaw.com](mailto:mdelaquil@bakerlaw.com)>; Grossman, Andrew M <[agrossman@bakerlaw.com](mailto:agrossman@bakerlaw.com)>; Dang, Mai-Trang <[Mai-Trang.Dang@USPTO.GOV](mailto:Mai-Trang.Dang@USPTO.GOV)>; McManus, Robert <[Robert.McManus@uspto.gov](mailto:Robert.McManus@uspto.gov)>  
**Subject:** RE: Hyatt v. Matal

Paul,

I don't believe our position on this issue has changed, but I will respond in more detail next week, including confirmation of which particular documents we may de-designate under the protective orders pursuant to our earlier discussions. I am not aware of any circumstances justifying your demand for an immediate response, and I am out of the office for the remainder of the week.

Regards,  
Phil

---

**From:** Levine, Paul M. [<mailto:pmlevine@bakerlaw.com>]

**Sent:** Wednesday, October 18, 2017 2:12 PM

**To:** Warrick, Philip <[Philip.Warrick@USPTO.GOV](mailto:Philip.Warrick@USPTO.GOV)>

**Cc:** McBride, Robert <[Robert.McBride@USPTO.GOV](mailto:Robert.McBride@USPTO.GOV)>; Stewart, Coke <[Coke.Stewart@uspto.gov](mailto:Coke.Stewart@uspto.gov)>; DeLaquil, Mark <[mdelaquil@bakerlaw.com](mailto:mdelaquil@bakerlaw.com)>; Grossman, Andrew M <[agrossman@bakerlaw.com](mailto:agrossman@bakerlaw.com)>

**Subject:** Hyatt v. Matal

Phil-

Please see the attached letter.

Paul

**Paul Levine**  
Partner

---

**BakerHostetler**

Washington Square  
1050 Connecticut Ave, N.W. | Suite 1100  
Washington, DC 20036-5304  
T +1.202.861.1606

[pmlevine@bakerlaw.com](mailto:pmlevine@bakerlaw.com)  
[bakerlaw.com](http://bakerlaw.com)



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## Exhibit 4

UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA

GILBERT P. HYATT,  
Plaintiff,

v.

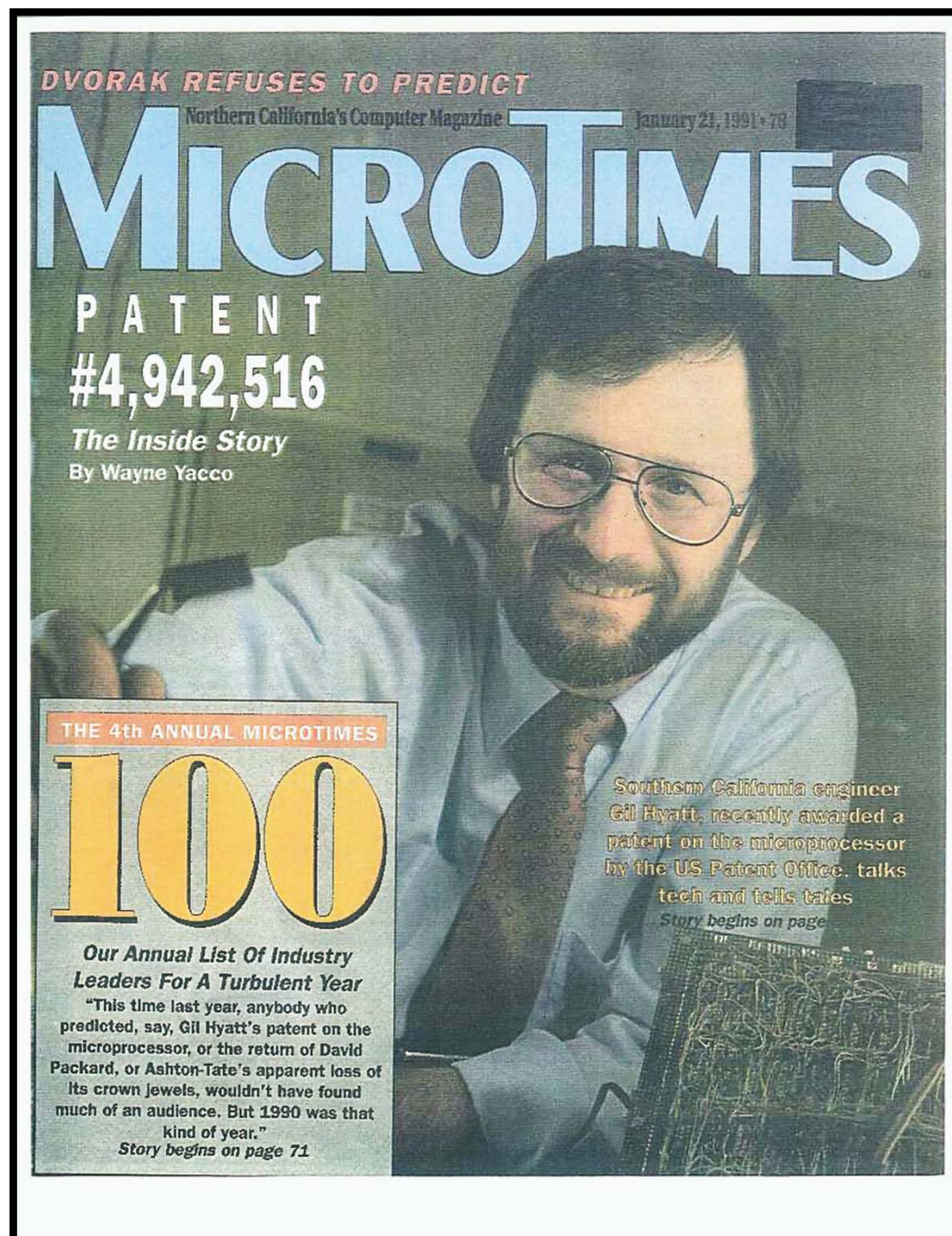
JOSEPH MATAL,  
Defendant.

Plaintiff's Opening Statement

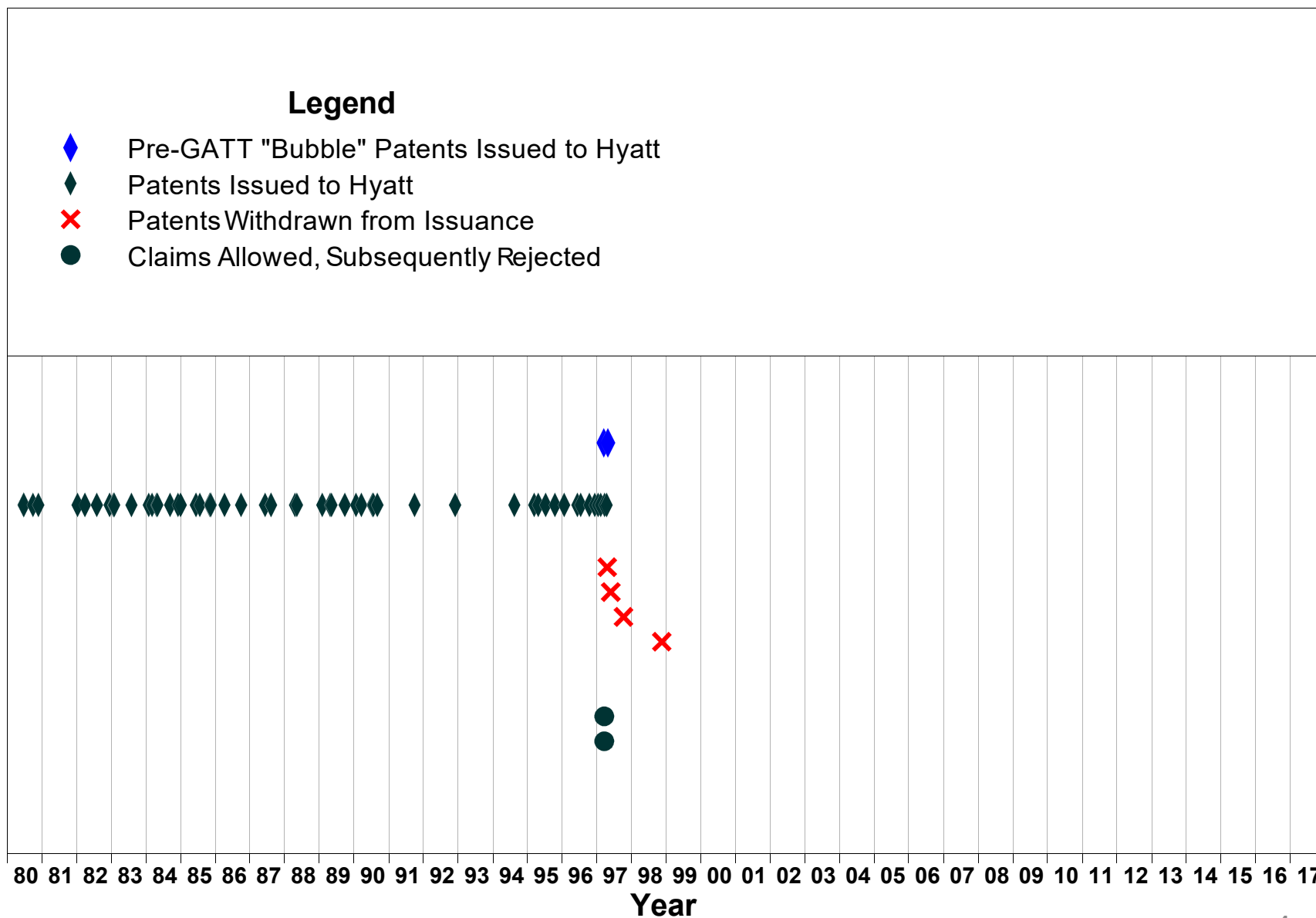
Mark W. DeLaquil





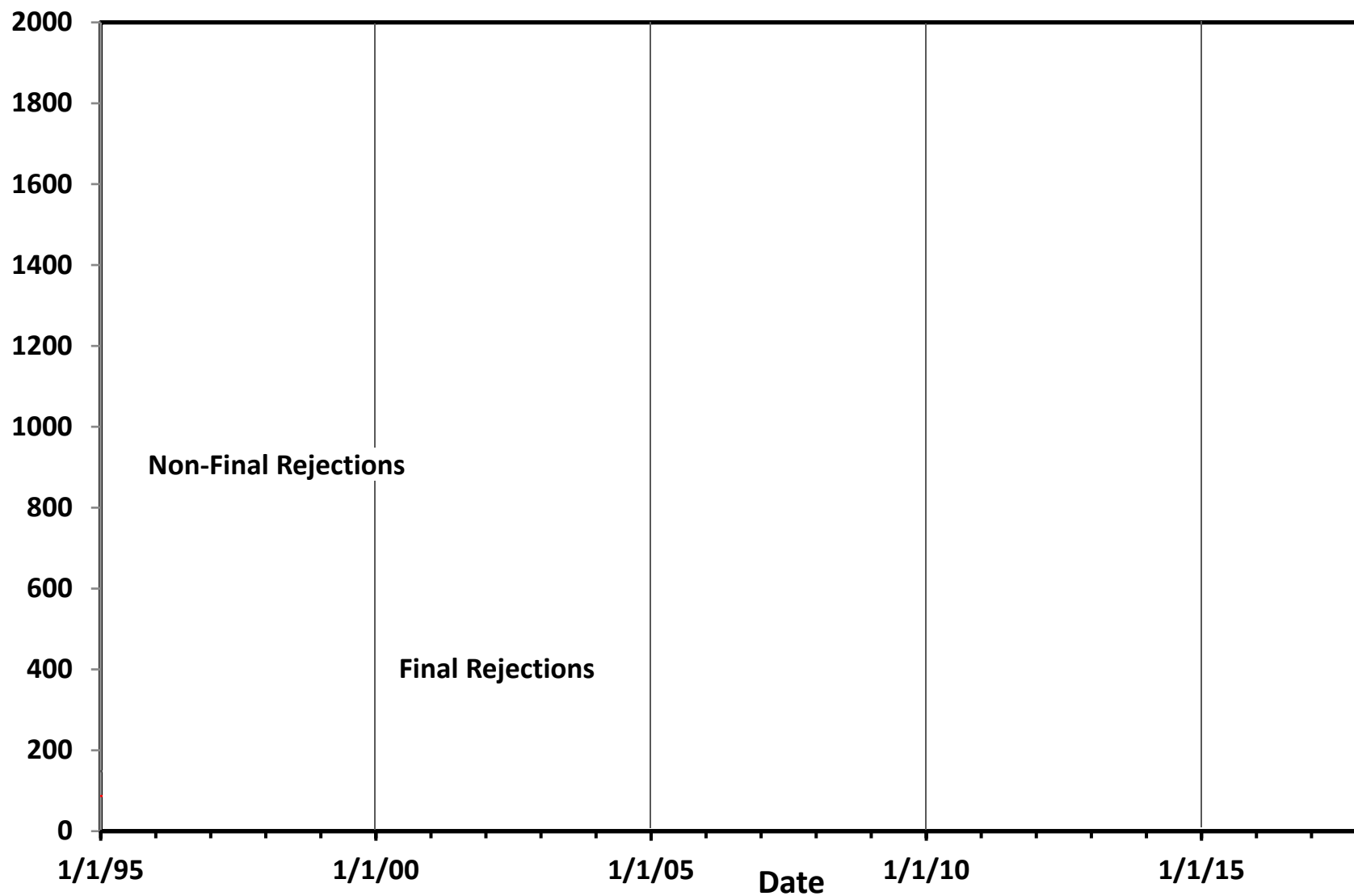


# Hyatt Patent Issuance: 1980-2017



# PTO's Actions in Hyatt's Applications

Cumulative  
Rejections



# PTO's Actions in Hyatt's Applications

## Cumulative Rejections

2000

1800

1600

Hjerpe, Richard

**From:** Hjerpe, Richard  
**Sent:** Monday, January 25, 1999 12:43 PM  
**To:** Jankus, Almis; Hong, Stephen; Breene, John; Von-Buhr, Maria; Tung, Kee; Katbab, Abdollah; Ba, Huynh; Brier, Jeffery; Chow, Dennis; Lao, LunYi; Wu, Xiao; Liang, Regina; Nguyen, Chanh  
**Cc:** Black, Thomas; Powell, Mark; Kim, Matt; Saras, Steven; Razavi, Michael  
**Subject:** FW: BULK FILER 1 UPDATE  
**Attachments:** BF1 TRACKING REPORT 1-23-99.xls; Bulk Filer 01-19-99.xls

A big **THANKS** goes to the examiners in 2770 who have generated the 10 Hyatt actions so far this year. Many of these actions were done just this past biweek. As you can see from the attached tracking report,

A big **THANKS** goes to the examiners in 2770 who have generated the 10 Hyatt actions so far this year. Many of these actions were done just this past biweek. As you can see from the attached tracking report, we need to continue this pace if we are to act on all **92 overdue cases** in 2770 by the end of the 2nd quarter (end of March 1999).

## Non-Final Rejection

800

600

400

200

0

1/1/95

1/1/00

Subject:

Al, Wang, Xi; Asto, Frank; Az, Ahana; Beaudouin, Robert; Black, Thomas; Bost, Dwayne; Boudreau, Leo; Burgess, Glenlon; Cabeca, John; Chan, Eddie; Chan, Jason; Chin, Stephen; Chin, Tommy; Chin, Wellington; Clark, Isaac; Coles, Edward; Craney, Lisa; Decady, Albert; Eisenzopf, Reinhard; Elmore, Reba; Epps, John; Faile, Andrew; Fletcher, Macia; Garber, Wendy; Grant, William; Green, Verlene; Greene, Earlene; Groody, James; Haliz, Tario; Harvey, Jack; Hayes, Gail; Hofsaess, Jeffrey; Horabik, Michael; Hucspeth, David; Isen, Forester; Johnson, Inez; Kim, Matt; Kizou, Hassan; Kuntz, Curtis; Lee, Thomas; Levy, Stuart; MacDonald, Allen; McCloud, Arthur; Moore, David; Oberley, Alvin; Olms, Douglas; Peng, John; Pham, Chi; Powell, Mark; Psitos, Aristotelis; Razavi, Michael; Saras, Steven; Sheikh, Ayaz; Spears, Kimberly; Swann, Tod; Teska, Kevin; Trammell, James; Voeltz, Todd; Wieder, Kenneth; Zelle, Krista

BULK FILER 1 UPDATE

Updates to the report of 1/19/99 are indicated in red.

The two right-most columns of the 1-19-99 report have been added to reflect the cases in which amendments have been received **during FY99 (i.e. since 10/1/98)** and the cases in which actions have been counted/mailed **during FY99 (i.e. since 10/1/98)**. This data has been used for providing the totals per workgroup in the attached tracking report.

A = one amendment/case received in FY99  
 AA = two amendments/case received in FY99  
 Ax = x amendments/case received in FY99  
 M = one action/case-counted/mailed in FY99  
 MM = two actions/case-counted/mailed in FY99

PTX-131

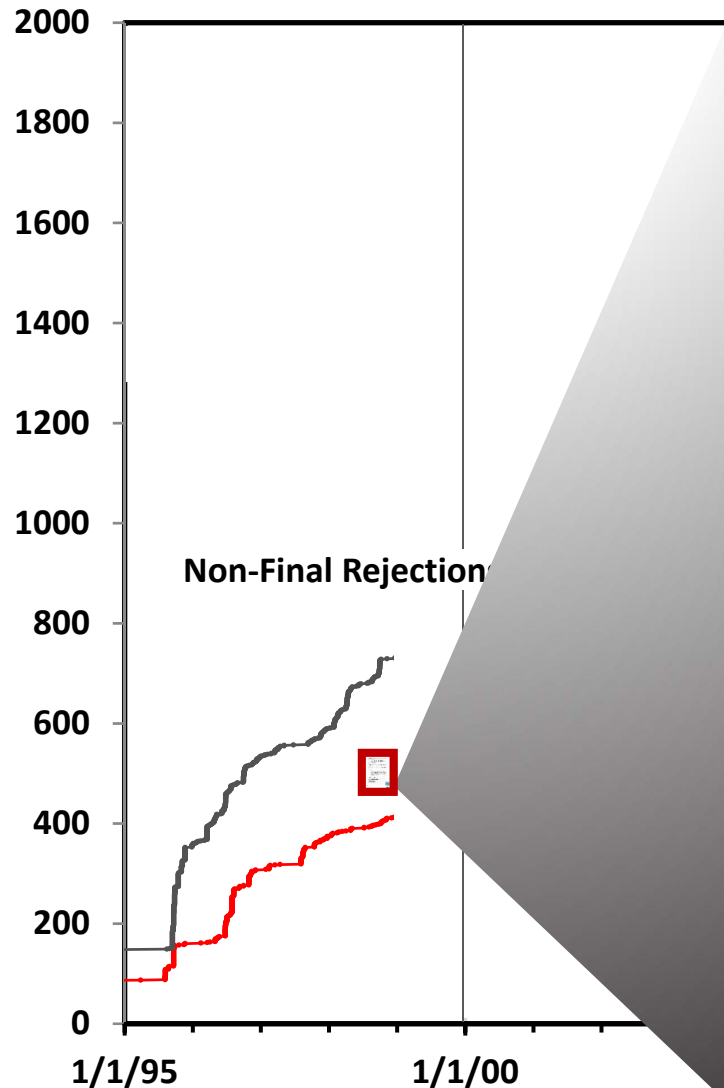
PROTECTED

PTO16-0001126

PTX-131.00001

# PTO's Actions in Hyatt's Applications

## Cumulative Rejections



Hjerpe, Richard

**From:** Hjerpe, Richard  
**Sent:** Monday, January 25, 1999 12:43 PM  
**To:** Jankus, Almis; Hong, Stephen; Breene, John; Von-Buhr, Maria; Tung, Kee; Katbab, Abdollah; Ba, Huynh; Brier, Jeffery; Chow, Dennis; Lao, LunYi; Wu, Xiao; Liang, Regina; Nguyen, Chanh  
**Cc:** Black, Thomas; Powell, Mark; Kim, Matt; Saras, Steven; Razavi, Michael  
**Subject:** FW: BULK FILER 1 UPDATE  
**Attachments:** BF1 TRACKING REPORT 1-23-99.xls; Bulk Filer 01-19-99.xls

A big **THANKS** goes to the examiners in 2770 who have generated the 10 Hyatt actions so far this year. Many of these actions were done just this past biweek. As you can see from the attached tracking report, we need to continue this pace if we are to act on all **92 overdue cases** in 2770 by the end of the 2nd quarter (end of March 1999).

The other attachment provides updated PALM information on the Hyatt cases and indicates the cases in which responses have been forwarded to the examiner in FY99 and the cases in which actions have been counted/mailed in FY99.

**Remember**...the goal is to do at least one Hyatt action every biweek. If everyone can do this, we will meet our goals.

-----Original Message-----

**From:** Hjerpe, Richard  
**Sent:** Saturday, January 23, 1999 5:51 PM  
**To:** Godici, Nicholas; Stone, Jacqueline; Rolla, Joseph; Goldberg, Gerald; Dwyer, James; Ng, Jin; Garrett, Robert; An, Meng-Ai; Asta, Frank; Au, Amelia; Beausoleil, Robert; Black, Thomas; Bost, Dwayne; Boudreau, Leo; Burgess, Glenon; Cabeca, John; Chan, Eddie; Chan, Jason; Chin, Stephen; Chin, Tommy; Chin, Wellington; Clark, Isaac; Coles, Edward; Craney, Lisa; Decady, Albert; Eisenzopf, Reinhard; Elmore, Reba; Epps, John; Faile, Andrew; Fletcher, Macia; Garber, Wendy; Grant, William; Green, Verlene; Greene, Earlene; Groody, James; Haliz, Tario; Harvey, Jack; Hayes, Gail; Hofstass, Jeffrey; Horabik, Michael; Hucspeth, David; Isen, Forester; Johnson, Inez; Kim, Matt; Kizou, Hassan; Kuntz, Curtis; Lee, Thomas; Levy, Stuart; MacDonald, Allen; McCloud, Arthur; Moore, David; Oberley, Alvin; Olms, Douglas; Peng, John; Pham, Chi; Powell, Mark; Psitos, Aristotelis; Razavi, Michael; Saras, Steven; Sheikh, Ayaz; Spears, Kimberly; Swann, Tod; Teska, Kevin; Trammell, James; Voeltz, Todd; Wieder, Kenneth; Zelle, Krista  
**Subject:** BULK FILER 1 UPDATE

Updates to the report of 1/19/99 are indicated in **red**.

The two right-most columns of the 1-19-99 report have been added to reflect the cases in which amendments have been received **during FY99 (i.e. since 10/1/98)** and the cases in which actions have been counted/mailed **during FY99 (i.e. since 10/1/98)**. This data has been used for providing the totals per workgroup in the attached tracking report.

**A** = one amendment/case received in FY99  
**AA** = two amendments/case received in FY99  
**Ax** = x amendments/case received in FY99  
**M** = one action/case-counted/mailed in FY99  
**MM** = two actions/case-counted/mailed in FY99

PTX-131

PROTECTED

PTO16-0001126

PTX-131.00001



# PTO's Actions in Hyatt's Applications

Cumulative  
Rejections

2000

1800

1600

1400

Zimmerman, Mark

From: Zimmerman, Mark  
Sent: Monday, August 12, 2002 9:13 AM  
To: Hjerpe, Richard; Wu, Xiao; Liang, Regina; Nguyen, Chanh; Shankar, Vijay; Mengistu, Amare; Nguyen, Phu; Chow, Dennis; Brier, Jeffery; Lao, LunYi; Jankus, Almis  
Cc: Razavi, Michael; Saras, Steven; Shalwala, Bipin; Bella, Matthew  
Subject: RE: Hyatt Actions Due no later than 8-30-2002

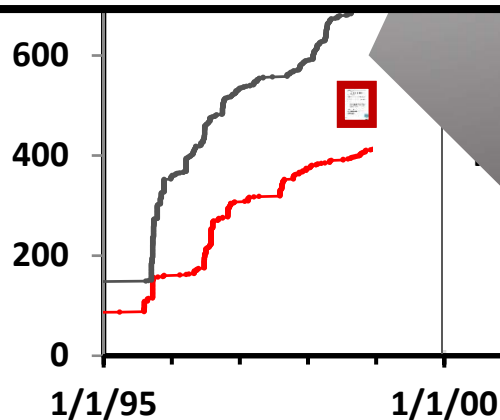
Hey. We have one hit already and at least two on deck.

-----Original Message-----

From: Hjerpe, Richard  
Sent: Sunday, August 11, 2002 1:11 PM  
To: Wu, Xiao; Liang, Regina; Nguyen, Chanh; Shankar, Vijay; Mengistu, Amare; Nguyen, Phu; Chow, Dennis; Brier, Jeffery; Lao, LunYi; Jankus, Almis

*We are currently 10 for 26 for a batting average of .385 .*

*That is really good for the major leagues, but for us, we need to be batting 1.000!*



the on-deck circle.

*Remember, you can not win if you do not play!!!*

<< File: 2670 Hyatt Actions Needed by 8-30-02  
DDD.xls >>

PTX-615

PROTECTED

PTO16-0000182

PTX-615.00001

# PTO's Actions in Hyatt's Applications

Cumulative  
Rejections

2000

1800

1600

1400

1200

1000

800

600

400

200

0

1/1/95

1/1/00

Non-Final Rejection

Zimmerman, Mark

From: Zimmerman, Mark  
Sent: Monday, August 12, 2002 9:13 AM  
To: Hjerpe, Richard; Wu, Xiao; Liang, Regina; Nguyen, Chanh; Shankar, Vijay; Mengistu, Amare; Nguyen, Phu; Chow, Dennis; Brier, Jeffery; Lao, LunYi; Jankus, Almis  
Cc: Razavi, Michael; Saras, Steven; Shalwala, Bipin; Bella, Matthew  
Subject: RE: Hyatt Actions Due no later than 8-30-2002

Hey. We have one hit already and at least two on deck.

-----Original Message-----

From: Hjerpe, Richard  
Sent: Sunday, August 11, 2002 1:11 PM  
To: Wu, Xiao; Liang, Regina; Nguyen, Chanh; Shankar, Vijay; Mengistu, Amare; Nguyen, Phu; Chow, Dennis; Brier, Jeffery; Lao, LunYi; Jankus, Almis  
Cc: Razavi, Michael; Saras, Steven; Shalwala, Bipin; Zimmerman, Mark; Bella, Matthew  
Subject: Hyatt Actions Due no later than 8-30-2002

**[Hjerpe, Richard]** << File: 2670 Hyatt Actions Needed by 8-30-02 DDD.xls >>

*We are currently 10 for 26 for a batting average of .385 .*

*That is really good for the major leagues, but for us, we need to be batting 1.000!*

*And so far, the 2 hitters in 2671 have not stepped out of the on-deck circle.*

*Remember, you can not win if you do not play!!!*

<< File: 2670 Hyatt Actions Needed by 8-30-02 DDD.xls >>

PTX-615

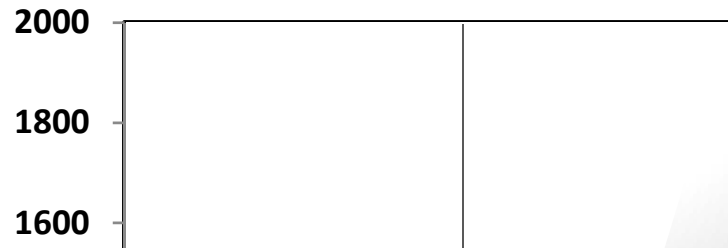
PROTECTED

PTO16-0000182

PTX-615.00001

# PTO's Actions in Hyatt's Applications

Cumulative  
Rejections



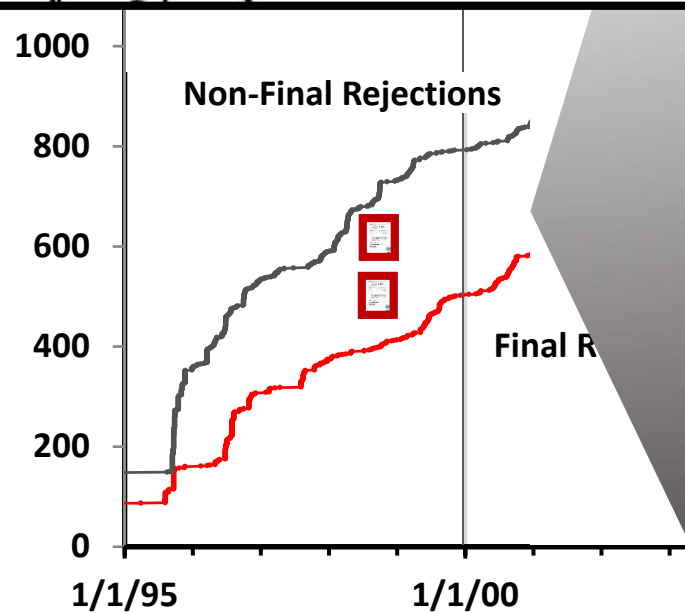
Decision on Petition

Page 2

However, in view of the lengthy prosecution in the instant application, the file is being forwarded to the examiner for immediate action as appropriate. Any delay caused petitioner in the treatment of the petition and the Appeal Brief is regretted.

*[Signature]* for Joe Rolla  
Joseph J. Rolla, Jr., Director  
Technology Center 2600

However, in view of the lengthy prosecution in the instant application, the file is being forwarded to the examiner for immediate action as appropriate. Any delay caused petitioner in the treatment of the petition and the Appeal Brief is regretted.



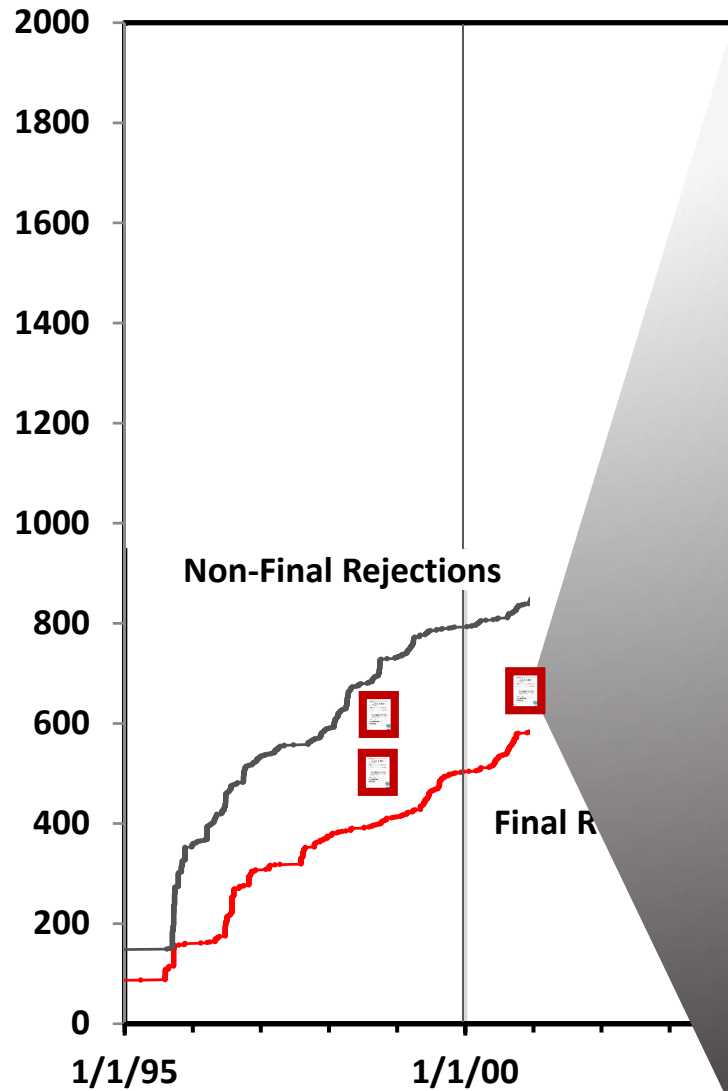
PROTECTED

PTO7-0106660  
PTX-165.00002



# PTO's Actions in Hyatt's Applications

Cumulative  
Rejections



Decision on Petition

Page 2

However, in view of the lengthy prosecution in the instant application, the file is being forwarded to the examiner for immediate action as appropriate. Any delay caused petitioner in the treatment of the petition and the Appeal Brief is regretted.

*[Signature]* for Joe Rolla  
Joseph J. Rolla, Jr., Director  
Technology Center 2600  
Communications

PROTECTED

PTO7-0106660  
PTX-165.00002

# PTO's Actions in Hyatt's Applications

Cumulative  
Rejections

2000

1800

From: [Nappi, Robert](#)  
To: [Yoo, Do](#)  
Cc: [Seidel, Richard](#); [Hajec, Donaki T.](#)  
Subject: RE: Hyatt case 05/302,771  
Date: Wednesday, May 08, 2002 11:23:17 AM

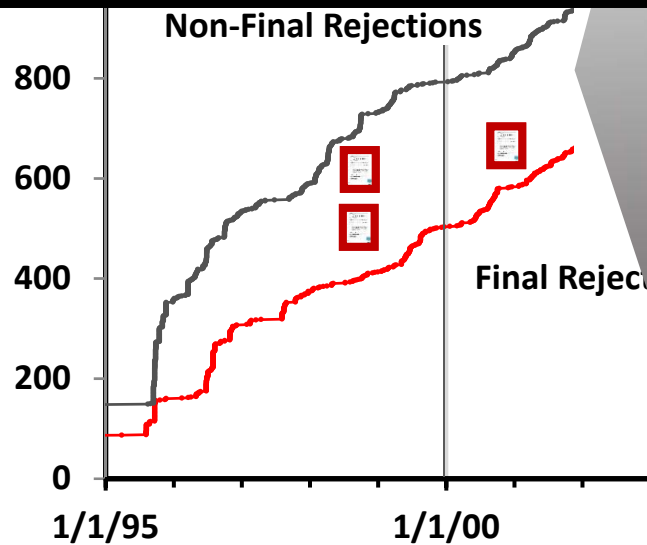
Yoo

We are done with the case, it is ready for issue complete with that most ancient form of allowance a blue slip (no examiner's name).

I have been waiting for a resolution concerning whether it is cleared for issue by "the powers to be" who

We are done with the case, it is ready for issue complete with that most ancient form of allowance a blue slip (no examiner's name).

I have been waiting for a resolution concerning whether it is cleared for issue by "the powers to be" who have been holding up the issue for the past several years. Also I was waiting for a decision as to who is going to issue the case (which is why it is still on Allen's docket).



Do Hyun Yoo  
Supervisory Patent Examiner  
TC 2100 - AU 2187  
Telephone (703) 308-4908

PROTECTED

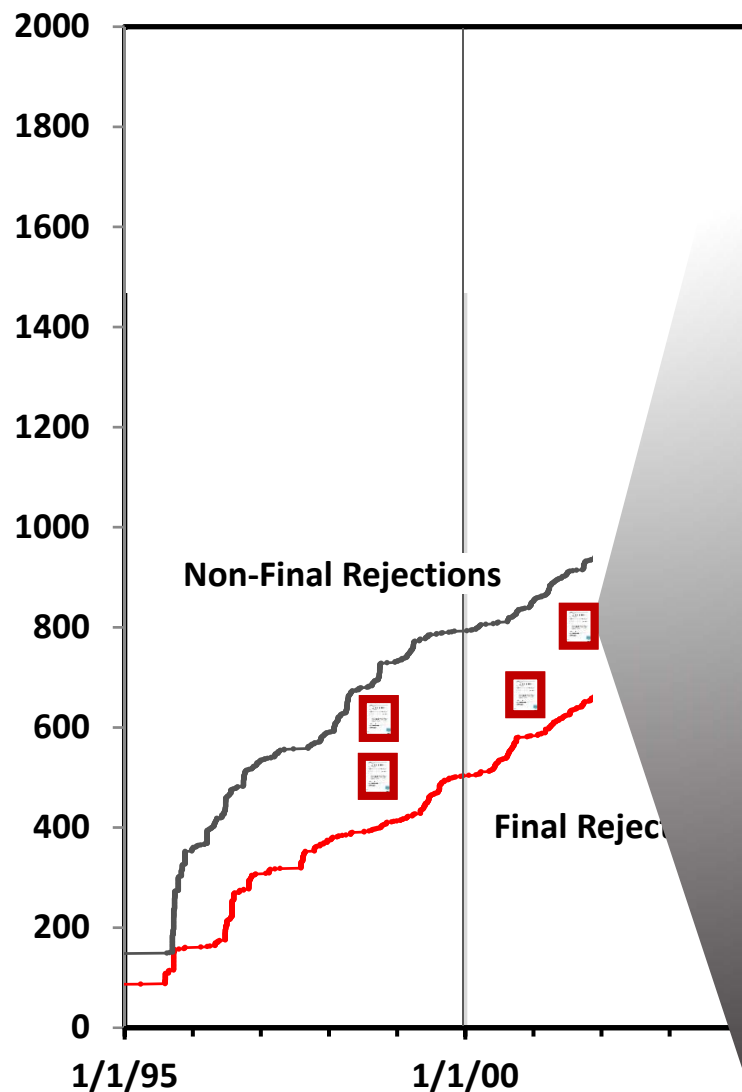
PTX-133

PTO16-0001325

PTX-133.00001

# PTO's Actions in Hyatt's Applications

## Cumulative Rejections



From: [Nappi, Robert](#)  
 To: [Yoo, Do](#)  
 Cc: [Seidel, Richard](#); [Hajec, Donaki T.](#)  
 Subject: RE: Hyatt case 05/302,771  
 Date: Wednesday, May 08, 2002 11:23:17 AM

Yoo

We are done with the case, it is ready for issue complete with that most ancient form of allowance a blue slip (no examiner's name).

I have been waiting for a resolution concerning whether it is cleared for issue by "the powers to be" who have been holding up the issue for the past several years. Also I was waiting for a decision as to who is going to issue the case (which is why it is still on Allen's docket).

If you know anything more please let me know I'd love to get the thing out of the office.

Rob

-----Original Message-----

From: Yoo, Do  
 Sent: Wednesday, May 08, 2002 10:42 AM  
 To: Nappi, Robert; Hajec, Don  
 Subject: Hyatt case 05/302,771

Is the examiner working on this case? I want to know the status of the case. Note that the case is still under Allen's docket and was not charged to the examiner in TC 2800. Please let me know the updated status of the case ASAP. Thanks.

Do Hyun Yoo  
 Supervisory Patent Examiner  
 TC 2100 - AU 2187  
 Telephone (703) 308-4908

PTX-133

PROTECTED

PTO16-0001325

PTX-133.00001

UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA

GILBERT P. HYATT,  
Plaintiff,  
v.  
JOSEPH MATAL,  
Defendant.

Civil Action No. 1:09-cv-1864 (RCL)  
Civil Action No. 1:09-cv-1869 (RCL)  
Civil Action No. 1:09-cv-1872 (RCL)  
Civil Action No. 1:05-cv-2310 (RCL)

DEFENDANT'S SECOND SUPPLEMENTAL RESPONSE TO  
PLAINTIFF'S INTERROGATORY NO. 4

Pursuant to Federal Rule of Civil Procedure 33, Defendant, Joseph Matal,<sup>1</sup> performing  
the functions and duties of the Under Secretary of Commerce for Intellectual Property and

RESPONSE TO INTERROGATORY NO. 5

Defendant objects to this Interrogatory as it seeks information that has little or no  
relevance to the issue of prosecution laches, particularly in view of the fact that, as the Court  
recognized, USPTO delay cannot excuse Mr. Hyatt's delay. Defendant further objects to this  
Interrogatory as it seeks information and documents subject to the deliberative process privilege.  
Defendant further objects to this Interrogatory as it seeks information contained in the  
administrative records of Mr. Hyatt's patent applications.

Subject to and without waiving the foregoing objections, the USPTO has no further  
information to provide other than what is included in the administrative record and the  
documents it has produced in response to Document Request No. 7.

FIRST SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 5

The following individuals were involved in the decision to withdraw from issuance patent  
application serial no. 05/849,812: **Bruce Lehman**; Nick Godici, Director, Group 2600; Examiner  
Raulfe Zache; Examiner Jeffrey Brier; SPE Thomas Lee; Joe Rolla, Director, Group 2300.

<sup>1</sup> U.S. Secretary of Commerce Wilbur Ross named U.S. Patent and Trademark Office (USPTO)  
Associate Solicitor Joseph Matal to perform the functions and duties of the Under Secretary of  
Commerce for Intellectual Property and Director of the USPTO. The position became effective  
June 7, 2017, and followed the resignation of former USPTO Director Michelle K. Lee on June  
6, 2017.

PTX-020

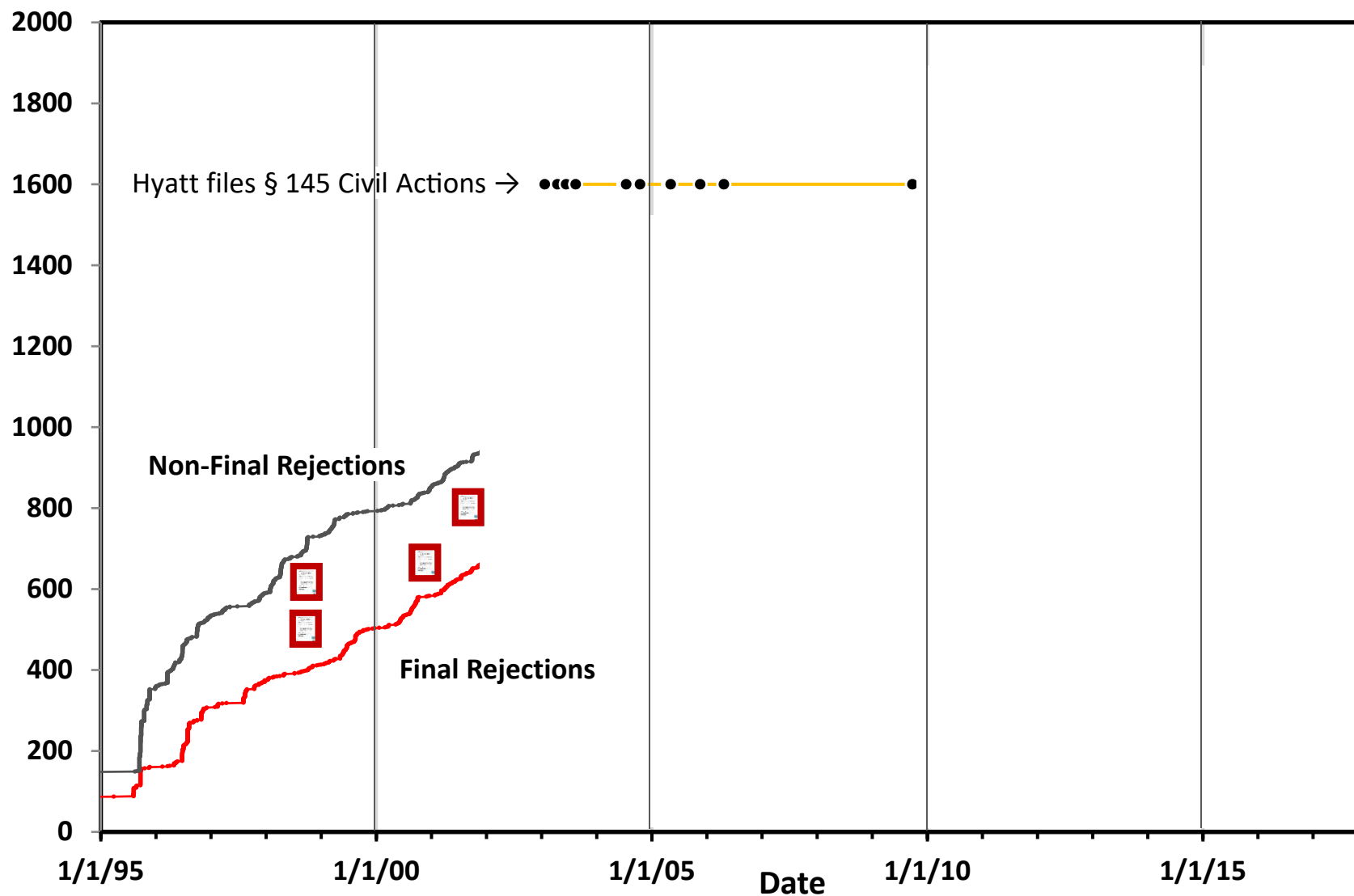
PTX-020.00001

Reon Time, TC 2600; Director Gerald Goldberg, TC 2700.

The following individuals were involved in the decision to withdraw from issuance patent  
application serial no. 05/849,812: **Bruce Lehman**; Nick Godici, Director, Group 2600; Examiner  
Raulfe Zache; Examiner Jeffrey Brier; SPE Thomas Lee; Joe Rolla, Director, Group 2300.

# PTO's Actions in Hyatt's Applications

Cumulative  
Rejections



# PTO's Actions in Hyatt's Applications

Cumulative  
Rejections  
2000

Hjerpe, Richard

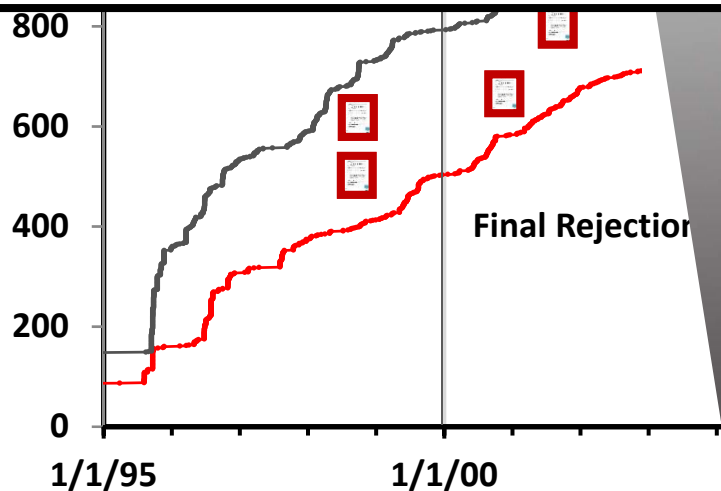
Yuk, Yuk, Yuk...

Gilbert trying to defend himself in the US Supreme Court???...there is some humor in here somewhere....maybe justice will prevail after all!

1200

-----Original Message-----  
From: Hjerpe, Richard  
Sent: Wednesday, February 26, 2003 12:40 PM  
To: MacDonald, Allen

I have new-found respect for the wonderful state of California and tax collectors everywhere!



-----Original Message-----  
From: MacDonald, Allen  
Sent: Wednesday, February 26, 2003 11:29 AM  
To: Hjerpe, Richard; Falic, Andrew; Powell, Mark; Grant, William; Teska, Kevin  
Cc: Bragdon, Reginald  
Subject: Hyatt article from today's press clips

Kasler, Dale; Sacramento Bee; February 24, 2003

Inventor, state tangle in high court over taxes Now living in Nevada, he decries California's pursuit of more than \$20 million.

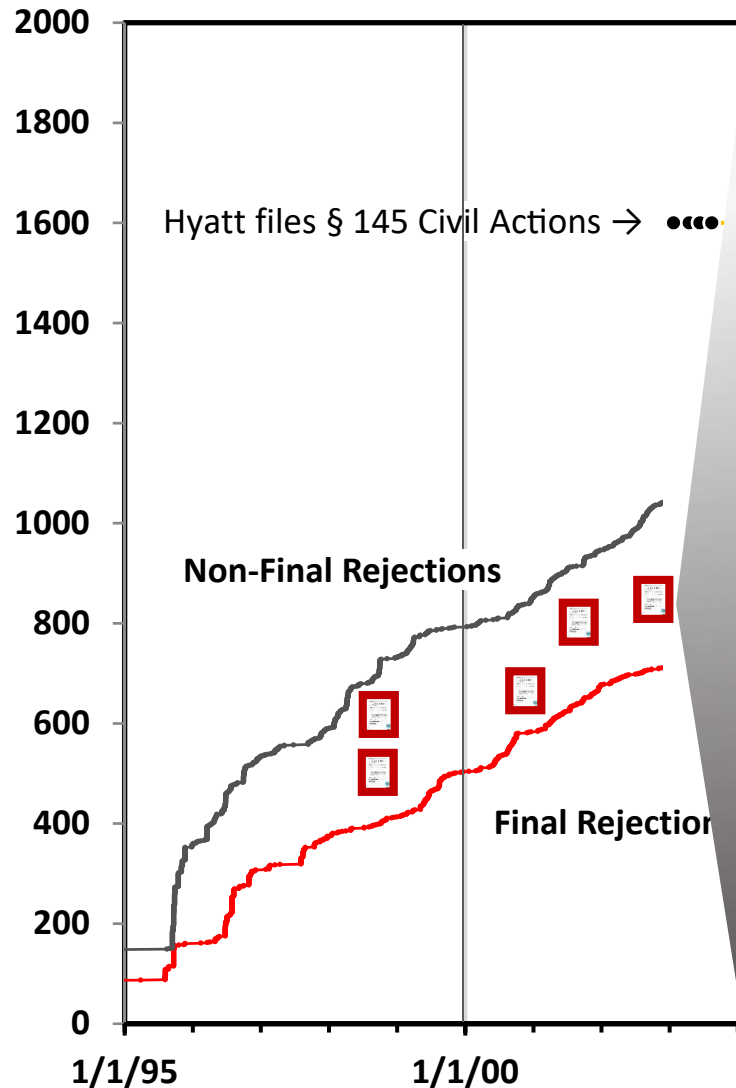
Gilbert Hyatt has always been willing to fight the establishment. He did it in 1990, when he was an obscure computer engineer in Southern California. That year he stunned the high-tech world by winning the patent on the microprocessor, the chip that forms the guts of a personal computer. Though he was effectively stripped of his title six years later, Hyatt's moment of glory as the "the father of the microprocessor" earned him millions of dollars - and set the stage for his latest battle. This time Hyatt, who now lives in Las Vegas, is taking on the state of California.

PROTECTED

PTO16-0000837  
PTX-124.00005

# PTO's Actions in Hyatt's Applications

Cumulative  
Rejections



Hjerpe, Richard

**From:** Hjerpe, Richard  
**Sent:** Wednesday, February 26, 2003 2:19 PM  
**To:** Chin, Wellington; Chin, Tommy  
**Subject:** FW: Hyatt article from today's press clips

Yuk, Yuk, Yuk...

-----Original Message-----

**From:** Hjerpe, Richard  
**Sent:** Wednesday, February 26, 2003 12:45 PM  
**To:** Rolla, Joseph; Bella, Matthew; Razavi, Michael; Saras, Steven; Shalwala, Bipin; Zimmerman, Mark  
**Subject:** FW: Hyatt article from today's press clips

Gilbert trying to defend himself in the US Supreme Court???...there is some humor in here somewhere....maybe justice will prevail after all!

-----Original Message-----

**From:** Hjerpe, Richard  
**Sent:** Wednesday, February 26, 2003 12:40 PM  
**To:** MacDonald, Allen  
**Subject:** RE: Hyatt article from today's press clips

I have new-found respect for the wonderful state of California and tax collectors everywhere!

And the USPTO has "come to its senses"?

This is just too good...thanks, Allen.

-----Original Message-----

**From:** MacDonald, Allen  
**Sent:** Wednesday, February 26, 2003 11:29 AM  
**To:** Hjerpe, Richard; Falic, Andrew; Powell, Mark; Grant, William; Teska, Kevin  
**Cc:** Bragdon, Reginald  
**Subject:** Hyatt article from today's press clips

Kasler, Dale; Sacramento Bee; February 24, 2003

Inventor, state tangle in high court over taxes Now living in Nevada, he decries California's pursuit of more than \$20 million.

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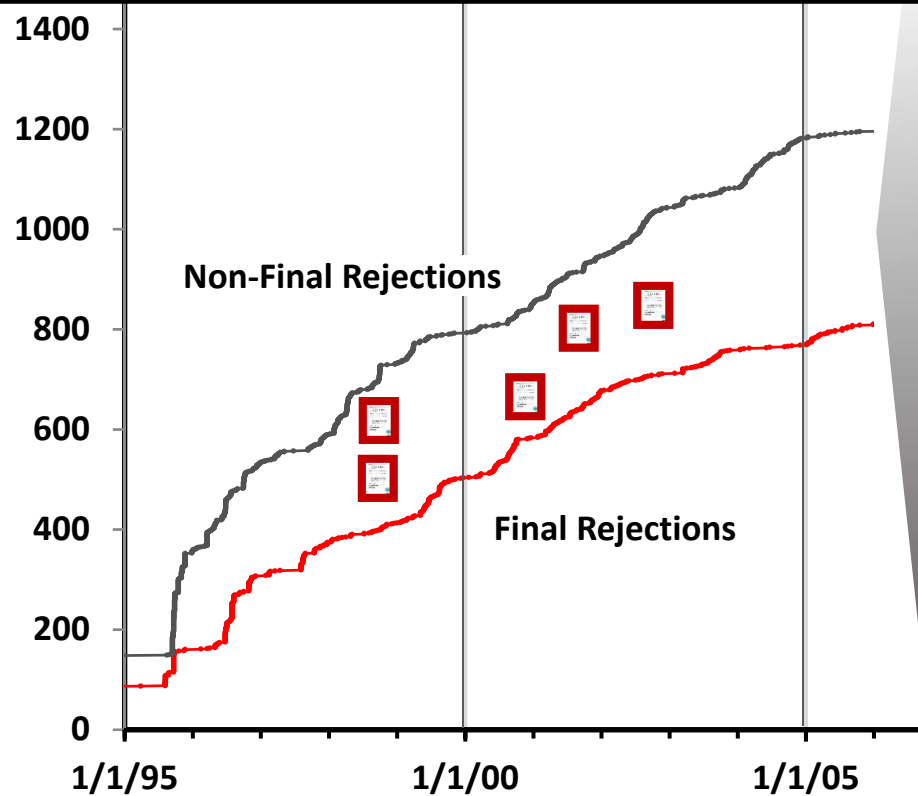
PROTECTED

PTO16-0000837  
PTX-124.00005

# PTO's Actions in Hyatt's Applications

Cumulative  
Rejections

As Rich mentioned we are on hold.



-----Original Message-----

**From:** Eisenzopf, Reinhard  
**Sent:** Wednesday, April 05, 2006 12:21 PM  
**To:** Razavi, Michael; Brier, Jeffery  
**Cc:** Christensen, Andrew; Hjerpe, Richard  
**Subject:** RE: BPAI Decision Reconsideration - 08/456,263;08/471,712;08/471,925;08/479,087;08/479,088

I know.

I want to know what is being done>>>

-----Original Message-----

**From:** Razavi, Michael  
**Sent:** Wednesday, April 05, 2006 11:26 AM  
**To:** Eisenzopf, Reinhard; Brier, Jeffery  
**Cc:** Christensen, Andrew; Hjerpe, Richard  
**Subject:** RE: BPAI Decision Reconsideration - 08/456,263;08/471,712;08/471,925;08/479,087;08/479,088

These are all Hyatts.

-----Original Message-----

**From:** Eisenzopf, Reinhard  
**Sent:** Wednesday, April 05, 2006 7:24 AM  
**To:** Razavi, Michael; Brier, Jeffery  
**Cc:** Christensen, Andrew; Hjerpe, Richard  
**Subject:** BPAI Decision Reconsideration - 08/456,263;08/471,712;08/471,925;08/479,087;08/479,088

I am checking on the status of these cases. A decision on reconsideration of the BPAI Decision has been rendered.

Please let me know when an action on this case will be done. I am not sure who is overseeing these Hyatt cases now.

Thanks, Rein

PTX-272

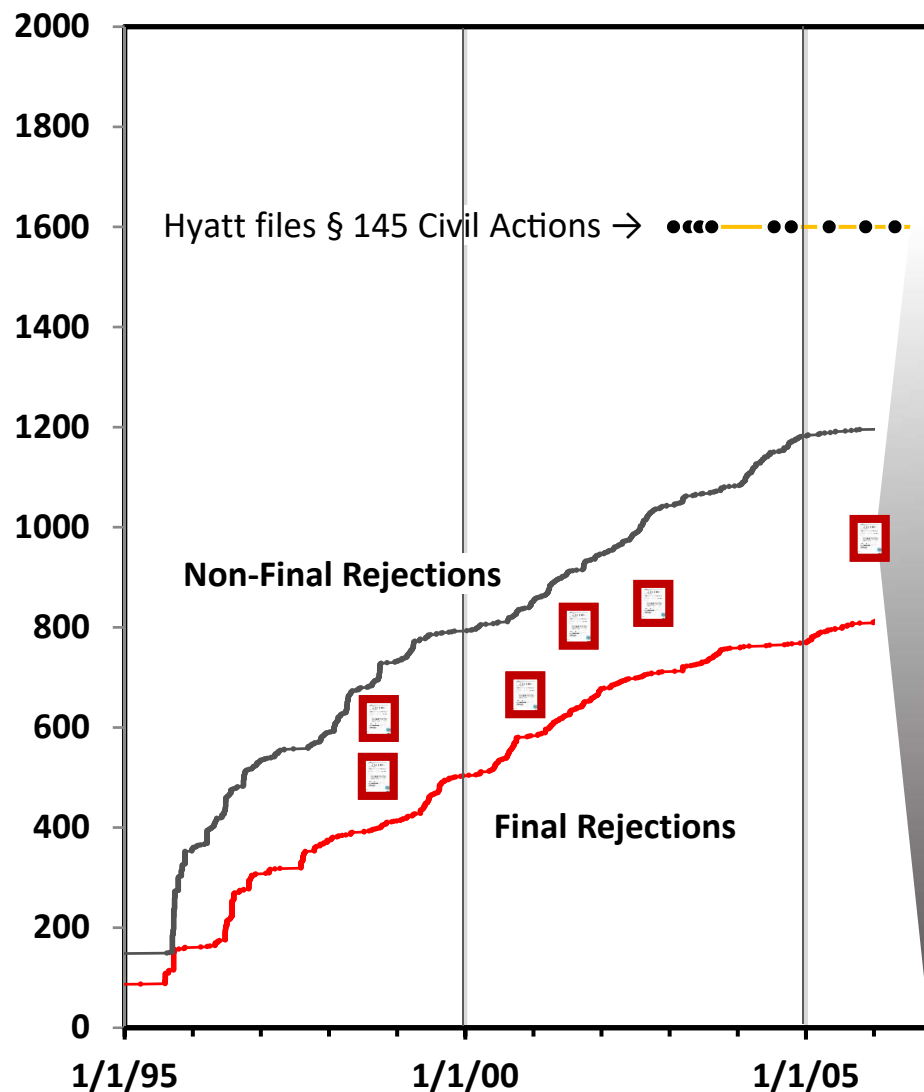
PROTECTED

PTO16-0000348  
 PTX-272.00001



# PTO's Actions in Hyatt's Applications

## Cumulative Rejections



Razavi, Michael

**From:** Razavi, Michael  
**Sent:** Wednesday, April 05, 2006 12:32 PM  
**To:** Eisenzopf, Reinhard; Brier, Jeffery  
**Cc:** Christensen, Andrew; Hjerpe, Richard  
**Subject:** RE: BPAI Decision Reconsideration - 08/456,263;08/471,712;08/471,925;08/479,087;08/479,088

As Rich mentioned **we are on hold.**

-----Original Message-----

**From:** Eisenzopf, Reinhard  
**Sent:** Wednesday, April 05, 2006 12:21 PM  
**To:** Razavi, Michael; Brier, Jeffery  
**Cc:** Christensen, Andrew; Hjerpe, Richard  
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**Sent:** Wednesday, April 05, 2006 11:26 AM  
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**Cc:** Christensen, Andrew; Hjerpe, Richard  
**Subject:** RE: BPAI Decision Reconsideration - 08/456,263;08/471,712;08/471,925;08/479,087;08/479,088

These are all Hyatts.

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Thanks, Rein

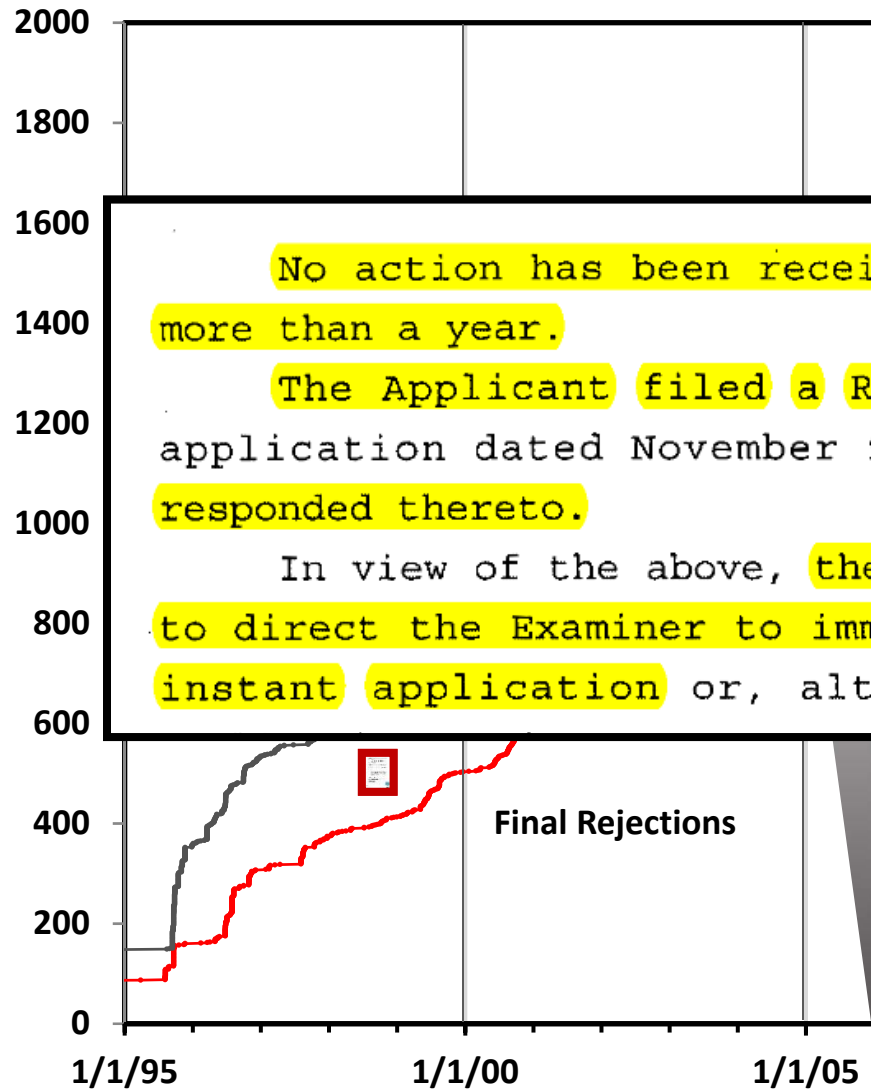
PTX-272

PROTECTED

PTO16-0000348  
 PTX-272.00001

# PTO's Actions in Hyatt's Applications

Cumulative  
Rejections



No action has been received in the instant application in more than a year.

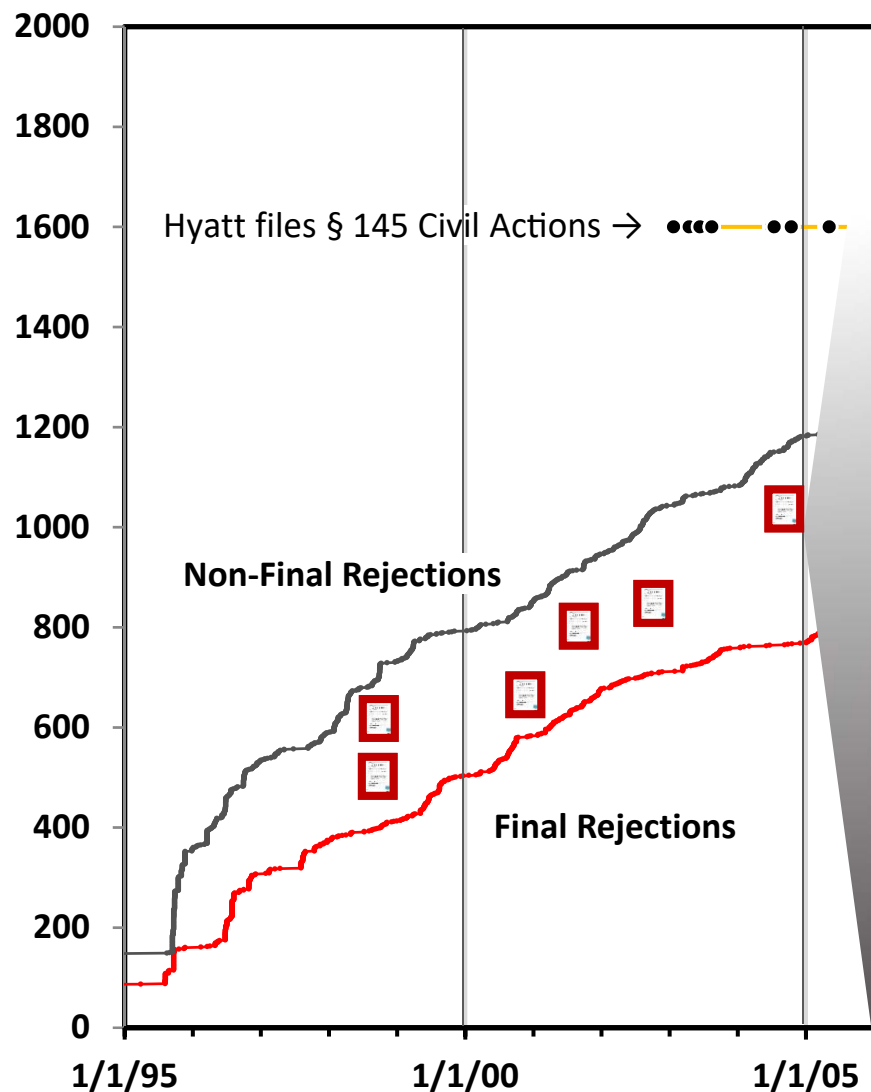
No action has been received in the instant application in more than a year.

The Applicant filed a Request For Status in the instant application dated November 9, 2004 but the Examiner has not responded thereto.

In view of the above, the Commissioner is hereby petitioned to direct the Examiner to immediately prepare an action in the instant application or, alternatively, to pass the instant

# PTO's Actions in Hyatt's Applications

## Cumulative Rejections



No action has been received in the instant application in more than a year.

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In view of the above, the Commissioner is hereby petitioned to direct the Examiner to immediately prepare an action in the instant application or, alternatively, to pass the instant application to issue.

Because this petition seeks to invoke the Supervisory Authority of the Commissioner under 37 CFR 1.181(a)(3), a petition fee is not required and thus a fee authorization is not needed.

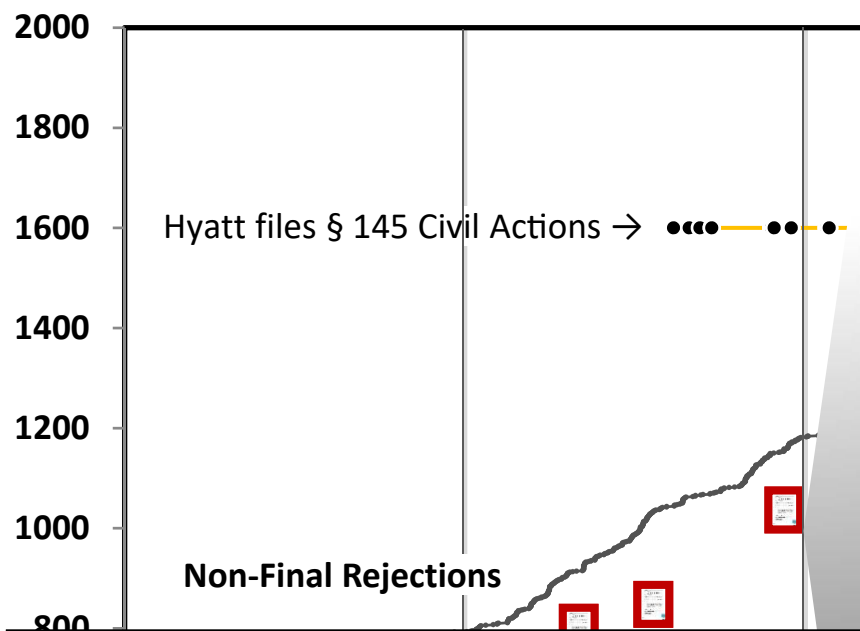
Respectfully submitted,

Dated: January 20, 2005

*Gilbert P. Hyatt*  
 Gilbert P. Hyatt  
 Registration No. 27,647  
 P.O. Box 81230  
 Las Vegas, NV 89180  
 Phone (702) 871-9899

# PTO's Actions in Hyatt's Applications

Cumulative  
Rejections



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. BOX 1450  
ALEXANDRIA, VA 22313-1450  
www.uspto.gov

MAIL

MAR 09 2005

DIRECTOR OFFICE  
TECHNOLOGY CENTER 2600

DECISION  
ON PETITION

GILBERT P HYATT  
PO BOX 81230  
LAS VEGAS NV 89180

In re Application of: :  
Hyatt :  
Application Serial No.: 08/470,084 :  
Filed: June 6, 1995 :  
For: MEMORY ARCHITECTURE HAVING A :  
MULTIPLE BUFFER OUTPUT ARRANGEMENT :

This is a decision on the petition, filed on January 21, 2005 under 37 C.F.R. §1.181 requesting an expedited action on the merits. This petition has been considered a request to affirm that this application is under "special" status in accordance with 37 CFR 1.102.

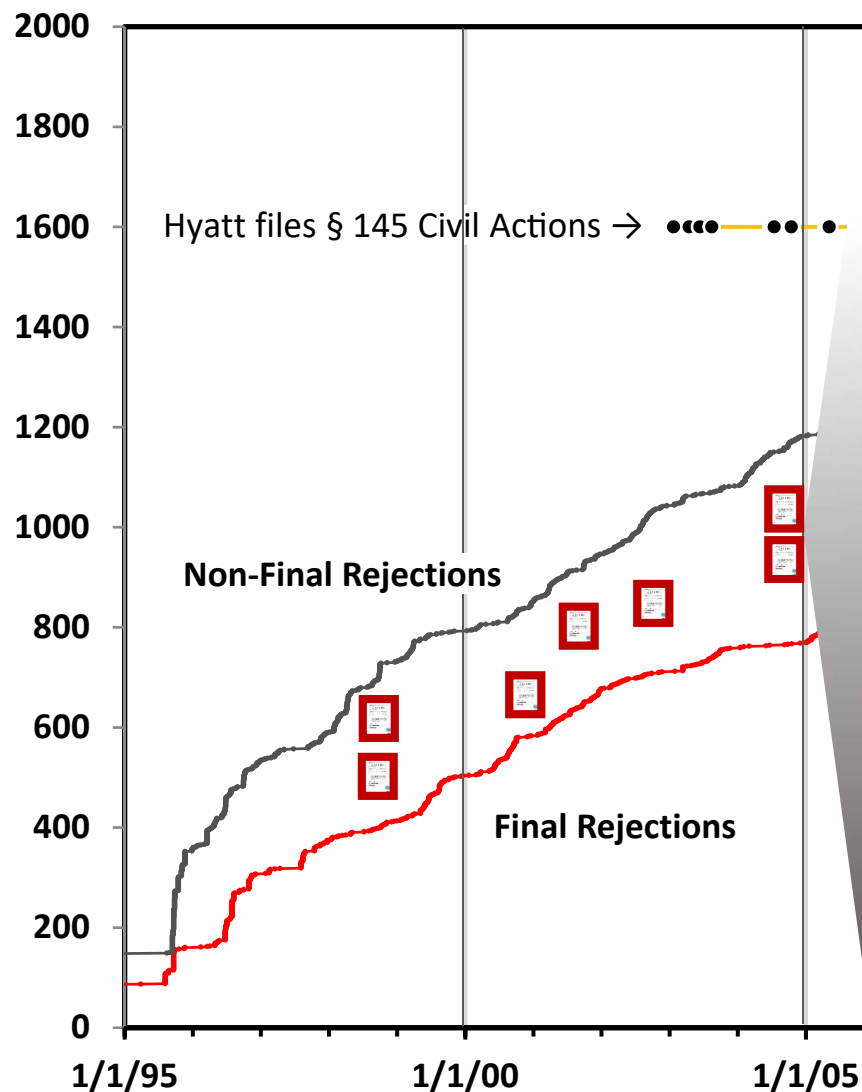
Petitioner provides support for the request for expedited action with reference to MPEP sections 708 and 708.01. The latter section specifically states that applications pending over 5 years should be considered special. Since this application by virtue of its prolonged pendency is already special in accordance with PTO policy, Petitioner's

Petitioner provides support for the request for expedited action with reference to MPEP sections 708 and 708.01. The latter section specifically states that applications pending over 5 years should be considered special. Since this application by virtue of its prolonged pendency is already special in accordance with PTO policy, Petitioner's request is moot.

The examiner will be notified that this application should be considered as "special" and appropriate for expedited action.

# PTO's Actions in Hyatt's Applications

## Cumulative Rejections



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. BOX 1450  
ALEXANDRIA, VA 22313-1450  
www.uspto.gov

MAIL

MAR 09 2005

DIRECTOR OFFICE  
TECHNOLOGY CENTER 2600DECISION  
ON PETITION

GILBERT P HYATT  
PO BOX 81230  
LAS VEGAS NV 89180

In re Application of: :  
Hyatt :  
Application Serial No.: 08/470,084 :  
Filed: June 6, 1995 :  
For: MEMORY ARCHITECTURE HAVING A :  
MULTIPLE BUFFER OUTPUT ARRANGEMENT :

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Petitioner provides support for the request for expedited action with reference to MPEP sections 708 and 708.01. The latter section specifically states that applications pending over 5 years should be considered special. Since this application by virtue of its prolonged pendency is already special in accordance with PTO policy, Petitioner's request is moot.

The examiner will be notified that this application should be considered as "special" and appropriate for expedited action.

The petition is **DISMISSED**.

Kenneth A. Wieder  
Special Program Examiner  
Technology Center 2600  
Communications

PROTECTED

PTO12-0033950

# PTO's Actions in Hyatt's Applications

Cumulative  
Rejections

2000

1800

1600

1400

1200

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400

200

0

1/1/95

1/1/00

1/1/05

Non-Final Rejections

Final Rejections

The PTO responded with a "DECISION ON PETITION" stating that "[t]he examiner will be notified that this application should be considered as 'special' and appropriate for expedited action" and then the PTO dismissed the petition. However:

1. the Applicant did not receive a paper notifying the Examiner to that effect and
2. the Applicant did not receive an action on the merits.

authorization is not needed.

In view of the above, the Commissioner is hereby petitioned for a second time to direct the Examiner to immediately prepare an action in the instant application or,

Dated: March 28, 2007

*Gilbert P. Hyatt*  
 Gilbert P. Hyatt  
 Registration No. 27,647  
 P.O. Box 81230  
 Las Vegas, NV 89180  
 Phone (702) 871-9899

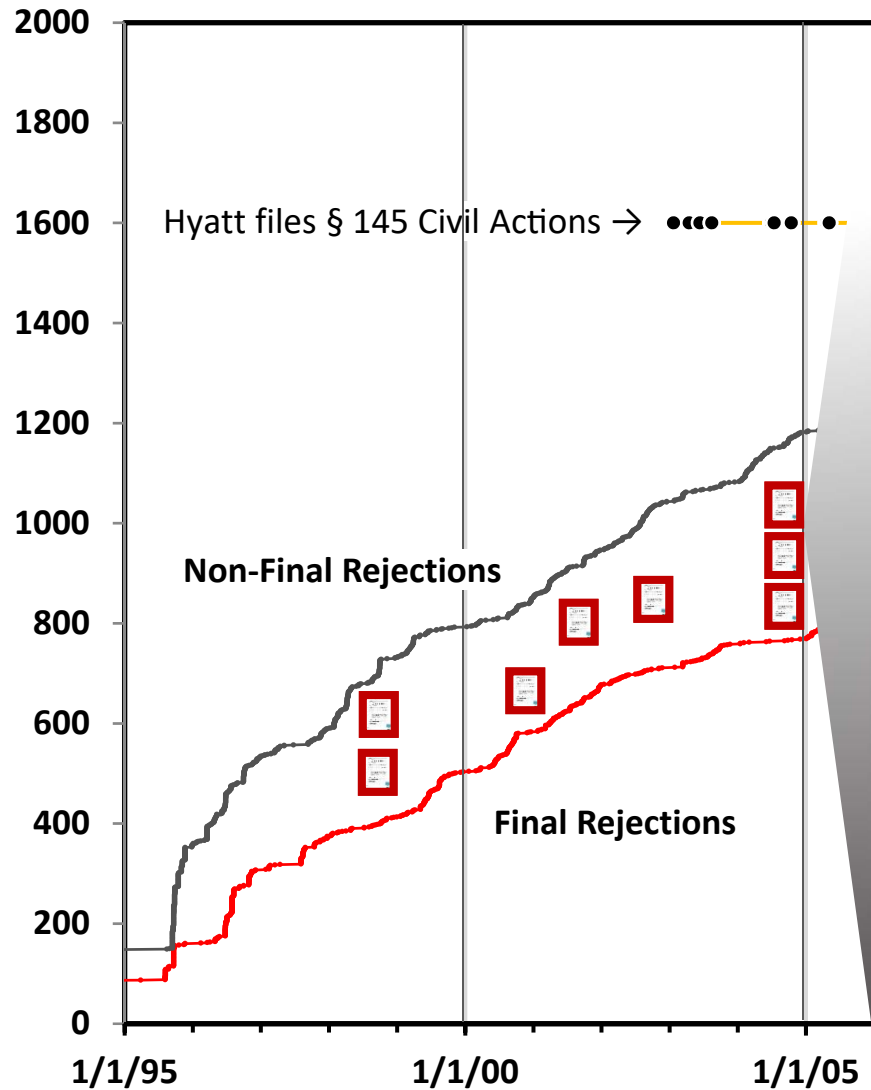
-2-

PROTECTED

PTO12-0033939

# PTO's Actions in Hyatt's Applications

## Cumulative Rejections



Petition For An Action On The Merits dated January 20, 2005. The Applicant pointed out therein that "[n]o action has been received in the instant application in more than a year".

The PTO responded with a "DECISION ON PETITION" stating that "[t]he examiner will be notified that this application should be considered as 'special' and appropriate for expedited action" and then the PTO dismissed the petition. However:

1. the Applicant did not receive a paper notifying the Examiner to that effect and
2. the Applicant did not receive an action on the merits.

Furthermore, the "DECISION ON PETITION" was not directed to the remedy that the Applicant was petitioned for, which should have been directed to an action on the merits.

In view of the above, the Commissioner is hereby petitioned for a second time to direct the Examiner to immediately prepare an action in the instant application or, alternatively, to pass the instant application to issue.

Because this petition seeks to invoke the Supervisory authority of the Commissioner under 37 CFR 1.181(a)(3), a petition fee is not required and thus a fee authorization is not needed.

CERTIFICATION OF MAILING BY EXPRESS MAIL. I hereby certify that this correspondence is being deposited with the United States Postal Service with Express Mail post office to addressee service under 37 CFR 1.10, postage prepaid, in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 with the express mail label number EV 749579893 on March 28, 2007.

Dated: March 28, 2007

Respectfully submitted,

*Gilbert P. Hyatt*  
 Gilbert P. Hyatt  
 Registration No. 27,647  
 P.O. Box 81230  
 Las Vegas, NV 89180  
 Phone (702) 871-9899

-2-

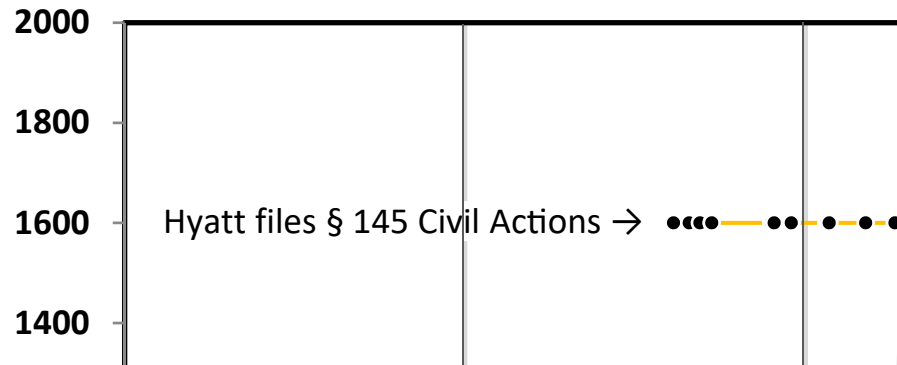
PROTECTED

PTO12-0033939



# PTO's Actions in Hyatt's Applications

Cumulative  
Rejections



3621 ifv

**PTO**  
OCT 15 2007  
PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	)	
GILBERT P. HYATT	)	Group Art Unit: 3621
Serial No.: 07/289,355	)	Examiner: Brian Werner
Filed: December 22, 1988	)	
Docket No.: 321	)	

The Applicant had a conference on November 16, 2006 with the Director of T.C. 2600, Andrew Christensen, who had responsibility for some of his applications. The Applicant described the issue of the PTO “recycling” of his patent applications that have rejections reversed by the Board and particularly described the history of two patent applications that were in T.C. 2600; including the instant application. The Applicant pointed out “the scenario of applications going round and round from the examining groups to the Board and then back to the examining groups and then back to the Board.” The Director confirmed that this was the policy that the PTO was following.

0 1/1/95 1/1/00 1/1/05

-1-

PTX-054

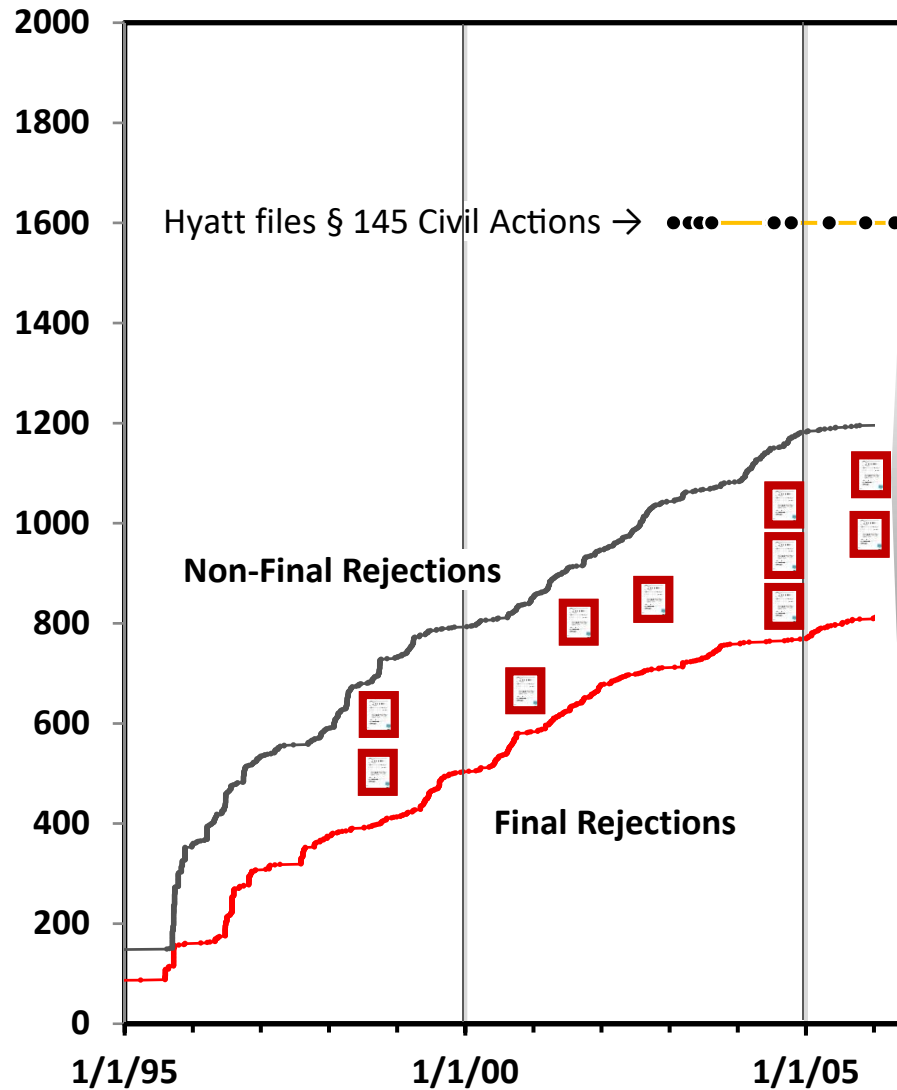
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PTO10-0023410  
PTX-054.00001



# PTO's Actions in Hyatt's Applications

## Cumulative Rejections



3621  
ifv

OCT 15 2007  
PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	)	
GILBERT P. HYATT	)	Group Art Unit: 3621
Serial No.: 07/289,355	)	Examiner: Brian Werner
Filed: December 22, 1988	)	
Docket No.: 321	)	
For: IMPROVED IMAGE PROCESSING ARCHITECTURE	)	

MEETING CONFERENCE RECORD

Hon. Commissioner For Patents  
P.O. Box 1450, Alexandria, VA 22313-1450

The Applicant had a conference on November 16, 2006 with the Director of T.C. 2600, Andrew Christensen, who had responsibility for some of his applications. The Applicant described the issue of the PTO "recycling" of his patent applications that have rejections reversed by the Board and particularly described the history of two patent applications that were in T.C. 2600; including the instant application. The Applicant pointed out "the scenario of applications going round and round from the examining groups to the Board and then back to the examining groups and then back to the Board." The Director confirmed that this was the policy that the PTO was following.

-1-

PROTECTED

PTX-054

PTO10-0023410  
PTX-054.00001

# PTO's Actions in Hyatt's Applications

Cumulative

Rejec

2000

Morse, Gregory

**From:** Morse, Gregory  
**Sent:** Tuesday, October 01, 2013 1:29 PM  
**To:** Briney III, Walter; Rosen, Elizabeth H.; Lee, John W.; Lee, Philip; Atala, Jamie J.; Pich, Ponnoreay  
**Cc:** Hafiz, Tariq  
**Subject:** Mailing

At this point I've seen versions of the requirement (sometimes just the basic version for e.g. status 71 apps with no action) for each of you. Those are fine as templates to copy.

- 1) Thanks for the hard work. This is an unusual part of an unusual detail.
- 2) I need to wait for the print queue to clear up before we mail. I will let you know. (Later this week, maybe?)
- 3) Remember that I need to sign for reopening after appeal brief (stat 121) and Tariq needs to sign for reopening after BPAI (stat 135, 144, 125)
- 4) I would like to see the requirement+action cases and the restart response period cases.
- 5) Let me know when you are ready to post the entire group with appropriate documents in OACS, including signatures for reopening. Fine if you have posted the requirement+action and the restart mail period to me.

Call with questions. The goal here is Thursday (maybe), though John and Cindy have a boatload of actions to create.

1800

1600

1400

1200

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800

Call with questions. The goal here is Thursday (maybe), though John and Cindy have a boatload of actions to create.

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PROTECTED

PTX-140

PTO16-0001562  
PTX-140.00001

1/1/10

1/1/15

# PTO's Actions in Hyatt's Applications

Cumulative

Rejec

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PTX-140

PTO16-0001562

PTX-140.00001

PROTECTED

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1/1/15

# PTO's Actions in Hyatt's Applications

## Cumulative

**From:** Breneman, Bruce  
**Sent:** Friday, August 01, 2014 10:02 AM  
**To:** Morse, Gregory; Zimmerman, Mark  
**Cc:** XPOPIM; Elkins, Roy; TSB2600 IFW\_PALM  
**Subject:** RE: Ceiling Exceeded Hyatt Cases (bruce)

The advantage of the nothing option is, we maintain the records (which likely will end up in court), closely matching truth, which is, applicant responded, and the examiners let the cases sit.

They then remain in the correct docket state, status, and no additional time is charged against the examiners.

If they were not instructed to hold work on the case, then we need to keep those scores.

Finally, what we do with those scores depends on what you plan to do with these cases. Will an examiner action be coming out shortly? No activity for a long time? Etc.

Also what I would like to propose, is that when these cases are ready for the next go round, it would be much better, for those that have a lot of them, that we consider them on a detail, and put them on opt out or on extended leave, to avoid us having to do those clock adjustments over and over again...or just put them a SPE's docket and don't worry about the scores.

**From:** TSB2600 IFW\_PALM  
**Sent:** Friday, August 01, 2014 9:08 AM  
**To:** Breneman, Bruce; TSB2600 IFW\_PALM; Elkins, Roy; XPOPIM  
**Subject:** RE: Ceiling Exceeded Hyatt Cases (bruce)

Below is a snagit of the beginning of the excel sheet.

Thanks.

Marc Springer

PALM/IFW Contract Trouble Shooter  
 U.S. Patent and Trademark Office  
 Knox 8D18-C  
 Phone: 571-272-8417

PROTECTED

PTO16-0000765  
 PTX-119.00003

Date 1/1/10 1/1/15

# PTO's Actions in Hyatt's Applications

## Cumulative

**From:** Breneman, Bruce  
**Sent:** Friday, August 01, 2014 10:02 AM  
**To:** Morse, Gregory; Zimmerman, Mark  
**Cc:** XPOPIM; Elkins, Roy; TSB2600 IFW\_PALM  
**Subject:** RE: Ceiling Exceeded Hyatt Cases (bruce)

Thanks.

Mark, Greg, there are several ways to deal with this.

As noted by Roy, perhaps the best course of action is to do nothing.

The advantage of the nothing option is, we maintain the records (which likely will end up in court), closely matching truth, which is, applicant responded, and the examiners let the cases sit.

They then remain in the correct docket state, status, and no additional time is charged against the examiners.

If we take that as a baseline, then the only question we perhaps need to deal with, are the examiner DM scores.

If they were instructed not to respond, then perhaps we need to remove those scores.

If they were not instructed to hold work on the case, then we need to keep those scores.

Finally, what we do with those scores depends on what you plan to do with these cases. Will an examiner action be coming out shortly? No activity for a long time? Etc.

Also what I would like to propose, is that when these cases are ready for the next go round, it would be much better, for those that have a lot of them, that we consider them on a detail, and put them on opt out or on extended leave, to avoid us having to do those clock adjustments over and over again...or just put them a SPE's docket and don't worry about the scores.

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Marc Springer

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 U.S. Patent and Trademark Office  
 Knox 8D18-C  
 Phone: 571-272-8417

PROTECTED

PTO16-0000765  
 PTX-119.00003

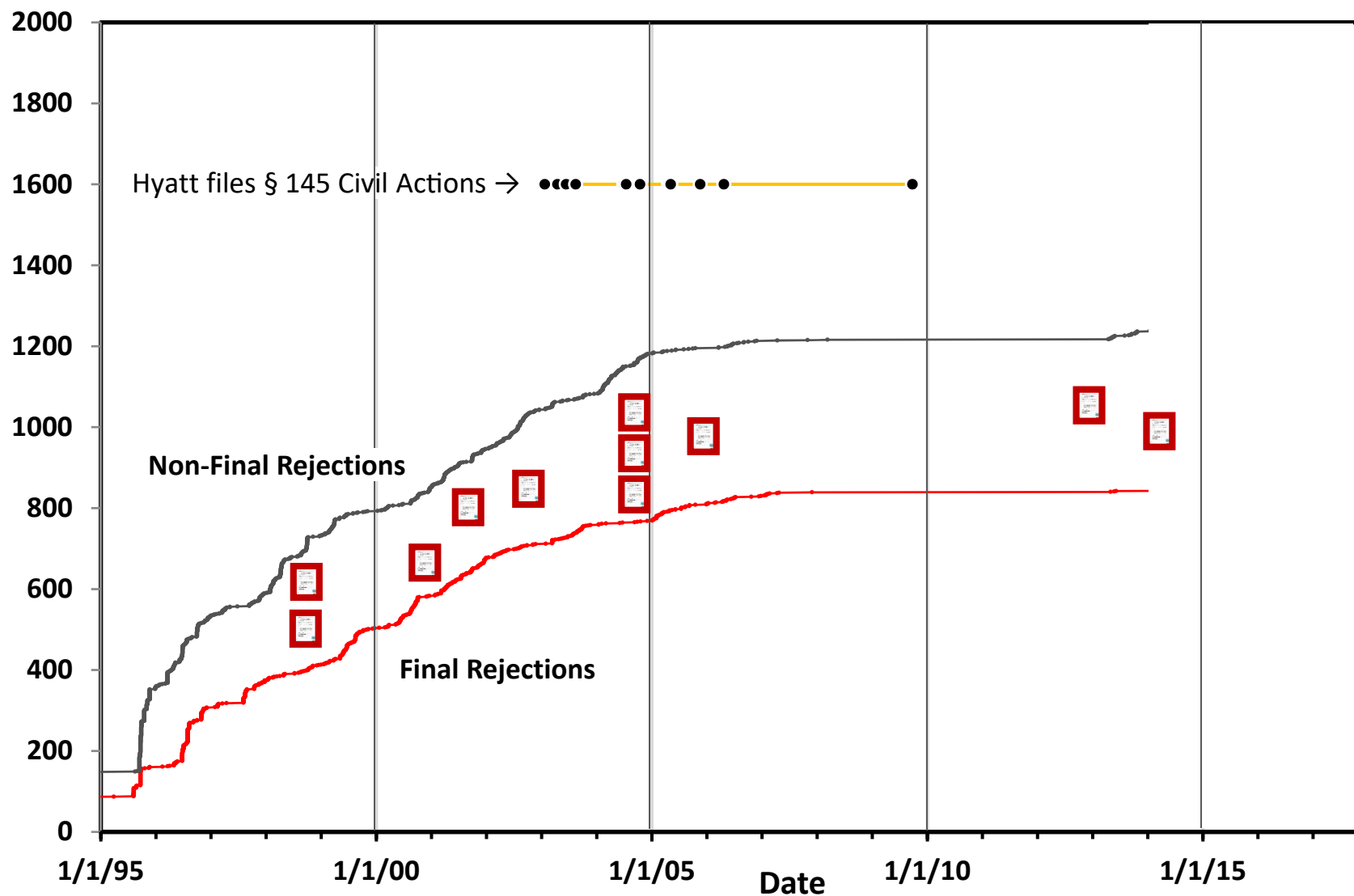
Date 1/1/10 1/1/15

## Deposition of Greg Morse, Hyatt Unit Leader, 30(b)(6) Designee



# PTO's Actions in Hyatt's Applications

Cumulative  
Rejections



# PTO's Actions in Hyatt's Applications

Cumulative  
Rejections

2000

1800

Briney III, Walter

From: Briney III, Walter  
Sent: Thursday, March 10, 2016 9:54 AM  
To: Morse, Gregory; Atala, Jamie J.; Colan, Giovanna B.; David, Matthew; Divecha,

I've been meaning to share these links for a while. The first points to a collection of articles about Hyatt. The second is one of those articles. I flagged the second one because it, more than anything else I've read, provides a unique glimpse into Hyatt's mind and the value he places on his patent applications.

<http://articles.latimes.com/keyword/gilbert -p-hyatt>

[http://articles.latimes.com/1993-06-02/business/fi-42447\\_1-divorce-settlement](http://articles.latimes.com/1993-06-02/business/fi-42447_1-divorce-settlement)

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PROTECTED

PTX-115

PTO16-0000740  
PTX-115.00001

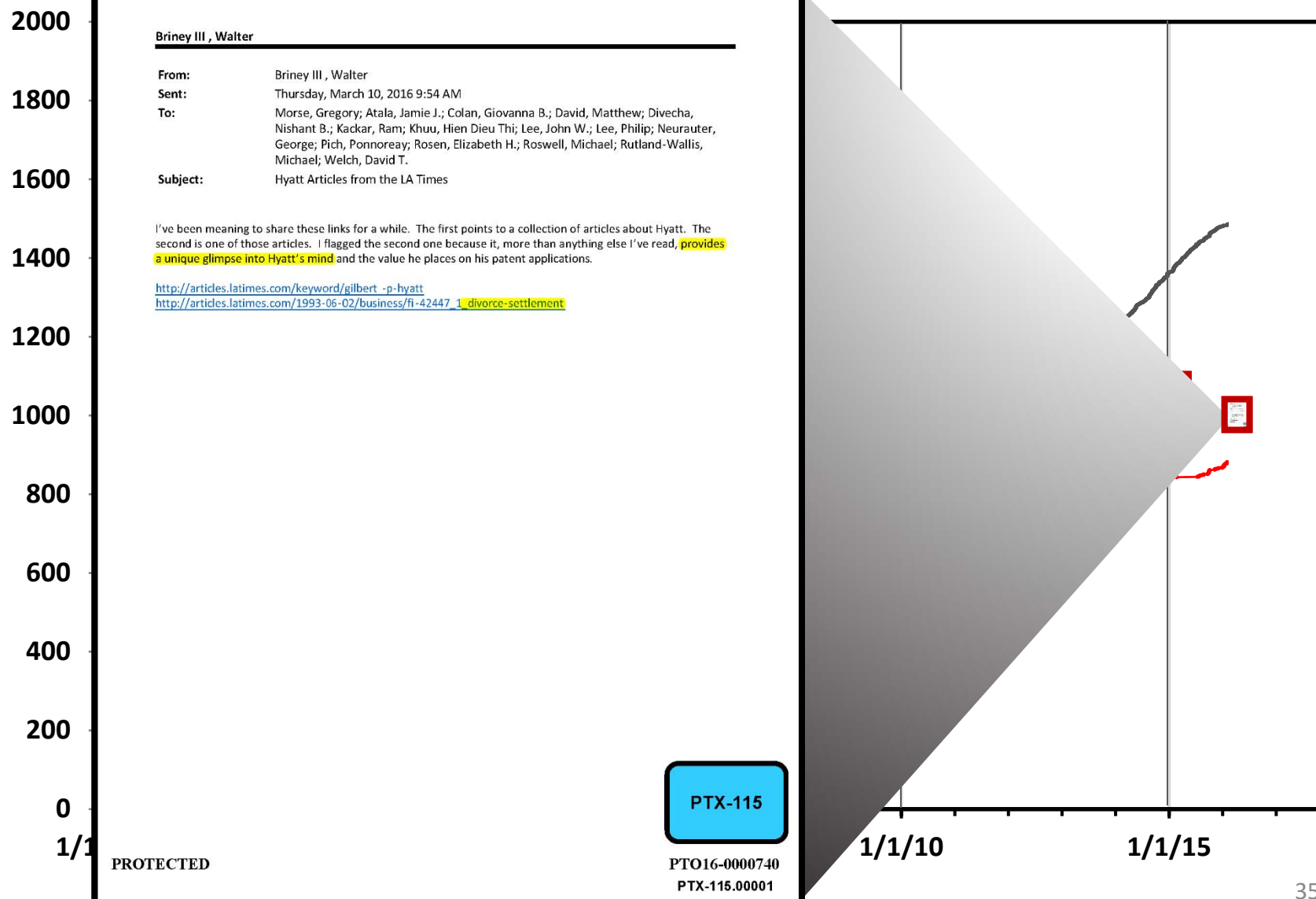
1/1/10

1/1/15



# PTO's Actions in Hyatt's Applications

## Cumulative Rejections



UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA

GILBERT P. HYATT,  
Plaintiff,  
v.  
MICHELLE K. LEE,  
Defendant.

Civil Action No. 1:09-cv-1864 (RCL)

FILED UNDER SEAL

GILBERT P. HYATT,  
Plaintiff,  
v.  
MICHELLE K. LEE,  
Defendant.

Civil Action No. 1:09-cv-1869 (RCL)

FILED UNDER SEAL

should not be anything significant left to do to prepare for trial, because trial will be based primarily on the discovery already conducted.

Mr. Hyatt further states that he is prejudiced by “the need to develop evidence and conduct any necessary discovery to address the facts and circumstances surrounding any asserted delay.” Opp. at 8. But there is nothing to discover about the laches basis for unpatentability. The USPTO’s motion does not rely on the opinions of any expert whom Mr. Hyatt might depose, nor does it depend on the personal recollections or perceptions of individuals. In fact, the USPTO’s laches motion is based entirely on Mr. Hyatt’s *own* conduct, which is all documented in the administrative record. And while Mr. Hyatt suggests that he needs discovery, he does not identify *any* information that he needs to obtain to be able to respond to the laches unpatentability issue. ~~Tallingly, Mr. Hyatt sought no discovery in responding to the USPTO’s~~

trials<sup>12</sup> on patentability issues, while ignoring the prosecution laches patentability issue. **Indeed, if this Court goes through the effort and expense of trial in these cases, and ultimately finds merit in Mr. Hyatt’s case, the USPTO will issue prosecution laches rejections based on the issues identified in its prosecution laches motion when the applications return to the USPTO.**<sup>13</sup> The

<sup>12</sup> Mr. Hyatt’s claim that we have “already informed the Court that there are no issues remaining for resolution” in the fourth case, Case No. 09-1869, (Opp. at 9) is incorrect because the USPTO informed Mr. Hyatt and this Court of the possibility that it would file a prosecution laches motion in that case at the September 12, 2016 status hearing. Mr. Hyatt is correct, however, that there no justiciable issues remain with respect to the USPTO Board decision giving rise to Case No. 09-1869.

<sup>13</sup> Mr. Hyatt asserts that in the 09-1869 case, all that remains is “to remand the case to the PTO with instructions to issue a notice of allowance on the unrejected claims.” Opp. at 9.

## Exhibit 7

**UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA**

GILBERT P. HYATT,  
Plaintiff,

v.

JOSEPH MATAL,  
Defendant.

Civil Action No. 1:09-cv-1864 (RCL)  
Civil Action No. 1:09-cv-1869 (RCL)  
Civil Action No. 1:09-cv-1872 (RCL)  
Civil Action No. 1:05-cv-2310 (RCL)

**DEFENDANT’S FIRST SUPPLEMENTAL OBJECTIONS AND RESPONSES TO  
PLAINTIFF’S FIRST SET OF REQUESTS FOR PRODUCTION (Nos. 1-26)**

Pursuant to Federal Rule of Civil Procedure 34, Defendant, Joseph Matal,<sup>1</sup> performing the functions and duties of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (“USPTO” or “Defendant”), by and through undersigned counsel, hereby responds to Plaintiff’s First Set of Requests for Production (Nos. 1-26) (“Requests”) as follows:

**PRELIMINARY STATEMENT**

Unless otherwise stated, Defendant has not withheld any documents pursuant to any objection after a reasonable, good faith investigation for responsive documents. To the extent further supplementation is necessary or Plaintiff requests additional production, Plaintiff reserves the right to withhold specifically identified classes of documents that are not subject to production.

**GENERAL OBJECTIONS**

---

<sup>1</sup> U.S. Secretary of Commerce Wilbur Ross named U.S. Patent and Trademark Office (USPTO) Associate Solicitor Joseph Matal to perform the functions and duties of the Under Secretary of Commerce for Intellectual Property and Director of the USPTO. The position became effective June 7, 2017, and followed the resignation of former USPTO Director Michelle K. Lee on June 6, 2017.

1. Defendant objects to each Request to the extent that it seeks information or materials subject to the attorney-client privilege, material prepared in anticipation of litigation or which otherwise constitutes work product, or information which is protected by any other applicable governmental privilege, including but not limited to the deliberative process privilege. To the extent that Defendant may produce any protected information or materials inadvertently, this inadvertent production is without prejudice to any claim that the information or material is privileged in any respect and/or protected from discovery, and such inadvertent production shall not be deemed to have waived any of Defendant's right or privileges.

2. Defendant objects to each Request to the extent that it seeks information which is neither relevant to nor appears reasonably calculated to lead to the discovery of admissible evidence in connection with any claim or defense of a party to this action, for it imposes an undue burden not commensurate with legitimate discovery needs.

3. Defendant objects to each Request to the extent that it seeks information or documents not within Defendant's possession, custody, or control.

4. Defendant objects to these Requests to the extent that they seek information which, if disclosed, would violate a statute or regulation, such as the Privacy Act.

5. USPTO objects to each Request to the extent that it compels the USPTO to breach its confidentiality obligations under 35 U.S.C. § 122 as applied to another applicant's application.

6. Defendant objects to each Request to the extent that the information and/or documents requested have been previously provided to the Plaintiff during the administrative proceedings underlying the four patent applications in these actions and Mr. Hyatt's other related

patent applications filed at the USPTO, and to the extent the information and/or documents requested are equally available to Plaintiff.

7. Defendant reserves the right to supplement, clarify, revise or correct any or all information contained in these responses should additional or different information become available through discovery or otherwise, pursuant to Fed. R. Civ. P. 26(e).

8. In providing these responses to Plaintiff's Requests, Defendant does not in any manner admit or imply that he considers any of the responses hereto, or any documents produced in response, to be relevant or material to the subject matter of this action or to the claims or defenses of any party herein, or that such discovery responses or documents are reasonably calculated to lead to the discovery of admissible evidence.

9. Defendant does not waive and hereby reserves the right to assert any and all objections to the admissibility into evidence at the trial of this action, or in any other proceeding, of any information provided in response to the Requests or any document produced or referred to in response to the Requests, on all grounds, including, but not limited to, relevance, materiality, and privilege.

10. Defendant objects to each definition, instruction, and request to the extent it seeks to impose or modify discovery obligations in a manner inconsistent with or more extensive in scope than those required under the Federal Rules of Civil Procedure, the Local Rules of the United States District Court for the District of Columbia, and the Court's May 2, 2017, Order On Laches Discovery ("the Court's Laches Discovery Order") (*see, e.g.*, Case No. 05-2310, ECF No. 131), particularly given the limited amount of time to conduct discovery and the Court's instructions that "discovery should be limited to factual issues surrounding whether Mr. Hyatt 'deliberately and without excuse' delayed patent prosecutions that would not be contained in the

administrative record or in which the parties dispute the record,” and “given the quasi-judicial nature of patent proceedings and the need for an expeditious conclusion to these cases, all discovery into these issues ought be narrow and limited to factual matters-not delve into hypotheticals or speculation or the reasons, mental processes, or conclusions of the examiners or other PTO officials.” *Id.* In this regard, the USPTO objects to each Request to the extent that it calls for the production of documentation that is unduly burdensome in relation to the relevance of the sought information to the USPTO’s affirmative defense of prosecution laches. Moreover, as the Court limited discovery to factual matters and excluded documents and information protected by the deliberative process privilege, the USPTO will not search for, collect, and/or produce documents protected by the deliberative process privilege.

11. The USPTO incorporates by reference every general objection set forth above into each specific objection and response. A specific objection or response may repeat a general objection for emphasis or for some other reason. The failure to include any general objection in any specific objection or response does not waive any general objection to the request. The USPTO reserves its right to amend its responses.

### **RESPONSES AND SPECIFIC OBJECTIONS**

Subject to and without waiving the foregoing General Objections, Defendant responds to Plaintiff’s First Set of Requests for Production as follows:

#### **REQUEST NO. 1**

All PALM, Electronic Desktop Application Navigator (“eDAN”), and bi-weekly employee docket reports issued after April 8, 1995, that refer to or reflect any involvement with Mr. Hyatt’s patent applications.

#### **RESPONSE TO REQUEST NO. 1**

Defendant hereby incorporates the general objections set forth above. Defendant also objects to this request as vague, ambiguous, overbroad, and unduly burdensome in that it requests “[a]ll” PALM, eDAN, and bi-weekly employee docket reports “that refer to or reflect” involvement with Mr. Hyatt’s patent applications. Defendant also objects to this request to the extent it seeks bi-weekly docket reports in electronic and paper format for hundreds of applications going back over 20 years in time as unduly burdensome in relation to the relevance of the information sought to the issue of prosecution laches. Defendant also objects to this request to the extent it seeks information contained in the administrative records of Mr. Hyatt’s applications or otherwise available to the Plaintiff. Defendant also objects to this request given the limited amount of time to conduct discovery and the Court’s instructions that “discovery should be limited to factual issues surrounding whether Mr. Hyatt ‘deliberately and without excuse’ delayed patent prosecutions that would not be contained in the administrative record” and that given “the need for an expeditious conclusion to these cases, all discovery into these issues ought be narrow.”

Subject to and without waiving the foregoing objections, Defendant has produced and/or will produce non-privileged documents responsive to this request.

#### **SUPPLEMENTAL RESPONSE TO REQUEST NO. 1**

Defendant hereby incorporates the general and specific objections set forth above. Subject to and without waiving the foregoing objections, Defendant provides the following supplemental response: Defendant has produced non-privileged documents responsive to this request. Defendant is withholding bi-weekly employee docket reports because these documents contain personal information of the examiners, would require extensive redactions, and have marginal relevance to the issue of prosecution laches. Moreover, the USPTO has provided a spreadsheet of docket information for Mr. Hyatt’s applications that identifies for each application



the individual each case was docketed to and the time period the application was docketed to that person. *See* PTO15-0000001. Thus, it is not clear what additional relevant information the bi-weekly employee docket reports would provide. The USPTO is willing to meet and confer on this portion of the request.

## **REQUEST NO. 2**

All PTO employee time and activity reports submitted after April 8, 1995 in which credit is claimed for work done on Mr. Hyatt's patent applications, including any related submissions or calculations with respect to goals under any production expectancy or performance appraisal plan.

## **RESPONSE TO REQUEST NO. 2**

Defendant hereby incorporates the general objections set forth above. Defendant also objects to this request as overbroad and unduly burdensome in that it requests "[a]ll PTO employee time and activity reports" for work done on Mr. Hyatt patent applications and has no apparent relevance to the issue of prosecution laches. Defendant also objects to this request as unduly broad and burdensome, especially given the marginal relevance of the information sought in view of the limited amount of time to conduct discovery and the Court's instructions that "discovery should be limited to factual issues surrounding whether Mr. Hyatt 'deliberately and without excuse' delayed patent prosecutions and that given 'the need for an expeditious conclusion to these cases, all discovery into these issues ought be narrow.'"

Subject to and without waiving the foregoing objections, Defendant has produced and/or will produce non-privileged documents responsive to this request.

## **SUPPLEMENTAL RESPONSE TO REQUEST NO. 2**

Defendant hereby incorporates the general and specific objections set forth above. Subject to and without waiving the foregoing objections, Defendant provides the following

supplemental response: Defendant has produced and/or will produce non-privileged documents responsive to this request. Defendant is withholding all PTO employee time and activity reports submitted after April 8, 1995 in which credit is claimed for work done on Mr. Hyatt's patent applications because these documents contain personal information of the examiners, would require extensive redactions, and have marginal relevance to the issue of prosecution laches. The USPTO is willing to meet and confer on this portion of the request.

**REQUEST NO. 3**

All documents evidencing that goals or requirements for a PTO employee's work performance were modified, waived, or excused with respect to Mr. Hyatt's patent applications.

**RESPONSE TO REQUEST NO. 3**

Defendant hereby incorporates the general objections set forth above. Defendant also objects to this request as having no relevance to the issue of prosecution laches. Defendant has no responsive documents to produce in response to this Request.

**REQUEST NO. 4**

The entire PALM historical record (including all transaction events, and status entries) and similar tracking documents or records for all of Mr. Hyatt's patent applications.

**RESPONSE TO REQUEST NO. 4**

Defendant hereby incorporates the general objections set forth above. Defendant also objects to this request as vague, ambiguous, overbroad, and unduly burdensome. Defendant also objects to this request to the extent it seeks all PALM records for hundreds of applications going back over 50 years in time as unduly burdensome in relation to any relevance the information sought might have to the issue of prosecution laches. Defendant also objects to this request to the extent it seeks information contained in the administrative records of Mr. Hyatt's applications or otherwise available to the Plaintiff. Defendant also objects to this request given the limited

amount of time to conduct discovery and the Court's instructions that "discovery should be limited to factual issues surrounding whether Mr. Hyatt 'deliberately and without excuse' delayed patent prosecutions that would not be contained in the administrative record" and that given "the need for an expeditious conclusion to these cases, all discovery into these issues ought be narrow."

Subject to and without waiving the foregoing objections, Defendant has produced and/or will produce non-privileged documents responsive to this request.

#### **REQUEST NO. 5**

All documents evidencing any policies, practices, instructions, memoranda, procedures, or guidelines (whether formal or informal) applicable to Mr. Hyatt's patent applications, including (but not limited to) documents relating to: (a) a "Hyatt Room" or other location to segregate or place Mr. Hyatt's patent application materials; (b) a "Bulk Filers" Art Unit, "Art Unit 2615," "Team Exam Six," or other unit, group, or team to examine or otherwise act upon Mr. Hyatt's patent applications; (c) "an entire art unit since 2013, dedicated to examining [Mr. Hyatt's] applications," as detailed on pages 3 and 43 of your Memorandum of Points and Authorities in Support of your Motion to Dismiss ("Memorandum of Law"); (d) the designation, flagging, or grouping of any of Mr. Hyatt's patent applications under the SAWS program or any similar program for identifying patent applications for additional scrutiny, review, or oversight; (e) the designation or treatment of Mr. Hyatt's patent applications as "special" or similar designation entitling the patent applications to expedited processing; (f) the rejection, objection, and/or abandonment of Mr. Hyatt's patent applications; (g) the coordination of office actions or other actions across more than one of Mr. Hyatt's patent applications; and (h) production expectancies and performance appraisal plans applicable to personnel working on Mr. Hyatt's applications.

**RESPONSE TO REQUEST NO. 5**

Defendant hereby incorporates the general objections set forth above. Defendant also objects to this request as overbroad and unduly burdensome in that it contains eight different subparts that each constitute a separate document request for a total of eight separate document requests. Defendant also objects to this request as vague, ambiguous, overbroad, and unduly burdensome, particularly to the extent it calls for policies that apply to all patent applications, such as policies in the MPEP, policies in the administrative records of Mr. Hyatt's applications, such as the 2013 Requirement, and other vague and unfamiliar terms, such as "Team Exam Six." Defendant also objects to this request as unduly burdensome in that the documents requested have marginal, if any, relevance to the issue of prosecution laches, particularly since the Court has stated that "Defendant is correct in noting that 'delay by the PTO cannot excuse the appellant's own delay.'" *See* the Court's Laches Discovery Order at 2 (citing *In re Bogese*, 303 F.3d 1362, 1369 (Fed. Cir. 2002)). Defendant also objects to this request to the extent it seeks information subject to the deliberative process privilege. Defendant also objects to this request to the extent it is not narrowly "tailored to the issue of prosecution laches." *Id.* at 2.

Subject to and without waiving the foregoing objections, Defendant has produced and/or will produce non-privileged documents responsive to this request.

**REQUEST NO. 6**

All documents relating to SAWS or any "be on the lookout" program or procedure, "second pair of eyes" program or procedure (i.e., providing for or requiring a second, special, or extra review of applications), or any similar program for identifying patent applications for additional scrutiny, review, or oversight referring to Mr. Hyatt, Mr. Hyatt's patent applications, or any issues involving Mr. Hyatt, including SAWS impact reports for Mr. Hyatt's patent applications and examiner training materials.

**RESPONSE TO REQUEST NO. 6**

Defendant hereby incorporates the general objections set forth above. Defendant objects to this request as it seeks information or materials subject to the attorney-client privilege, material that constitutes attorney work product, and information or materials subject to the deliberative process privilege. Defendant also objects to this request as it is based on pure speculation without any reasonable belief on Mr. Hyatt's part that the programs for which he requests documents actually exist. Defendant also objects to this request as vague and ambiguous as to the terms "be on the lookout" program or procedure and "second pair of eyes" program or procedure. Defendant also objects to this request to the extent Mr. Hyatt's applications were not subject to SAWS.

Subject to and without waiving the foregoing objections, Defendant has produced and/or will produce non-privileged documents responsive to this request.

**REQUEST NO. 7**

All documents relating to the withdrawal from issue of the following:

- a) U.S. Patent No. 5,625,761, Hyatt Docket No. 342, Patent Application Ser. No. 07/763,395;
- b) Hyatt Docket No. 363, Patent Application Ser. No. 08/433,307;
- c) Hyatt Docket No.145, Patent Application Ser. No. 05/849,812; and
- d) U.S. Patent No. 5,847,379, Hyatt Docket No. 324, Patent Application Ser. No. 07/357,570.

**RESPONSE TO REQUEST NO. 7**

Defendant hereby incorporates the general objections set forth above. Defendant objects to this request as it seeks information or materials subject to the attorney-client privilege, material that constitutes attorney work product, and information or materials subject to the

deliberative process privilege. Defendant further objects to this request as it seeks information in the administrative record or that is publicly available.

Subject to and without waiving the foregoing objections, Defendant has produced and/or will produce non-privileged documents responsive to this request.

**REQUEST NO. 8**

All documents showing any of Mr. Hyatt's patent applications, including those identified in Document Request No. 7, as applications planned for issue, as prospective patent grants, or as utility grant prints.

**RESPONSE TO REQUEST NO. 8**

Defendant hereby incorporates the general objections set forth above. Defendant objects to this request as it seeks information or materials subject to the attorney-client privilege, material that constitutes attorney work product, and information or materials subject to the deliberative process privilege. Defendant also objects to this request to the extent it seeks information in the administrative record, publicly available, or otherwise available to Mr. Hyatt.

Subject to and without waiving the foregoing objections, Defendant has produced and/or will produce non-privileged documents responsive to this request.

**REQUEST NO. 9**

All documents relating to "submarine" or "submariner" patents, patent applications, or patent applicants or to patent applications filed by "independent inventors," "individual inventors," or "small inventors" referring to Mr. Hyatt, Mr. Hyatt's patent applications, or any issues involving Mr. Hyatt.

**RESPONSE TO REQUEST NO. 9**

Defendant hereby incorporates the general objections set forth above. Defendant also objects to this request as vague and ambiguous as the terms in quotations are undefined.

Defendant further objects to this request as it seeks information or materials subject to the attorney-client privilege, material that constitutes attorney work product, and information or materials subject to the deliberative process privilege. Defendant further objects to this request to the extent it seeks information that has marginal, if any, relevance to the issue of prosecution laches. Defendant further object to this request as vague and ambiguous to the extent it seeks documents relating to “independent inventors,” “individual inventors,” or “small inventors” referring to Mr. Hyatt.

Subject to and without waiving the foregoing objections, Defendant has produced and/or will produce non-privileged documents responsive to this request.

**REQUEST NO. 10**

All communications sent from, sent to, or received by Michelle Lee, David Kappos, Teresa Stanek Rea, Jon Dudas, James Rogan, Bruce Lehman, Q. Todd Dickinson, Nick Godici, John Doll, Robert Stoll, Margaret “Peggy” Focarino, Drew Hirshfeld, Lawrence Goffney, Stephen Kunin, Edward Kazenske, Esther Keplinger, the Office of Patent Legal Administration or its personnel, or the Board of Patent Appeals and Interferences or Patent Trial and Appeal Board (“Appeals Board”) or its personnel referring to Mr. Hyatt, Mr. Hyatt’s patent applications, or any issues involving Mr. Hyatt.

**RESPONSE TO REQUEST NO. 10**

Defendant hereby incorporates the general objections set forth above. Defendant objects to this request as it seeks information or materials subject to the attorney-client privilege, material that constitutes attorney work product, and information or materials subject to the deliberative process privilege, especially for all communications sent from, sent to, or received by OPLA and the Board or its personnel. Defendant also objects to this request as vague and ambiguous as to the meaning of “any issues involving Mr. Hyatt.” Defendant further objects to

this request to the extent it seeks information that has marginal, if any, relevance to the issue of prosecution laches. Defendant further object to this request as unduly burdensome to the extent it seeks all communications that refer to Mr. Hyatt to the extent the requested communications do not relate to the issue of prosecution laches, and it unbounded by any time scope limitation.

Subject to and without waiving the foregoing objections, Defendant has produced and/or will produce non-privileged documents responsive to this request. Defendant stands on its objections to the extent the request calls for all communications regarding OPLA and the Board and its personnel, but is willing to meet and confer on this portion of the request.

#### **SUPPLEMENTAL RESPONSE TO REQUEST NO. 10**

Defendant hereby incorporates the general and specific objections set forth above. Subject to and without waiving the foregoing objections, Defendant provides the following supplemental response: Defendant has produced and/or will produce non-privileged documents responsive to this request. Defendant is not withholding communications regarding OPLA. Subject to the parties' agreement during a meet and confer as to the limited scope of this request concerning communications regarding the Board and its personnel, i.e., that Plaintiff seeks communications from outside the Board to the Board, e.g., telling them to do or not do something, Defendant is not withholding communications regarding the Board and its personnel.

#### **REQUEST NO. 11**

All documents relating to the effect of Mr. Hyatt's patent applications being filed prior to the effective date for the Uruguay Round of the General Agreement on Tariffs and Trade ("GATT") (i.e., June 8, 1995), including (but not limited to): (a) documents evidencing the potential impact of granting such patent applications; and (b) the use of Mr. Hyatt's patent applications as exemplars of pre-GATT patent applications.

#### **RESPONSE TO REQUEST NO. 11**



Defendant hereby incorporates the general objections set forth above. Defendant objects to this request as it seeks information or materials subject to the attorney-client privilege, material that constitutes attorney work product, and information or materials subject to the deliberative process privilege. Defendant also objects to this request as vague and ambiguous as to the terms “the use of Mr. Hyatt’s patent applications as exemplars of pre-GATT patent applications.” Defendant also objects to this request to the extent it is duplicative of requests nos. 6, 9, and 10.

Subject to and without waiving the foregoing objections, Defendant has produced and/or will produce non-privileged documents responsive to this request.

**REQUEST NO. 12**

All documents since June 8, 1995, relating to legislation, legislative proposals, or the need for legislation regarding pre-GATT patent applications that refer to Mr. Hyatt, Mr. Hyatt’s patent applications, or any issues involving Mr. Hyatt.

**RESPONSE TO REQUEST NO. 12**

Defendant hereby incorporates the general objections set forth above. Defendant also objects to this request to the extent it seeks information that is publicly available or otherwise available to Mr. Hyatt. Defendant objects to this request as it seeks information or materials subject to the attorney-client privilege, material that constitutes attorney work product, and information or materials subject to the deliberative process privilege. Defendant further object to the term “issues involving Mr. Hyatt” as vague and ambiguous.

Subject to and without waiving the foregoing objections, Defendant has produced and/or will produce non-privileged documents responsive to this request.

**REQUEST NO. 13**

All documents relating to the “Clearing the Oldest Patent Applications” (“COPA”) initiative that refer to Mr. Hyatt, Mr. Hyatt’s patent applications, or any issues involving Mr. Hyatt.

**RESPONSE TO REQUEST NO. 13**

Defendant hereby incorporates the general objections set forth above. Defendant objects to this request as it seeks information or materials subject to the attorney-client privilege, material that constitutes attorney work product, and information or materials subject to the deliberative process privilege. Defendant further object to the term “issues involving Mr. Hyatt” as vague and ambiguous.

Subject to and without waiving the foregoing objections, Defendant has produced and/or will produce non-privileged documents responsive to this request.

**REQUEST NO. 14**

All documents relating to the PTO’s actions to re-open prosecution instead of (a) allowing the Appeals Board to rule on Mr. Hyatt’s appealed patent applications or (b) issuing Mr. Hyatt’s patent applications after a ruling in his favor by the Appeals Board.

**RESPONSE TO REQUEST NO. 14**

Defendant hereby incorporates the general objections set forth above. Defendant also objects to this request to the extent it seeks information in the administrative record. Defendant objects to this request as it seeks information or materials subject to the attorney-client privilege, material that constitutes attorney work product, and information or materials subject to the deliberative process privilege.

Subject to and without waiving the foregoing objections, Defendant has produced and/or will produce non-privileged documents responsive to this request.

**REQUEST NO. 15**

All documents relating to the use of Requirements for claim selection or for information, including under 37 C.F.R. § 1.105, in Mr. Hyatt's patent applications.

**RESPONSE TO REQUEST NO. 15**

Defendant hereby incorporates the general objections set forth above. Defendant objects to this request as it seeks information or materials subject to the attorney-client privilege, material that constitutes attorney work product, and information or materials subject to the deliberative process privilege.

Subject to and without waiving the foregoing objections, Defendant has produced and/or will produce non-privileged documents responsive to this request.

**REQUEST NO. 16**

All documents relating to the loss, in whole or in part, of file histories from Mr. Hyatt's patent applications and the recovery or reconstruction of such file histories.

**RESPONSE TO REQUEST NO. 16**

Defendant hereby incorporates the general objections set forth above. Defendant also objects to this request to the extent it seeks information in the administrative record. Defendant further objects to this request to the extent it seeks information subject to the deliberative process privilege.

Subject to and without waiving the foregoing objections, Defendant has produced and/or will produce non-privileged documents responsive to this request.

**REQUEST NO. 17**

All documents relating to actions to overrule or otherwise block or deter a patent examiner from allowing, acting to issue, or recommending issuance of any of Mr. Hyatt's patent applications.

**RESPONSE TO REQUEST NO. 17**

Defendant hereby incorporates the general objections set forth above. Defendant also objects to this request to the extent it seeks information in the administrative record. Defendant objects to this request as it seeks information or materials subject to the attorney-client privilege, material that constitutes attorney work product, and information or materials subject to the deliberative process privilege.

Subject to and without waiving the foregoing objections, Defendant has produced and/or will produce non-privileged documents responsive to this request.

**REQUEST NO. 18**

All documents evidencing that Mr. Hyatt promised to focus his patent applications, as stated on page 1 of your Memorandum of Law, that Mr. Hyatt “would focus his claims and file well-differentiated claims directed to a different invention in each of his roughly 400 applications,” as stated on page 4 of your Memorandum of Law, or that the PTO relied on any such promises.

**RESPONSE TO REQUEST NO. 18**

Defendant hereby incorporates the general objections set forth above. Defendant also objects to this request to the extent it seeks information in the administrative records of Mr. Hyatt’s applications. Defendant also objects to this request to the extent it seeks information that the USPTO has previously provided to Mr. Hyatt in relation to the parties’ briefing on the USPTO’s prosecution laches motion, Mr. Hyatt’s motion for discovery, and Mr. Hyatt’s renewed motion for discovery. Defendant objects to this request as it seeks information or materials subject to the attorney-client privilege, material that constitutes attorney work product, and information or materials subject to the deliberative process privilege.

Subject to and without waiving the foregoing objections, Defendant has produced and/or will produce non-privileged documents responsive to this request.

**REQUEST NO. 19**

All documents relating to whether Mr. Hyatt's conduct before the PTO has been "unreasonable," as stated on pages 1, 4, and 27 of your Memorandum of Law, or could result in application of prosecution laches.

**RESPONSE TO REQUEST NO. 19**

Defendant hereby incorporates the general objections set forth above. Defendant also objects to this request to the extent it seeks information in the administrative records of Mr. Hyatt's applications. Defendant also objects to this request to the extent it seeks information that the USPTO has previously provided to Mr. Hyatt, or that Mr. Hyatt otherwise has in his possession, in relation to the parties' briefing on the USPTO's prosecution laches motion, Mr. Hyatt's motion for discovery, and Mr. Hyatt's renewed motion for discovery. Defendant has further provided examples of Mr. Hyatt's unreasonable conduct in the USPTO's First Set of Interrogatories. Defendant objects to this request as it seeks information or materials subject to the attorney-client privilege, material that constitutes attorney work product, and information or materials subject to the deliberative process privilege.

Subject to and without waiving the foregoing objections, Defendant has produced and/or will produce non-privileged documents responsive to this request.

**REQUEST NO. 20**

All documents evidencing any warnings from the PTO regarding prosecution laches, as stated on page 3 of your Memorandum of Law.

**RESPONSE TO REQUEST NO. 20**

Defendant hereby incorporates the general objections set forth above. Defendant also objects to this request to the extent it seeks information in the administrative records of Mr. Hyatt's applications. Defendant also objects to this request to the extent it seeks information that

the USPTO has previously provided to Mr. Hyatt, or that Mr. Hyatt otherwise has in his possession, in relation to the parties' briefing on the USPTO's prosecution laches motion, Mr. Hyatt motion for discovery, and Mr. Hyatt's renewed motion for discovery. Defendant further objects to this request as it seeks information or materials subject to the attorney-client privilege, material that constitutes attorney work product, and information or materials subject to the deliberative process privilege.

Subject to and without waiving the foregoing objections, Defendant has produced and/or will produce non-privileged documents responsive to this request. For example, the USPTO described warnings given in 1978, 1980, and 1995 in its prosecution laches briefing. *See* USPTO Reply in support of its motion to dismiss for prosecution laches at pages 20-21; A206847-852; A206855-56; see also USPTO motion to dismiss for prosecution laches at pages 13-14; A819-820 (09-1864); A202643-648. Other examples of warnings regarding Mr. Hyatt's conduct in the administrative records of Mr. Hyatt's applications include the following identified by application number and date of the office action that included the warning:

08/285,669	12/30/2016
08/433,307	1/3/2017
08/435,502	5/28/2015
08/435,502	8/19/2016
08/469,061	4/20/2017
08/472,025	10/2/2015
08/472,025	12/30/2016
08/469,939	3/3/2017
08/469,573	11/18/2016

08/471,543	3/13/2017
08/470,899	10/25/2016
08/466,953	11/29/2016
08/470,082	12/1/2016
08/471,428	1/4/2017
08/435,033	1/25/2017
08/471,708	3/6/2017
08/471,925	2/7/2017
08/472,019	3/7/3017
08/479,087	5/3/2017
08/479,088	3/29/2017
08/471,070	5/10/2017
08/456333	11/15/2016
08/458005	2/13/2017
08/458206	10/24/2016
08/459221	7/26/2016
08/459848	3/2/2017
08/460705	6/16/2015
08/460705	10/24/2016
08/466599	7/7/2015
08/466599	11/16/2016
08/466992	8/16/2016
08/439,033	6/1/2015

08/439,033	8/26/2016
08/457,369	7/7/2015
08/457,369	1/25/2017
08/439,032	8/19/2015
08/439,032	1/30/2017
08/457,210	8/24/2015
08/457,210	3/16/2017
08/457,716	9/23/2015
08/457,716	5/5/2017
08/457,344	12/8/2015
08/457,344	2/14/2017
08/458,003	12/31/2015
08/457,195	3/28/2016
08/457,663	5/25/2016
07/419,911	8/2/2016
08/456,599	8/2/2016
08/640,726	8/2/2016
08/458,144	8/16/2016
08/457,446	8/17/2016
08/457,717	8/17/2016
08/457,939	1/17/2017
08/456,327	1/31/2017
08/456,338	3/16/2017



08/457,369	5/12/2017
8323471	12/28/2016
8417530	12/1/2015
8417530	4/27/2017
8419681	10/6/2015
8419681	1/4/2017
8435513	12/2/2015
8435513	5/9/2017
8437527	3/16/2016
8437736	11/25/2016
8458197	3/14/2016
8458548	10/11/2016
8459220	3/21/2016
8459244	6/21/2016
8459599	6/1/2016
8459877	4/11/2017
8460064	5/23/2016
8460092	10/25/2016
8462306	12/9/2016
8464037	11/25/2016
8464995	3/29/2017
8465073	12/29/2016
8465203	3/6/2017

8470671	1/5/2016
8470671	12/6/2016
8471547	10/24/2016
8470879	11/9/2016
8471699	6/17/2016
8471713	7/6/2016
8471548	3/16/2017
8469532	6/20/2016
8469532	3/29/2017
7502588	3/30/2017
8471152	4/17/2017
8420470	5/3/2017
8418212	11/23/2016
6848017	3/31/2017
8418211	1/31/2017
8419326	2/16/2017
8419586	11/21/2016
8419476	11/21/2016
8419585	11/18/2016
8428359	11/22/2016
7357570	3/29/2017
8454877	12/8/2016
8454889	11/23/2016

8454896	10/27/2016
8454901	2/13/2017
8454902	11/16/2016
8455117	10/6/2016
8455356	11/25/2016
8455505	3/17/2017
08/471,704	11/3/2016
08/470,079	1/13/2017
08/470,177	3/3/2017
08/471,709	5/16/2017
8457196	8/28/2015
8457208	11/24/2015
8457362	2/7/2017
8457715	8/28/2015
8458141	8/31/2015
8458143	9/21/2015
8458549	3/8/2017
8460612	3/31/2016
8460718	11/25/2015
8465071	10/5/2015
8465173	3/8/2017
8469321	3/31/2016
8469580	4/6/2016

8471123	9/29/2015
8471255	8/28/2015
8471846	9/26/2016
8464007	9/26/2016
8459158	9/26/2016
8465200	9/26/2016
08/458582	4/24/2017
08/464035	4/21/2017
08/423081	11/30/2015
08/459508	11/25/2015
08/464246	11/6/2015
08/431638	5/25/2016
08/435938	5/24/2016
08/438598	5/25/2016
08/463118	8/22/2016
08/464032	5/24/2016
08/465152	5/24/2016
08/465923	12/30/2015
08/469019	5/24/2016
08/430777	11/15/2016
08/436854	1/29/2016
08/436854	11/15/2016
08/436855	3/14/2017

08/460590	9/27/2016
08/462333	1/11/2016
08/462333	11/25/2016
08/462712	1/6/2016
08/462712	11/22/2017
08/462919	1/3/2017
08/463109	5/25/2016
08/463109	4/28/2017
08/463117	3/28/2016
08/463820	5/24/2016
08/463820	5/16/2017
08/464114	7/7/2015
08/464114	9/12/2016
08/464441	6/29/2015
08/464441	9/12/2016
08/465482	4/5/2017
11/006170	12/12/2014
08/458004	12/23/2014
11/006062	1/9/2015
11/006099	3/2/2015
11/006408	4/1/2015
11/006134	4/16/2015
11/006182	4/29/2015

11/006206	5/21/2015
08/458791	6/24/2015
08/458004	9/29/2015
08/460433	11/13/2015
08/459648	1/6/2016
08/458791	3/15/2016
08/463823	5/10/2016
08/460433	7/19/2016
08/465201	8/29/2016
08/459648	9/6/2016
08/469018	10/21/2016
08/458004	10/24/2016
08/458791	10/25/2016
08/457728	11/10/2016
08/463823	12/20/2016
08/460433	3/14/2017
08/469263	3/15/2017
08/762669	3/24/2017
08/459648	5/1/2017
07/182,709	7/28/2016
07/182,709	4/4/2017
08/445,456	1/31/2017
08/445,458	11/7/2016

08/454,810	5/11/2017
08/454,873	8/25/2015
08/454,873	11/8/2016
08/454,874	5/18/2017
08/454,875	11/14/2016
08/454,886	4/5/2016
08/454,886	5/10/2017
08/454,887	10/6/2015
08/454,887	11/18/2016
08/454,984	10/6/2015
08/454,984	11/7/2016
08/455,303	11/21/2016
08/455,309	6/30/2016
08/455,309	3/9/2017
08/456,129	8/17/2016
08/456,129	3/16/2017
08/456130	3/28/2017
08/456,138	3/31/2017

**REQUEST NO. 21**

All communications with parties outside of the PTO, other than Mr. Hyatt or his representatives, relating to Mr. Hyatt or any of Mr. Hyatt's patent applications.

**RESPONSE TO REQUEST NO. 21**

Defendant hereby incorporates the general objections set forth above. Defendant further objects to this request as it seeks information or materials subject to the attorney-client privilege, material that constitutes attorney work product, and information or materials subject to the deliberative process privilege. Defendant further objects to this request as unduly burdensome and irrelevant to the extent it seeks information that has marginal, if any, relevance to the issue of prosecution laches. Defendant further objects to this request to the extent it seeks information that is publicly available or otherwise available to Mr. Hyatt.

Subject to and without waiving the foregoing objections, Defendant has produced and/or will produce non-privileged documents responsive to this request.

**REQUEST NO. 22**

All documents relating to Mr. Hyatt's '094 patent application, as discussed on page 37–38 of your Memorandum of Law.

**RESPONSE TO REQUEST NO. 22**

Defendant hereby incorporates the general objections set forth above. Defendant also objects to this request to the extent it seeks information in the administrative records of Mr. Hyatt's applications. Defendant also objects to this request to the extent it seeks information that the USPTO has previously provided to Mr. Hyatt, or that Mr. Hyatt otherwise has in his possession, in relation to the parties' briefing on the USPTO's prosecution laches motion, Mr. Hyatt's motion for discovery, and Mr. Hyatt's renewed motion for discovery. Defendant further objects to this request as it seeks information or materials subject to the attorney-client privilege, material that constitutes attorney work product, and information or materials subject to the deliberative process privilege.

Subject to and without waiving the foregoing objections, Defendant has produced and/or will produce non-privileged documents responsive to this request.



**REQUEST NO. 23**

All documents other than cited prior art evidencing media articles accessed or stored by PTO personnel referring to Mr. Hyatt, Mr. Hyatt's patent applications, or his issued patents.

**RESPONSE TO REQUEST NO. 23**

Defendant hereby incorporates the general objections set forth above. Defendant further objects to this request as unduly burdensome and irrelevant to the extent it seeks information that has marginal, if any, relevance to the issue of prosecution laches. Defendant also objects to this request to the extent it seeks information that the USPTO has previously provided to Mr. Hyatt, or that Mr. Hyatt otherwise has in his possession, in relation to the parties' briefing on the USPTO's prosecution laches motion. Defendant further objects to this request as it seeks information or materials subject to the attorney-client privilege, material that constitutes attorney work product, and information or materials subject to the deliberative process privilege.

Subject to and without waiving the foregoing objections, Defendant has produced and/or will produce non-privileged documents responsive to this request.

**REQUEST NO. 24**

All documents relating to the suspension of prosecution or of other consideration of Mr. Hyatt's patent applications.

**RESPONSE TO REQUEST NO. 24**

Defendant hereby incorporates the general objections set forth above. Defendant also objects to this request to the extent it seeks information in the administrative record. Defendant further objects to this request as it seeks information or materials subject to the attorney-client privilege, material that constitutes attorney work product, and information or materials subject to the deliberative process privilege. Defendant further objects to this request to the extent it seeks information in the possession of Mr. Hyatt or otherwise available to Mr. Hyatt.

Subject to and without waiving the foregoing objections, Defendant has produced and/or will produce non-privileged documents responsive to this request. Defendant has also produced documents responsive to this request in case no. 14-1300 in the Eastern District of Virginia, including the USPTO's briefing in that case concerning the USPTO's position regarding why it suspended prosecution in the 80 applications at issue in that case.

**REQUEST NO. 25**

All documents relating to appeal conferences, as described in Manual of Patent Examining Procedure § 1207.01, in Mr. Hyatt's patent applications.

**RESPONSE TO REQUEST NO. 25**

Defendant hereby incorporates the general objections set forth above. Defendant also objects to this request to the extent it seeks information in the administrative record. Defendant further objects to this request as it seeks information or materials subject to the attorney-client privilege, material that constitutes attorney work product, and information or materials subject to the deliberative process privilege. Defendant further objects to this request to the extent it seeks information in the possession of Mr. Hyatt or otherwise available to Mr. Hyatt.

Subject to and without waiving the foregoing objections, Defendant has produced and/or will produce non-privileged documents responsive to this request.

**REQUEST NO. 26**

If you assert any documents sought by Mr. Hyatt have not been retained, documents evidencing the PTO's document preservation or retention policies, including all such policies and procedures enacted to comply with the Federal Records Act.

**RESPONSE TO REQUEST NO. 26**

Defendant hereby incorporates the general objections set forth above. Defendant further objects to this request to the extent it seeks information subject to the deliberative process or

attorney-client privilege. Defendant further objects to this request as Mr. Hyatt's discovery requests seek information and documents dating back to as early as 1969, and much of the information sought has marginal, if any, relevance to the issue of prosecution laches.

Subject to and without waiving the foregoing objections, Defendant has produced and/or will produce non-privileged documents responsive to this request.

Dated: July 12, 2017

Respectfully submitted,

CHANNING D. PHILLIPS, D.C. Bar #415793  
United States Attorney  
for the District of Columbia

DANIEL F. VAN HORN, D.C. Bar #924092  
Chief, Civil Division

By: /s/ Robert E. McBride  
JASON T. COHEN, ME Bar #004465  
Assistant United States Attorney  
ROBERT E. McBRIDE  
Special Assistant United States Attorney  
ROBERT J. McMANUS  
Special Assistant United States Attorney  
THOMAS W. KRAUSE  
Special Assistant United States Attorney  
United States Attorney's Office, Civil Division  
555 Fourth Street, NW  
Washington, DC 20530  
Tel: 202.252.2523  
Fax: 202.252.2599  
Email: Jason.Cohen@usdoj.gov

*Counsel for Defendant*

**CERTIFICATE OF SERVICE**

I hereby certify that on July 12, 2017, the foregoing was delivered electronically to the following counsel for Plaintiff:

Aaron M. Panner  
Thomas B. Bennett  
KELLOGG, HUBER, HANSEN, TODD, EVANS & FIGEL, P.L.L.C.  
1615 M Street, N.W.  
Suite 400  
Washington, D.C. 20036  
[apanner@khhte.com](mailto:apanner@khhte.com)  
[tbennett@khhte.com](mailto:tbennett@khhte.com)

Andrew M. Grossman  
Paul M. Levine  
Mark DeLaquil  
Baker & Hostetler LLP  
1050 Connecticut Ave., N.W.  
Suite 1100  
Washington, D.C. 20036  
[agrossman@bakerlaw.com](mailto:agrossman@bakerlaw.com)  
[pmlevine@bakerlaw.com](mailto:pmlevine@bakerlaw.com)  
[mdelaquil@bakerlaw.com](mailto:mdelaquil@bakerlaw.com)

/s/ Robert E. McBride  
ROBERT E. MCBRIDE  
Special Assistant United States Attorney

## Exhibit 8

UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA

-----:  
GILBERT P. HYATT, :  
 :  
 :  
 : Plaintiff, :  
 v. : Civil Action No. 05-2310(RCL)  
 : Civil Action No. 09-1864(RCL)  
 JOSEPH MATAL, : Civil Action No. 09-1869(RCL)  
 : Civil Action No. 09-1872(RCL)  
 : Defendant. : ECF  
-----:

Videotaped Deposition of PATRICIA CAPERS

Monday, August 21, 2017

Washington, D.C.

Reported by:

Susan L. Ciminelli, RPR, CRR

Job no: 19460

1  
2 Videotaped Deposition of:  
3 PATRICIA CAPERS,  
4 called for oral examination by counsel for  
5 Plaintiff, pursuant to notice, at the office of  
6 Baker & Hostetler, LLP, Washington Square, Suite  
7 1100, 1050 Connecticut Avenue, Washington, D.C.,  
8 before SUSAN L. CIMINELLI, RPR, CRR, a Notary Public  
9 in and for the District of Columbia, beginning at  
10 9:22 a.m., when were present on behalf of the  
11 respective parties:  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22

A P P E A R A N C E S

On behalf of Plaintiff:

MARK W. DeLAQUIL, ESQUIRE  
Baker & Hostetler, LLP  
Washington Square  
Suite 1100  
1050 Connecticut Avenue, N.W.  
Washington, D.C. 20036-5304  
(202) 868-1697  
mdelaquil@bakerlaw.com

On behalf of Defendant:

ROBERT McBRIDE, ESQUIRE  
United States Patent & Trademark Office  
600 Dulany Avenue  
Madison West Building 8C43A  
Mail Stop 8  
PO Box 1450  
Alexandria, Virginia 22313-1450  
(571) 272-7153  
robert.mcbride@uspto.gov

ALSO PRESENT:

CHARLIE WIDNER, Videographer  
GILBERT P. HYATT, Via video conference

\* \* \* \* \*



## C O N T E N T S

PATRICIA CAPERS

EXAMINATION BY:

PAGE

Counsel for Plaintiff

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CAPERS DEPOSITION EXHIBITS:

PAGE

1 Second Amended Notice of Deposition

11

2 PTO16-0000942-996

65

3 PTO16-0000997-1028

65

4 PTO16-0001029-1046

66

5 PTO16-0001047-1078

66

6 PTO16-0001079-1082

66

7 PTO16-0001083-1125 (2-7 Request for  
Records Disposition Authority

67

8 Policy for Archiving and Destroying

Configuration Management OCIO-5002-09

72

9 USPTO Rules of the Road OCIO-POL-36

73

10 USPTO Enterprise SharePoint Policy

OCIO-5003-09

79

11 PTO14-0000006

Reference Request

Accession No. 241-89-04

111

CAPERS DEPOSITION EXHIBITS: PAGE

12 PTO15-0004825-4826 Technology Center

1600 Special Applications Warning

System (SAWS) 139

13 Defendant's Second Supplemental

Response to Plaintiff's Interrogatory

No. 2; Corrected First Supplemental

Responses to Interrogatory Nos. 2, 4

and 7 150

## P R O C E E D I N G S

THE VIDEOGRAPHER: This is tape number 1 of the videotaped deposition of Patricia Capers, in the matter of Hyatt versus Matal, in the United States District Court for the District of Columbia, civil Action Numbers 05-2310(RCL), 09-1864(RCL), 09-1869(RCL), and 09-1872(RCL) ECF. This deposition is being held at Baker Hostetler on August 21st, 2017, at approximately 9:22 a.m.

My name is Charlie Widner from the firm of TransPerfect Legal Solutions, and I am the legal video specialist. The court reporter is Sue Ciminelli in association with TransPerfect Legal Solutions. Will counsel please introduce themselves.

MR. DeLAQUIL: On behalf of the Plaintiff, Mark DeLaquil of the Baker & Hostetler law firm.

MR. McBRIDE: And on behalf of the Patent and Trademark Office, Robert McBride.

THE VIDEOGRAPHER: Will the court reporter please swear in the witness, and we can

1 proceed.

2 Whereupon,

3 PATRICIA CAPERS,

4 was called as a witness by counsel for Plaintiff,

5 and having been duly sworn, was examined and

6 testified as follows:

7 EXAMINATION BY COUNSEL FOR PLAINTIFF

8 BY MR. DeLAQUIL:

9 Q. Good morning, Ms. Capers.

10 A. Good morning.

11 Q. Would you please state your name for the  
12 record?

13 A. My name is Patricia Capers.

14 Q. Thank you. Ms. Capers, have you ever  
15 been deposed before?

16 A. Yes, I have.

17 Q. Approximately how many times?

18 A. Two.

19 Q. What was the nature of the first  
20 deposition?

21 A. The first deposition dealt with an oil  
22 and gas company multistate filing.

1 Q. Was it a deposition in connection with a  
2 federal court action?

3 A. Yes, it was.

4 Q. And were you employed by the Patent and  
5 Trademark Office at that time?

6 A. No, I was not.

7 Q. Thank you. Was it a civil matter or a  
8 criminal matter?

9 A. Civil.

10 Q. What about the second deposition?

11 A. It related to the same transaction, but  
12 with different plaintiffs.

13 Q. Who were you employed with at the time of  
14 that deposition?

15 A. At the time, I was employed with Encana  
16 Oil & Gas Company.

17 Q. Sure. And was that deposition in  
18 conjunction with your employment at Encana?

19 A. Yes, it was.

20 Q. Thank you. And what was the general  
21 subject matter of the litigation in the first  
22 deposition?

1           A.     In the deposition, it involved asking  
2     about the management of records at Encana, and their  
3     affiliates and -- in Texas.

4           Q.     Was that also the subject of the second  
5     deposition?

6           A.     Yes, it was.

7           Q.     And approximately when was the first  
8     deposition?

9           A.     2003, it occurred.

10          Q.     And the second deposition?

11          A.     That was also in 2003.

12          Q.     Thank you. Ms. Capers, you've been  
13     deposed before, but I think it would make sense for  
14     us to go over, at least briefly, the general rules  
15     of the deposition.

16          A.     Thank you.

17          Q.     I represent the Plaintiff in this action,  
18     Gilbert Hyatt, and you have been designated as a  
19     representative of the Patent and Trademark Office.  
20     Do you understand that?

21          A.     Yes, I do.

22          Q.     Thank you. I'm going to ask you a series

1 of questions. If you don't understand a question,  
2 would you please let me know?

3 A. I will.

4 Q. Because if you don't let me know that you  
5 don't understand the question, I'm going to presume  
6 you understand it. Fair enough?

7 A. Yes, that's fair.

8 Q. Thanks. If you find a question  
9 confusing, would you please let me know?

10 A. I will.

11 Q. Thank you. If I've assumed an incorrect  
12 fact in a question, would you also let me know that?

13 A. Yes, I will.

14 Q. As we get into depositions about records,  
15 record keeping policies, I may use some incorrect  
16 terminology. If so, would you please correct me?

17 A. Yes.

18 Q. If you understand.

19 A. Yes.

20 Q. Thank you. Are you familiar with the  
21 subject matter of this lawsuit?

22 A. Somewhat, I am.

1 Q. Would you tell me your understanding of  
2 this lawsuit, please?

3 MR. McBRIDE: Can I just interject, just  
4 before we get too far down the road, can we just  
5 state for the record the scope of the topic that she  
6 has agreed to testify about?

7 MR. DeLAQUIL: Sure. We can go to that.  
8 No problem. But before we do that, just give me one  
9 minute.

10 MR. McBRIDE: Sure.

11 MR. DeLAQUIL: We'll go there now. Would  
12 you mark this as Exhibit 1, please?

13 (Capers Exhibit No. 1 was  
14 marked for identification.)

15 BY MR. DeLAQUIL:

16 Q. Ms. Capers, do you need your glasses?

17 A. Yes, I do. Thank you.

18 Q. Thank you. Ms. Capers, have you ever  
19 seen this document before?

20 A. No, I have not.

21 Q. This document, which has been marked as  
22 Hyatt Exhibit 1 -- excuse me, as Capers Exhibit 1,



1 is the Second Amended Notice of Deposition. If you  
2 would turn to the final page of this document,  
3 you'll see topic 26. Have you seen topic 26 before?

4 A. Yes, I have.

5 Q. And if you haven't seen this document,  
6 how have you seen topic 26?

7 A. I saw a document, in speaking with  
8 Mr. McBride, that I believe had a circle around two  
9 topics. And this appears to perhaps have been one  
10 of those topics.

11 Q. What was the other topic that had a  
12 circle around?

13 A. I don't recall.

14 Q. Would you please read the topics in this  
15 deposition notice, which would start --

16 A. It might be 14.

17 Q. 14.

18 A. Yes.

19 Q. Sure. And are you prepared to testify  
20 about topic 14?

21 A. I am.

22 Q. And are you prepared to talk -- testify

1 about topic 26?

2 A. I am.

3 MR. McBRIDE: And, Mark, I'd just like to  
4 interject. I think Ms. Stewart and you had some  
5 email discussion about this. But with respect to  
6 topic 26, Ms. Capers is prepared to talk about the  
7 second portion of that relating to the PTO's  
8 document preservation and/or retention policies,  
9 which include all such policies and procedures  
10 enacted to comply with the Federal Records Act.

11 MR. DeLAQUIL: Yes. I've asked  
12 Ms. Capers what she is prepared to testify about,  
13 but I do agree, in our correspondence, that we  
14 designated as to topic 26 this final portion, the  
15 PTO's document preservation and/or retention  
16 policies, although I would note that topic 26 is a  
17 little broader in the sense that the PTO's document  
18 preservation and retention policies are an example  
19 of the PTO's search for and production of documents.

20 So insofar as your search and production  
21 of documents relate to those specific items, I  
22 expect that Ms. Capers is able to testify about

1       those matters today.

2                   MR. McBRIDE:   Okay.   But just to be  
3       clear, she was not prepared -- she wasn't educated  
4       on what was done to search for documents.

5                   MR. DeLAQUIL:   Understood.   And I don't  
6       prepare -- I don't expect to ask Ms. Capers  
7       questions about that specific topic, or certainly  
8       not at length.

9                   MR. McBRIDE:   Okay.

10                  MR. DeLAQUIL:   Except inasmuch as it  
11       relates to the document retention and destruction  
12       policies.

13                  MR. McBRIDE:   Understood.

14                  MR. DeLAQUIL:   Thank you.

15       BY MR. DeLAQUIL:

16                  Q.       Who designated you to testify on behalf  
17       of the Patent and Trademark Office today?

18                  A.       My director, Marcie Lovett, contacted me,  
19       and contacted our executive director, David Childs,  
20       and requested that I meet with Mr. McBride, and --  
21       as the records officer for U.S. Patent and  
22       Trademark, my director, informed me that I might

1           A.     Okay.

2           Q.     And then we can go through them. And the  
3     purpose of this is for you to show me in the  
4     documents that the PTO has produced in this  
5     litigation, what exactly the PTO's policies on  
6     document retention and destruction are as to  
7     specific classes of documents.

8           A.     Okay.

9           Q.     Understand?

10          A.     Yes.

11          Q.     Thank you. The first document that I'll  
12     hand the court reporter is Bates marked PTO 16-942  
13     through PTO 16-996, and will be marked as Exhibit  
14     Capers 2. The second document that I'll hand to the  
15     court reporter is -- contains the Bates range  
16     PTO16-997 through PTO16-1028, and will be marked by  
17     the court reporter as Exhibit Capers 3.

18                 MR. DeLAQUIL: Did I give you a copy of  
19     that yet, Rob?

20                 MR. McBRIDE: Not yet.

21                         (Capers Exhibit Nos. 2-3 were  
22                         marked for identification.)

1                   MR. DeLAQUIL: The next document is Bates  
2 marked PTO 16-1029 through PTO16-1046, and will be  
3 marked as Exhibit Capers 4.

4                   (Capers Exhibit No. 4 was  
5 marked for identification.)

6                   MR. McBRIDE: Excuse me, Mark. Did you  
7 have a copy for me?

8                   MR. DeLAQUIL: Yes. I've got a copy of  
9 all of these.

10                  MR. McBRIDE: Thank you.

11                  MR. DeLAQUIL: The next document, which  
12 is Bates range PTO16-1047 through PTO16-1078 and  
13 will be marked by the court reporter as Exhibit  
14 Capers 5.

15                  (Capers Exhibit No. 5 was  
16 marked for identification.)

17                  MR. DeLAQUIL: The next document is Bates  
18 range PTO16-1079 through PTO16-1082, and will be  
19 marked by the court reporter as Exhibit Capers 6.  
20 Did I give Capers 6 to you?

21                  MR. McBRIDE: Yes, I have Capers 6.

22                  (Capers Exhibit No. 6 was

1 marked for identification.)

2 MR. DeLAQUIL: The next document is Bates  
3 marked PTO16-1083 through PTO-1125, and will be  
4 marked by the court reporter as Capers 7.

5 (Capers Exhibit No. 7 was  
6 marked for identification.)

7 BY MR. DeLAQUIL:

8 Q. Ms. Capers, each of the documents that  
9 have been marked Exhibit Capers 3 through 7 begin  
10 with a title, requests for records disposition  
11 authority. What does that mean?

12 A. An SF-115, the request for disposition  
13 authority is the document that is provided to the  
14 appraisal archivist at NARA requesting that the  
15 retention and disposition of select federal records  
16 at an agency is approved after review. Generally  
17 before this document is presented to the National  
18 Archives, the records officer or a representative  
19 meets with the organization, discusses the type of  
20 records, the use of the records, annotate that on  
21 this form, and then submits it to the National  
22 Archives for approval.

1           Upon approval, after any amendments to  
2   this document, then the retention and its  
3   instructions become the legal and operative manner  
4   in which the records would be managed until another  
5   submission overrides an existing schedule.

6           Q.     Sure. And if you look at the oldest of  
7   these documents, Exhibit Capers 2, the title was a  
8   little different. Request for authority to dispose  
9   of records?

10          A.     Yes.

11          Q.     Is that the same meaning as request for  
12   records disposition authority?

13          A.     Yes, that's the same meaning.

14          Q.     Okay. You used the term SF-115 in  
15   conjunction with these documents.

16          A.     Yes.

17          Q.     Is that because, beginning on Exhibit  
18   Capers 3, in the bottom right, it says, Standard  
19   Form 115?

20          A.     Yes. Yes. The standard form references  
21   the type of document agencies use to submit a  
22   proposed disposition schedule.

1           Q.     And it looks -- if you look at the top  
2     right, with the signature of the Archivist of the  
3     United States, or his representative, that each of  
4     the documents marked Exhibit Capers 2 through  
5     Exhibit Capers 7 has been approved.

6           A.     Yes.

7           Q.     Are you aware of any requests for records  
8     disposition authority that the PTO has made to the  
9     Archivist that are not included in Exhibits Capers 2  
10    through 7?

11          A.     The only way that I can answer that is  
12    the fact that I'm aware that we have approximately  
13    200 retention schedules, and this does not appear to  
14    encompass 200, at first glance of these documents  
15    before me. So just based on what I see here, this  
16    would not be the entire consolidated records control  
17    schedule before me.

18          Q.     Okay. So this is only some of the  
19    requests for authority to dispose of records that  
20    have been made from the PTO to the Archivist?

21          A.     That's what it appears to me.

22          Q.     Okay. Does the PTO maintain a document



1 that sets forth the disposition directions for all  
2 types of records in the agency as of today?

3 A. Yes, it's on our web page.

4 Q. It's on your web page.

5 A. Uh-huh.

6 Q. And what's that document called?

7 A. It's called the consolidated records  
8 control schedule. Consolidated, meaning that  
9 it's -- it has within that document, covering all  
10 records, both administrative and the mission  
11 records. And then it's broken down also on the web  
12 page by function. And then the consolidated  
13 schedule has all of the schedules listed.

14 Q. Is that available on the public facing  
15 Patent and Trademark Office website?

16 A. You will find -- no, we currently don't  
17 have a public facing records retention schedule on  
18 the U.S. Patent web page. We have internal  
19 schedules. We plan in the future for an outward  
20 facing, but you can also find these schedules on the  
21 NARA records retention web page.

22 Q. By these schedules, do you mean the

## Exhibit 9

**UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA**

GILBERT P. HYATT,  
Plaintiff,

v.

JOSEPH MATAL,  
Defendant.

Civil Action No. 1:09-cv-1864 (RCL)  
Civil Action No. 1:09-cv-1869 (RCL)  
Civil Action No. 1:09-cv-1872 (RCL)  
Civil Action No. 1:05-cv-2310 (RCL)

**DEFENDANT'S SECOND SUPPLEMENTAL RESPONSE TO PLAINTIFF'S  
INTERROGATORY NO. 2; CORRECTED FIRST SUPPLEMENTAL  
RESPONSES TO INTERROGATORY NOS. 2, 4, AND 7**

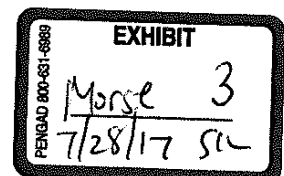
Pursuant to Federal Rule of Civil Procedure 33, Defendant, Joseph Matal,<sup>1</sup> performing the functions and duties of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office ("USPTO" or "Defendant"), by and through undersigned counsel, hereby responds to Plaintiff's First Set of Interrogatories (Nos. 1-7) ("Interrogatories") as follows:

**GENERAL OBJECTIONS**

1. Defendant objects to these Interrogatories to the extent that they seek information or materials subject to the attorney-client privilege, materials prepared in anticipation of litigation or which otherwise constitutes work product, or information which is protected by any other applicable governmental privilege, including but not limited to the deliberative process privilege.

<sup>1</sup> U.S. Secretary of Commerce Wilbur Ross named U.S. Patent and Trademark Office (USPTO) Associate Solicitor Joseph Matal to perform the functions and duties of the Under Secretary of Commerce for Intellectual Property and Director of the USPTO. The position became effective June 7, 2017, and followed the resignation of former USPTO Director Michelle K. Lee on June 6, 2017.

**PTX-019**



**PTX-019.00001**

2. Defendant objects to these Interrogatories to the extent that they seek information which is neither relevant to, nor appears reasonably calculated to lead to the discovery of admissible evidence in connection with, any claim or defense of a party to this action, for it imposes an undue burden not commensurate with legitimate discovery needs.

3. Defendant objects to each Interrogatory to the extent that it seeks information or documents not within Defendant's possession, custody, or control.

4. Defendant objects to these Interrogatories to the extent that they seek information which, if disclosed, would violate a statute or regulation, such as the Privacy Act.

5. USPTO objects to each Interrogatory to the extent that it compels the USPTO to breach its confidentiality obligations under 35 U.S.C. § 122 as applied to another applicant's application.

6. Defendant objects to each Interrogatory to the extent that the information and/or documents requested have been previously provided to the Plaintiff during the administrative proceedings underlying the four patent applications in these actions and Mr. Hyatt's other related patent applications filed at the USPTO, and to the extent the information and/or documents requested are equally available to Plaintiff.

7. Defendant reserves the right to supplement, clarify, revise or correct any or all information contained in these responses should additional or different information become available through discovery or otherwise, pursuant to Fed. R. Civ. P. 26(e).

8. In providing these responses to Plaintiff's Interrogatories, Defendant does not in any manner admit or imply that he considers any of the responses hereto, or any documents produced in response, to be relevant or material to the subject matter of this action or to the

claims or defenses of any party herein, or that such discovery responses or documents are reasonably calculated to lead to the discovery of admissible evidence.

9. Defendant does not waive and hereby reserves the right to assert any and all objections to the admissibility into evidence at the trial of this action, or in any other proceeding, of any information provided in response to the Interrogatories or any document produced or referred to in response to the Interrogatories, on all grounds, including, but not limited to, relevance, materiality, and privilege.

10. Defendant objects to the Instructions, Definitions, and Interrogatories to the extent they seek to impose or modify discovery obligations in a manner inconsistent with or more extensive in scope than those required under the Federal Rules of Civil Procedure, the Local Rules of the United States District Court for the District of Columbia, and the Court's May 2, 2017, Order On Laches Discovery (*see, e.g.*, Case No. 05-2310, ECF No. 131), particularly given the limited amount of time to conduct discovery and the Court's instructions that "discovery should be limited to factual issues surrounding whether Mr. Hyatt 'deliberately and without excuse' delayed patent prosecutions that would not be contained in the administrative record or in which the parties dispute the record," and "given the quasi-judicial nature of patent proceedings and the need for an expeditious conclusion to these cases, all discovery into these issues ought be narrow and limited to factual matters-not delve into hypotheticals or speculation or the reasons, mental processes, or conclusions of the examiners or other PTO officials." *Id.* In this regard, the USPTO objects to each Interrogatory to the extent that it calls for the production of documentation that is unduly burdensome in relation to the relevance of the sought information to the USPTO's affirmative defense of prosecution laches. Moreover, as the Court limited discovery to factual matters and excluded documents and information protected by the

deliberative process privilege, the USPTO will not search for, collect, and/or produce documents protected by the deliberative process privilege.

11. The USPTO incorporates by reference every general objection set forth above into each specific objection and response. A specific objection or response may repeat a general objection for emphasis or for some other reason. The failure to include any general objection in any specific objection or response does not waive any general objection to the Interrogatory. The USPTO reserves its right to amend its responses.

### **RESPONSES AND SPECIFIC OBJECTIONS**

Subject to and without waiving the foregoing General Objections and Qualifications, Defendant responds to Plaintiff's First Set of Interrogatories as follows:

#### **INTERROGATORY NO. 1**

Identify all patent examiners having any involvement with Mr. Hyatt's patent applications after April 8, 1995; for each such examiner, list the dates which he or she first became involved with the patent applications, ceased to be involved with the patent applications, and the patent applications with which he or she was involved.

#### **RESPONSE TO INTERROGATORY NO. 1**

Defendant objects to this Interrogatory as it seeks information contained in the administrative records of Mr. Hyatt's applications or otherwise available to the Plaintiff.

Subject to and without waiving the foregoing objections, and pursuant to Federal Rule of Civil Procedure 33(d), the USPTO has produced a document with responsive information at PTO15-0000001.

#### **INTERROGATORY NO. 2**

Identify all supervisors, managerial employees, and employees in the office of the Patent Commissioner, office of the Deputy Commissioner, Office of Patent Legal Administration, and

Office of Petitions responsible for, working on, or otherwise involved with Mr. Hyatt's patent applications after April 8, 1995; for each such supervisor, list the dates which he or she first became involved with the patent applications, ceased being involved with the patent applications, and with which patent applications he or she was involved.

**RESPONSE TO INTERROGATORY NO. 2**

Defendant objects to this Interrogatory as overbroad and unduly burdensome as it seeks information that has little or no relevance to the issue of prosecution laches and it imposes an undue burden not commensurate with legitimate discovery needs. Defendant objects to this Interrogatory as it seeks information contained in the administrative records of Mr. Hyatt's applications.

Subject to and without waiving the foregoing objections, the information sought is available from the administrative records of Mr. Hyatt's patent applications, which are in his possession, and which the USPTO has produced to plaintiff.

**[CORRECTED] FIRST SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 2**

Defendant incorporates the same objections the USPTO has previously made in response to this Interrogatory. Subject to and without waiving the foregoing objections, the USPTO supplements its response as follows:

Pursuant to Federal Rule of Civil Procedure 33(d), the USPTO has produced a document with responsive information at PTO15-0000001. The USPTO further identifies the following individuals that were involved with Mr. Hyatt's applications: Pinchus Laufer from approximately 2001-2005; Greg Morse from approximately 2013 – present; Richard Hjerpe from approximately the late-1990s to approximately 2011; Reginald Bragdon from approximately 2003 to approximately 2007.

**SECOND SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 2**

Defendant incorporates the same objections the USPTO has previously made in response to this Interrogatory. Subject to and without waiving the foregoing objections, the USPTO supplements its response as follows:

The USPTO further identifies the following individuals that were involved with Mr. Hyatt's applications: Michael Razavi from approximately 1995 – early 2000; Diego Gutierrez from approximately October 2012 – March 2013.

**INTERROGATORY NO. 3**

Identify all file histories or portions of file histories of Mr. Hyatt's patent applications that were lost by the PTO after April 8, 1995, irrespective of whether those histories were subsequently located or reconstructed; for each such history or portion of history, please provide the date and circumstances of its loss and the discovery of its loss, whether it has been restored, and, if so, the date and circumstances of its restoration.

**RESPONSE TO INTERROGATORY NO. 3**

Defendant objects to this Interrogatory as overbroad and unduly burdensome as it seeks information that has little or no relevance to the issue of prosecution laches, particularly in view of the fact that, as the Court recognized, USPTO delay cannot excuse Mr. Hyatt's delay. Defendant further objects to this Interrogatory as it seeks information concerning the circumstances of transactions that occurred many years, if not decades, ago, and the information sought imposes an undue burden not commensurate with legitimate discovery needs.

Subject to and without waiving the foregoing objections, the information sought is available from the PALM records the USPTO has produced. *See* PTO15-0000003 - 0004803.

**INTERROGATORY NO. 4**

Identify which, if any, of Mr. Hyatt's patent applications that have been subject to or otherwise associated with the Sensitive Application Warning System ("SAWS") program or any



similar program for identifying patent applications for additional scrutiny, review, or oversight; for each such application, please provide the date and nature of each program-related action to which the application was subject.

**RESPONSE TO INTERROGATORY NO. 4**

Defendant objects to this Interrogatory as it seeks information that has little or no relevance to the issue of prosecution laches, particularly in view of the fact that, as the Court recognized, USPTO delay cannot excuse Mr. Hyatt's delay. Defendant further objects to this Interrogatory as it seeks information that is apparent from the administrative records of Mr. Hyatt's applications and it seeks information that is otherwise known to Mr. Hyatt. Defendant further objects to this Interrogatory as it seeks information and documents subject to the deliberative process privilege. Defendant further objects to this Interrogatory as it compels the USPTO to breach its confidentiality obligations under 35 U.S.C. § 122 as applied to another applicant's application.

Subject to and without waiving the foregoing objections, the USPTO provides the following response. The USPTO believes approximately five of Mr. Hyatt's patent applications were flagged in the SAWS program from approximately 2000-2010. None of the four applications before the Court are included in these five applications. None of Mr. Hyatt's applications are currently flagged in the SAWS program as the program has been discontinued.

**[CORRECTED] FIRST SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 4**

Defendant incorporates the same objections the USPTO has previously made in response to this Interrogatory. Subject to and without waiving the foregoing objections, the USPTO supplements its response as follows:

The following five applications were likely in the SAWS program from approximately 2000-2010:

Application Serial No. 06/181,492;

Application Serial No. 08/286,620;

Application Serial No. 08/456,138;

Application Serial No. 08/471,214;

Application Serial No. 08/471,795.

The following application was in the SAWS program in 2014: application serial 08/456,263.

The USPTO is not aware of any other Hyatt applications that were in the SAWS program during any time period, including from 1995-2000.

**INTERROGATORY NO. 5**

For each of Mr. Hyatt's patent applications that were withdrawn from issue, including those identified in Document Request No. 7, identify the person who made the decision to withdraw it from issue and the physical location of the respective application file history (or any copy thereof) at the time of that person's decision.

**RESPONSE TO INTERROGATORY NO. 5**

Defendant objects to this Interrogatory as it seeks information that has little or no relevance to the issue of prosecution laches, particularly in view of the fact that, as the Court recognized, USPTO delay cannot excuse Mr. Hyatt's delay. Defendant further objects to this Interrogatory as it seeks information and documents subject to the deliberative process privilege. Defendant further objects to this Interrogatory as it seeks information contained in the administrative records of Mr. Hyatt's patent applications.

Subject to and without waiving the foregoing objections, the USPTO has no further information to provide other than what is included in the administrative record and the documents it has produced in response to Document Request No. 7.

**FIRST SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 5**

Defendant incorporates the same objections the USPTO has previously made in response to this Interrogatory. Subject to and without waiving the foregoing objections, the USPTO supplements its response as follows:

The following individuals were involved in the decision to withdraw from issuance U.S. Patent No. 5,625,761: Examiner Robert Harrell; SPE Parshotam Lall; Joe Rolla, Director, Group 2600.

The following individuals were involved in the decision to withdraw from issuance patent application serial no. 07/357,570: Examiner Michael Shingleton; SPE Robert Pascal; Director Rolf Hille, TC 2800; Director Gerald Goldberg, TC 2700.

The following individuals were involved in the decision to withdraw from issuance patent application serial no. 05/849,812: Bruce Lehman; Nick Godici, Director, Group 2600; Examiner Raulfe Zache; Examiner Jeffrey Brier; SPE Thomas Lee; Joe Rolla, Director, Group 2300.

The following individuals were involved in the decision to withdraw from issuance patent application serial no. 08/433,307: Examiner Terrell Fears; Nick Godici, Director, Group 2600.

**INTERROGATORY NO. 6**

For each alteration to or deletion of Patent Application Locating and Monitoring System (“PALM”) records relating to the examination or other action on Mr. Hyatt’s patent applications made after April 8, 1995, please provide the date and nature of the action and identify the person who requested or performed it or, if records of such alterations or deletions have not been maintained for any period of time subsequent to April 8, 1995, please identify all persons authorized to undertake such alterations or deletions and the time periods of such authorization.

**RESPONSE TO INTERROGATORY NO. 6**

Defendant objects to this Interrogatory as it seeks information that has little or no relevance to the issue of prosecution laches, particularly in view of the fact that, as the Court recognized, USPTO delay cannot excuse Mr. Hyatt's delay. Defendant further objects to this Interrogatory as it seeks information and documents subject to the deliberative process privilege. Defendant further objects to this Interrogatory as it seeks information contained in the administrative records of Mr. Hyatt's patent applications.

Subject to and without waiving the foregoing objections, the USPTO has produced responsive information at PTO15-0023599.

**INTERROGATORY NO. 7**

If you contend that any of the documents in the administrative records of Plaintiff's patent applications are relevant to your prosecution laches defense, identify with particularity (e.g., with a Bates number) which documents the PTO will rely upon to support its defense

**RESPONSE TO INTERROGATORY NO. 7**

Defendant objects to this Interrogatory as premature in that the USPTO is not obligated to identify at this time all of the documents it will rely upon to support its affirmative defense of prosecution laches. That being said, the USPTO has already identified in detail many of the documents that it believes supports its prosecution laches defense. *See, e.g.*, the USPTO's briefing in support of its motion to dismiss for prosecution laches, the USPTO's opposition to Mr. Hyatt's motion for discovery, and the USPTO's opposition to Mr. Hyatt's renewed motion for discovery, including the accompanying laches appendices provided therewith. *See, e.g.*, Laches Appendix volume 1, A200000-206906; Laches Appendix volume 2, A206907-208782. The USPTO has produced these laches appendices in response to Mr. Hyatt's discovery requests nos. 18, 19, 20, and 22. *See* PTO15-0014816-21530.

In that briefing, the USPTO stated that the administrative records of the four applications before the Court support the USPTO's prosecution laches defense. *Id.* The USPTO further stated in its briefing that it believes the administrative records of all his related patent applications support the USPTO's laches defense because they show Mr. Hyatt's pattern of repeatedly filing numerous claims amendments, with the result that his claim set ballooned to over 115,000, while at the same time rewriting many claims; shifting the claims to a different invention; and filing claims for the same invention in different applications—all of which has unreasonably delayed meaningful examination. *Id.* As the Federal Circuit has stated, a pattern of overall delay in a series of related patent applications can trigger prosecution laches. *See Symbol Technologies, Inc v. Lemelson Medical, Education & Research foundation, LP*, 422 F.3d 1378, 1384-86 (Fed. Cir. 2005). Thus, as the file histories of Mr. Hyatt's applications show a pattern of dilatory conduct that is highly relevant to the issue of prosecution laches, the USPTO will rely on them to supports its affirmative defense of prosecution laches.

Furthermore, the USPTO has identified additional specific examples of Mr. Hyatt's unreasonable conduct in its First Set of Interrogatories.

The USPTO reserves all rights to supplement this response and rely on any examples of conduct in the administrative records of Mr. Hyatt's patent applications that demonstrates a pattern of conduct that has delayed prosecution or otherwise supports the USPTO's affirmative defense of prosecution laches.

**[CORRECTED] FIRST SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 7**

Defendant incorporates the same objections that it previously made in response to this Interrogatory. Subject to and without waiving the foregoing objections, the USPTO supplements its response as follows:

Defendant identifies as relevant to its prosecution laches defense the substantive portions (e.g., specifications, preliminary amendments, claim amendments, office actions, office action responses, briefing to the Board, Board decisions) of the administrative records of all of Mr. Hyatt's roughly 400 applications because they show Mr. Hyatt's pattern of conduct across a series of related patent applications that unreasonably delayed examination of his claims.<sup>2</sup>

Defendant further identifies below by Bates Number a narrow subset of specific documents it will rely upon to support its prosecution laches defense. The specifically cited documents include:

- the administrative records for the four applications at issue;
- the administrative record for one or more exemplary applications selected from each of the 12 different families of Hyatt applications;
- Exemplary Office Actions and Responses;
- Examples of Overlapping Claims in the four applications at issue and other applications;
- Documents comprising the laches appendix to Defendant's motion to dismiss and Defendant's opposition to Plaintiff's renewed motion for discovery; and
- Documents cited in USPTO Interrogatories 12-17.

Defendant incorporates by reference and reserves the right to rely on any documents and/or examples cited within the specific documents identified below by Bates Number.

Defendant also incorporates by reference any documents relied upon in the forthcoming expert

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<sup>2</sup> Defendant does not identify these relevant documents by bates number because Plaintiff's counsel, Paul Levine, told the USPTO in a July 6, 2017 email at 5:09 pm: "If the PTO claims that all the documents in the application file histories are 'relevant' to its defense, simply state as much in your response in lieu of providing a long list of bates numbers. However, please separately provide the bates numbers of the documents the PTO will rely upon to support its defense, per the Court order."

reports. Defendant further reserves the right to supplement the documents it will rely on to support its prosecution laches defense as discovery progress, the parties exchange expert reports and take expert discovery, and the USPTO learns which documents Mr. Hyatt will rely on to support his contention that he has not unreasonably delayed prosecution.

<b>Applications at Issue</b>	<b>Bates Ranges</b>
Application No. 08/456,398 (09-1864)	PTO10-0044821 - 0050745 (A1-5922) <sup>3</sup>
Application No. 08/472,062 (09-1869)	PTO12-0082187 - 0083674 (A1-A1470) <sup>4</sup>
Application No. 08/431,639 (09-1872)	PTO8-0006110 - 0008058 (A1-1945) <sup>5</sup>
Application No. 08/457,211 (05-2310)	PTO10-0083133 - 0091285 (A1-12156) <sup>6</sup>

<b>Exemplary Applications</b>	<b>Bates Ranges</b>
Application No. 08/470,671	PTO2-0024275 - 0034498
Application No. 08/454,902	PTO5-0029242 - 0032896
Application No. 08/457,716	PTO6-0068278 - 0072103
Application No. 08/464,007	PTO10-0296144 - 0301861
Application No. 08/445,458	PTO11-0015615 - 0018721
Application No. 08/471,704	PTO12-0061938 - 0064570
Application No. 08/470,899	PTO12-0040146 - 0041952
Application No. 08/471,428	PTO12-0048348 - 0050287
Application No. 08/471,932	PTO4-0042668 - 0045367
Application No. 08/419,585	PTO7-0068410 - 0074687
Application No. 05/302,771	PTO3-0000001 - 0008954
Application No. 08/472,025	PTO1-0025465 - 0027965
Application No. 08/462,919	PTO8-0049202 - 0052910
Application No. 08/462,333	PTO8-0038156 - 0043138
Application No. 08/417,530	PTO9-0011254 - 0014110

<b>Exemplary Office Actions and Responses</b>	<b>Bates Ranges</b>
Application No. 07/493,061	PTO1-0002499 - 0002542

<sup>3</sup> Administrative Record for Application No. 08/456,398.

<sup>4</sup> Administrative Record for Application No. 08/472,862.

<sup>5</sup> Administrative Record for Application No. 08/431,639.

<sup>6</sup> Administrative Record for Application No. 08/457,211.

<b>Exemplary Office Actions and Responses</b>	<b>Bates Ranges</b>
Application No. 08/285,669	PTO1-0006284 - 0006327 PTO1-0004001 - 0004297
Application No. 08/428,737	PTO1-0008664 - 0008707
Application No. 08/429,272	PTO1-0011470 - 0011900
Application No. 08/433,307	PTO1-0015073 - 0015118 PTO1-0012975 - 0013188
Application No. 08/435,502	PTO1-0017528 - 0017573 PTO1-0016113 - 0016139 PTO1-0016658 - 0016676
Application No. 08/436,552	PTO1-0019594 - 0019639
Application No. 08/469,061	PTO1-0022477 - 0022522 PTO1-0020569 - 0020697
Application No. 08/471,214	PTO1-0024469 - 0024514
Application No. 08/472,025	PTO1-0027052 - 0027097 PTO1-0026105 - 0026123 PTO1-0025738 - 0025762 PTO1-0025465 - 0025503
Application No. 08/469,532	PTO2-0015604 - 0015640 PTO2-0014506 - 0014517 PTO2-0013489 - 0013792 PTO2-0014145 - 0014174
Application No. 08/469,532	PTO2-0015602 - 0015640 PTO2-0014504 - 0014517 PTO2-0014145 - 0014174 PTO2-0013487 - 0013792
Application No. 08/470,671	PTO2-0032650 - 0032686 PTO2-0033396 - 0033417 PTO2-0033584 - 0033782 PTO2-0034144 - 0034173
Application No. 08/470,879	PTO2-0036919 - 0036958



<b>Exemplary Office Actions and Responses</b>	<b>Bates Ranges</b>
	PTO2-0034501 - 0034843
Application No. 08/470,897	PTO2-0072476 - 0072512
Application No. 08/470,900	PTO2-0048330 - 0048878
Application No. 08/471,152	PTO2-0053353 - 0053389 PTO2-0051782 - 0051826
Application No. 08/471,547	PTO2-0056383 - 0056419 PTO2-0055785 - 0055816 PTO2-0055639 - 0055661
Application No. 08/471,548	PTO2-0065866 - 0065902 PTO2-0064289 - 0064325
Application No. 08/471,599	PTO2-0069419 - 0069455
Application No. 08/471,699	PTO2-0075468 - 0075504 PTO2-0074337 - 0074351 PTO2-0073976 - 0074002
Application No. 08/471,703	PTO2-0078641 - 0078677
Application No. 08/471,713	PTO2-0082281 - 0082317 PTO2-0081240 - 0081252 PTO2-0080764 - 0080794
Application No. 08/471,815	PTO2-0088104 - 0088140
Application No. 08/471,931	PTO2-0091117 - 0091153
Application No. 08/472,409	PTO2-0099441 - 0099477
Application No. 08/479,423	PTO2-0102954 - 0102990
Application No. 07/502,588	PTO2-0003928 - 0003964 PTO2-0001757 - 0002095
Application No. 07/539,936	PTO2-0007165 - 0007201
Application No. 07/541,988	PTO2-0010397 – 0010433

<b>Exemplary Office Actions and Responses</b>	<b>Bates Ranges</b>
Application No. 05/849,812	PTO4-0010038 - 0010095 PTO4-0012520 – 0012730
Application No. 08/469,528	PTO4-0015028 – 0016181
Application No. 08/470,665	PTO4-0019117 – 0019173
Application No. 08/470,666	PTO4-0021690 – 0021746
Application No. 08/470,856	PTO4-0024774 – 0024830
Application No. 08/470,859	PTO4-0027542 – 0027598
Application No. 08/470,898	PTO4-0030466 - 0030522 PTO4-0029527 - 0029782 PTO4-0029140 – 0029184
Application No. 08/471,062	PTO4-0033190 – 0033246
Application No. 08/471,434	PTO4-0035808 - 0035864 PTO4-0034567 – 0034848
Application No. 08/471,795	PTO4-0038865 – 0038921
Application No. 08/471,810	PTO4-0041406 - 0041462 PTO4-0040744 - 0040761 PTO4-0040142 – 0040222
Application No. 08/471,932	PTO4-0043839 - 0043895 PTO4-42668 – 0043055
Application No. 08/472,031	PTO4-0046783 - 0046839 PTO4-0045887 – 0045904
Application No. 08/472,032	PTO4-0049756 - 0049813 PTO4-0048684 – 0048709
Application No. 08/472,041	PTO4-0053224 - 0053281 PTO4-0052278 - 0052295 PTO4-0051371 – 0051610
Application No. 08/479,097	PTO4-0055961 - 0056017 PTO4-0055078 – 0055101
Application No. 08/483,011	PTO4-0058575 - 0058631

<b>Exemplary Office Actions and Responses</b>	<b>Bates Ranges</b>
	PTO4-0057668 – 0057685
Application No. 08/486,151	PTO4-0061881 – 0061937
Application No. 07/357,570	PTO5-0001792 – 0001820 PTO5-0000001 - 0000146
Application No. 08/454,780	PTO5-0005771 - 0007239
Application No. 08/454,877	PTO5-0010995 - 0011023 PTO5-0009315 - 0009353
Application No. 08/454,879	PTO5-0014143 - 0014170
Application No. 08/454,884	PTO5-0016919 - 0016946
Application No. 08/454,889	PTO5-0020548 - 0020575 PTO5-0018907 - 0019192 PTO5-0018396 - 0018441
Application No. 08/454,896	PTO5-0023666 - 0023692 PTO5-0022272 - 0022446
Application No. 08/454,901	PTO5-0027613 - 0027641 PTO5-0025005 - 0025046
Application No. 08/454,902	PTO5-0031425 - 0031452 PTO5-0029962 - 0030124 PTO5-0029267 - 0029322
Application No. 08/455,117	PTO5-0035008 - 0035036 PTO5-0033373 - 0033395
Application No. 08/455,164	PTO5-0038377 - 0038404
Application No. 08/455,202	PTO5-0041756 - 0041782 PTO5-0039855 - 0039904
Application No. 08/455,356	PTO5-0045881 - 0045907 PTO5-0043656 - 0043691
Application No. 08/455,435	PTO5-0049163 - 0049190 PTO5-0047356 - 0047394
Application No. 08/455,456	PTO5-0052578 - 0052604

<b>Exemplary Office Actions and Responses</b>	<b>Bates Ranges</b>
Application No. 08/455,505	PTO5-0056287 - 0056313 PTO5-0054182 - 0054296
Application No. 08/455,648	PTO5-0059431 - 0059457 PTO5-0057816 - 0057817
Application No. 08/455,738	PTO5-0061966 - 0061995 PTO5-0060737 - 0060738
Application No. 08/455,750	PTO5-0065076 - 0065102
Application No. 08/455,752	PTO5-0068782 - 0068808
Application No. 08/455,769	PTO5-0072216 - 0072242
Application No. 08/455,779	PTO5-0075470 - 0075496 PTO5-0073732 - 0073771
Application No. 08/456,126	PTO5-0078453 - 0078479 PTO5-0076836 - 0076873
Application No. 08/456,270	PTO5-0084404 - 0084430 PTO5-0082463 - 0082500
Application No. 08/457,659	PTO5-0088194 - 0088201
Application No. 08/457,941	PTO5-0091428 - 0091454
Application No. 08/501,978	PTO5-0094507 - 0094533 PTO5-0093110 - 0093147
Application No. 08/501,979	PTO5-0097725 - 0097751 PTO5-0095948 - 0095986 PTO5-0096695 - 0096717
Application No. 08/501,980	PTO5-0100800 - 0100826 PTO5-0099120 - 0099121
Application No. 08/501,981	PTO5-0103753 - 0103779 PTO5-0102282 - 0102284
Application No. 07/419,911	PTO6-0001198 - 0001236 PTO6-0000275 - 0000303 PTO6-0000001 - 0000029

<b>Exemplary Office Actions and Responses</b>	<b>Bates Ranges</b>
Application No. 08/439,032	PTO6-0004790 - 0005294 PTO6-0003986 - 0004025 PTO6-0003369 - 0003401
Application No. 08/439,033	PTO6-0008850 - 0008887 PTO6-0007399 - 0007434 PTO6-0007163 - 0007189
Application No. 08/456,327	PTO6-0012746 - 0012783 PTO6-0011350 - 0011371 PTO6-0010962 - 0011056
Application No. 08/456,332	PTO6-0016205 - 0016242
Application No. 08/456,338	PTO6-0019628 - 0019665 PTO6-0017824 - 0017995
Application No. 08/456,397	PTO6-0022728 - 0022765
Application No. 08/456,399	PTO6-0026153 - 0026190 PTO6-0024696 - 0024717
Application No. 08/456,599	PTO6-0029654 - 0029691 PTO6-0027989 - 0028016 PTO6-0027673 - 0027698
Application No. 08/457,086	PTO6-0032835 - 0032872 PTO6-0031587 - 0031608
Application No. 08/457,195	PTO6-0036744 - 0036781 PTO6-0034871 - 0034902 PTO6-0034843 - 0034870
Application No. 08/457,210	PTO6-0039940 - 0039977 PTO6-0038796 - 0038836 PTO6-0038493 - 0038518
Application No. 08/457,344	PTO6-0043672 - 0043709 PTO6-0042373 - 0042411 PTO6-0041969 - 0041996
Application No. 08/457,355	PTO6-0047275 - 0047312

<b>Exemplary Office Actions and Responses</b>	<b>Bates Ranges</b>
Application No. 08/457,361	PTO6-0050579 - 0050616
Application No. 08/457,369	PTO6-0053561 - 0053598
Application No. 08/457,446	PTO6-0059711 - 0059748 PTO6-0057790 - 0057813 PTO6-0057444 - 0057469
Application No. 08/457,609	PTO6-0063354 - 0063392
Application No. 08/457,663	PTO6-0066652 - 0066689 PTO6-0065387 - 0065416 PTO6-0065358 - 0065386
Application No. 08/457,716	PTO6-0070353 - 0070391 PTO6-0069003 - 0069041 PTO6-0068582 - 0068610
Application No. 08/457,717	PTO6-0074295 - 0074332 PTO6-0072611 - 0072634 PTO6-0072107 - 0072131
Application No. 08/457,939	PTO6-0077782 - 0077819 PTO6-0076689 - 0076724 PTO6-0076157 - 0076177
Application No. 08/457,963	PTO6-0081424 - 0081463
Application No. 08/458,003	PTO6-0085017 - 0085054 PTO6-0083739 - 0083779 PTO6-0083024 - 0083051
Application No. 08/458,102	PTO6-0088550 - 0088587
Application No. 08/458,144	PTO6-0093227 - 0093264 PTO6-0090662 - 0090681 PTO6-0090224 - 0090249
Application No. 08/458,579	PTO6-0096892 - 0096929 PTO6-0095329 - 0095336
Application No. 08/459,090	PTO6-0099463 - 0099500 PTO6-0098279 - 0098301

<b>Exemplary Office Actions and Responses</b>	<b>Bates Ranges</b>
Application No. 08/640,726	PTO6-0103052 - 0103089 PTO6-0101571 - 0101602 PTO6-0101199 - 0101226
Application No. 08/640,727	PTO6-0106647 - 0106684
Application No. 06/848,017	PTO7-0005348 - 0005385 PTO7-0003546 - 0003567
Application No. 08/417,532	PTO7-0007842 - 0008811
Application No. 08/418,211	PTO7-0014997 - 0015035 PTO7-0013640 - 0013681
Application No. 08/418,212	PTO7-0020886 - 0020924
Application No. 08/418,213	PTO7-0029187 - 0029225
Application No. 08/418,215	PTO7-0035637 - 0035404
Application No. 08/418,216	PTO7-0040194 - 0040232
Application No. 08/418,996	PTO7-0046198 - 0046236
Application No. 08/419,326	PTO7-0051368 - 0051406
Application No. 08/419,476	PTO7-0058038 - 0058076 PTO7-0055986 - 0056178
Application No. 08/419,584	PTO7-0063835 - 0063873 PTO7-0063287 - 0063355
Application No. 08/419,585	PTO7-0070653 - 0070691 PTO7-0068969 - 0069115 PTO7-0068410 - 0068463
Application No. 08/419,586	PTO7-0076992 - 0077030 PTO7-0075280 - 0075424 PTO7-0074690 - 0074740
Application No. 08/419,682	PTO7-0085231 - 0085268
Application No. 08/420,170	PTO7-0088758 - 0088795
Application No. 08/420,470	PTO7-0093586 - 0093624

<b>Exemplary Office Actions and Responses</b>	<b>Bates Ranges</b>
	PTO7-0091540 - 0091680
Application No. 08/423,073	PTO7-0099458 - 0099495
Application No. 08/423,234	PTO7-0104497 - 0104535
Application No. 08/423,235	PTO7-0109707 - 0109745
Application No. 08/423,390	PTO7-0115912 - 0115949
Application No. 08/426,361	PTO7-0121376 - 0121413
Application No. 08/426,450	PTO7-0125464 - 0125501
Application No. 08/426,521	PTO7-0130531 - 0130568
Application No. 08/426,548	PTO7-0135049 - 0135087
Application No. 08/426,549	PTO7-0138728 - 0138765
Application No. 08/426,554	PTO7-0143211 - 0143248
Application No. 08/426,754	PTO7-0148639 - 0148676
Application No. 08/426,779	PTO7-0154937 - 0154975
Application No. 08/427,547	PTO7-0159556 - 0159593
Application No. 08/428,359	PTO7-0165149 - 0165186 PTO7-0163533 - 0163680 PTO7-0163137 - 0163188
Application No. 08/434,424	PTO8-0011987 - 0012015
Application No. 08/436,854	PTO8-0019464 - 0019492 PTO8-0018351 - 0018374 PTO8-0017704 - 0017742
Application No. 08/436,855	PTO8-0023977 - 0024936 PTO8-0022959 - 0023144
Application No. 08/438,575	PTO8-0032109 - 0032137
Application No. 08/462,333	PTO8-0039786 - 0039814 PTO8-0038788 - 0038809 PTO8-0038156 - 0038193
Application No. 08/462,712	PTO8-0044687 - 0044715



Exemplary Office Actions and Responses	Bates Ranges
	PTO8-0043775 - 0043795 PTO8-0043139 - 0043175
Application No. 08/462,919	PTO8-0050421 - 0050449 PTO8-0049202 - 0049340
Application No. 08/463,109	PTO8-0054924 - 0054952 PTO8-0053171 - 0053192 PTO8-0052911 - 0052960
Application No. 08/463,117	PTO8-0061121 - 0061149 PTO8-0059992 - 0060014
Application No. 08/463,820	PTO8-0069009 - 0069037 PTO8-0067452 - 0067473
Application No. 08/464,114	PTO8-0075880 - 0075908 PTO8-0074778 - 0074800
Application No. 08/464,441	PTO8-0079986 - 0080014 PTO8-0078931 - 0078953
Application No. 08/464,986	PTO8-0086609 - 0086637
Application No. 08/465,482	PTO8-0092573 - 0092601
Application No. 08/465,627	PTO8-0095352 - 0095380 PTO8-0094009 - 0094024
Application No. 08/465,659	PTO8-0098187 - 0098215
Application No. 07/763,395	PTO9-0003024 - 0003065
Application No. 07/774,159	PTO9-0007806 - 0007847
Application No. 08/323,471	PTO9-0009293 - 0009333 PTO9-0008175 - 0008205
Application No. 08/417,530	PTO9-0012439 - 0012479 PTO9-0011675 - 0011694 PTO9-0011289 - 0011317 PTO9-0011254 - 0011288

<b>Exemplary Office Actions and Responses</b>	<b>Bates Ranges</b>
Application No. 08/419,590	PTO9-0015010 - 0015050
Application No. 08/419,681	PTO9-0017764 - 0017804 PTO9-0017171 - 0017183 PTO9-0016956 - 0016983 PTO9-0016012 - 0016949
Application No. 08/420,942	PTO9-0019999 - 0021316
Application No. 08/423,081	PTO9-0024333 - 0024373 PTO9-0023523 - 0023533 PTO9-0023181 - 0023521
Application No. 08/429,391	PTO9-0027718 - 0027758
Application No. 08/430,089	PTO9-0030074 - 0030114
Application No. 08/430,777	PTO9-0032993 - 0033033 PTO9-0032519 - 0032686 PTO9-0032005 - 0032057
Application No. 08/431,638	PTO9-0035861 - 0035901 PTO9-0034996 - 0035066
Application No. 08/432,249	PTO9-0038563 - 0038603
Application No. 08/432,384	PTO9-0040923 - 0040963
Application No. 08/432,878	PTO9-0043804 - 0043844
Application No. 08/434,449	PTO9-00465543 - 0046583
Application No. 08/435,513	PTO9-0049512 - 0049552 PTO9-0048866 - 0048880 PTO9-0048598 - 0048632
Application No. 08/435,907	PTO9-0051667 - 0051707
Application No. 08/435,924	PTO9-0053819 - 0053859
Application No. 08/435,938	PTO9-0056623 - 0056663 PTO9-0055966 - 0056022
Application No. 08/436,853	PTO9-0058949 - 0058989

<b>Exemplary Office Actions and Responses</b>	<b>Bates Ranges</b>
Application No. 08/437,527	PTO9-0061512 - 0061552 PTO9-0060937 - 0060955 PTO9-0060716 - 0060743
Application No. 08/437,736	PTO9-0064002 - 0064042 PTO9-0063381 - 0063434 PTO9-0063034 - 0063090s
Application No. 08/438,012	PTO9-0066951 - 0066991
Application No. 08/438,598	PTO9-0069707 - 0069747 PTO9-0068979 - 0069037
Application No. 08/458,197	PTO-0072089 - 0072129 PTO-0071596 - 0071612 PTO-0071449 - 0071473
Application No. 08/458,548	PTO9-0075451 - 0075491 PTO9-0075772 - 0075833 PTO9-0075842 - 0075898
Application No. 08/458,582	PTO9-0077256 - 0077296 PTO9-0076336 - 0076575
Application No. 08/459,220	PTO9-0079848 - 0079888 PTO9-0079215 - 0079229 PTO9-0078933 - 0078966
Application No. 08/459,244	PTO9-0082522 - 0082562 PTO9-0081903 - 0081917 PTO9-0081667 - 0081694 PTO9-0081637 - 0081664
Application No. 08/459,505	PTO9-0086215 - 0086255
Application No. 08/459,508	PTO9-0087954 - 0087994 PTO9-0086876 - 0086890 PTO9-0086569 - 0086601
Application No. 08/459,599	PTO9-0091059 - 0091099 PTO9-0091652 - 0091672

<b>Exemplary Office Actions and Responses</b>	<b>Bates Ranges</b>
	PTO9-0091674 - 0091704
Application No. 08/459,877	PTO9-0092476 - 0092516 PTO9-0091898 - 0091935
Application No. 08/460,064	PTO9-0096103 - 0096143 PTO9-0096706 - 0096724 PTO9-0096729 - 0096756
Application No. 08/460,092	PTO9-0098655 - 0098695 PTO9-0099330 - 0099368 PTO9-0099369 - 0099392
Application No. 08/460,550	PTO9-0101211 - 0101251
Application No. 08/460,590	PTO9-0103661 - 0103701 PTO9-0103946 - 0104040 PTO9-0104048 - 0104104
Application No. 08/460,697	PTO9-0106210 - 0106250
Application No. 08/460,768	PTO9-0108591 - 0108631
Application No. 08/460,800	PTO9-0111082 - 0111122
Application No. 08/460,966	PTO9-0113396 - 0113436
Application No. 08/461,572	PTO9-0115346 - 0115386
Application No. 08/462,306	PTO9-0118469 - 0118509 PTO9-0119185 - 0119215
Application No. 08/463,118	PTO9-0120188 - 0120228
Application No. 08/463,791	PTO9-0123119 - 0123159
Application No. 08/464,032	PTO9-0126058 - 0126098
Application No. 08/464,035	PTO9-0127794 - 0127834 PTO9-0127278 - 0127410
Application No. 08/464,037	PTO9-0130666 - 0130706 PTO9-0130300 - 0130362
Application No. 08/464,085	PTO9-0133255 - 0133295

<b>Exemplary Office Actions and Responses</b>	<b>Bates Ranges</b>
Application No. 08/464,246	PTO9-0136845 - 0136885 PTO9-0137605 - 0137621 PTO9-0137622 - 0137649
Application No. 08/464,520	PTO9-0138421 - 0138461
Application No. 08/464,521	PTO9-0141193 - 0141233
Application No. 08/464,980	PTO9-0143485 - 0143525
Application No. 08/464,995	PTO9-0145641 - 0145681 PTO9-0145247 - 0145331
Application No. 08/464,997	PTO9-0151056 - 0151096
Application No. 08/465,073	PTO9-0155091 - 0155131 PTO9-0155430 - 0155490
Application No. 08/465,152	PTO9-0157229 - 0157269
Application No. 08/465,176	PTO9-0158930 - 0158970
Application No. 08/465,923	PTO9-0164605 - 0164645
Application No. 08/466,994	PTO9-0166524 - 0166564
Application No. 08/467,471	PTO9-0169572 - 0169612
Application No. 08/469,002	PTO9-0170663 - 0170703
Application No. 07/289,355	PTO10-0022315 - 0022348
Application No. 08/456,296	PTO10-0027909 - 0027942
Application No. 08/456,333	PTO10-0035341 - 0035374
Application No. 08/456,339	PTO10-0038701 - 0038749
Application No. 08/456,901	PTO10-0051945 - 0051978
Application No. 08/457,194	PTO10-0058597 - 0058630
Application No. 08/457,196	PTO10-0065379 - 0065412 PTO10-0064701 - 0064723 PTO10-0064281 PTO10-0064519 - 0064547
Application No. 08/457,197	PTO10-0071843 - 0071876

<b>Exemplary Office Actions and Responses</b>	<b>Bates Ranges</b>
Application No. 08/457,208	PTO10-0078921 - 0078954 PTO10-0078021 - 0078043
Application No. 08/457,360	PTO10-0092155 - 0092188
Application No. 08/457,362	PTO10-0097700 - 0097733 PTO10-0096684 - 0096806
Application No. 08/457,448	PTO10-0103286 - 0103319
Application No. 08/457,715	PTO10-0108913 - 0108946 PTO10-0108168 - 0108191 PTO10-0107847 PTO10-0108119 - 0108144
Application No. 08/457,726	PTO10-0114774 - 0114807
Application No. 08/457,728	PTO10-0120906 - 0120939 PTO10-0119671 - 0119713
Application No. 08/458,004	PTO10-0125731 - 0125764 PTO10-0125370 - 0125426 PTO10-0124923 - 0125016 PTO10-0124410 - 0124452
Application No. 08/458,005	PTO10-0131615 - 0131648 PTO10-0131098 - 0131200
Application No. 08/458,006	PTO10-0136106 - 0136139
Application No. 08/458,104	PTO10-0141702 - 0141735
Application No. 08/458,141	PTO10-0144198 - 0144231 PTO10-0143524 - 0143546 PTO10-0143129 - 0143156
Application No. 08/458,142	PTO10-0149379 - 0149412
Application No. 08/458,143	PTO10-0159527 - 0159560 PTO10-0160339 - 0160361 PTO10-0160411 - 0160440
Application No. 08/458,206	PTO10-0162374 - 0162407

<b>Exemplary Office Actions and Responses</b>	<b>Bates Ranges</b>
	PTO10-0161453 - 0161544
Application No. 08/458,549	PTO10-0170832 - 0170865 PTO10-0169672 - 0169794
Application No. 08/458,608	PTO10-0176156 - 0176189
Application No. 08/458,791	PTO10-0181513 - 0181546 PTO10-0180814 - 0180836 PTO10-0180467 - 0180495 PTO10-0180402 - 0180441
Application No. 08/459,152	PTO10-0186822 - 0186855
Application No. 08/459,158	PTO10-0192311 - 0192344 PTO10-0191775 - 0191880 PTO10-0190931 - 0191000
Application No. 08/459,221	PTO10-0198054 - 0198087
Application No. 08/459,648	PTO10-0207079 - 0207112 PTO10-0205585 - 0205635
Application No. 08/459,848	PTO10-0212599 - 0212632 PTO10-0211500 - 0211626
Application No. 08/460,172	PTO10-0217790 - 0217823
Application No. 08/460,422	PTO10-0222996 - 0223029
Application No. 08/460,433	PTO10-0230264 - 0230297 PTO10-0229228 - 0229249 PTO10-0228752 - 0228782 PTO10-0228681 - 0228728
Application No. 08/460,607	PTO10-0235164 - 0235197
Application No. 08/460,612	PTO10-0241103 - 0241136 PTO10-0240298 - 0240319 PTO10-0239929 - 0239960
Application No. 08/460,705	PTO10-0247975 - 0248008 PTO10-0247220 - 0247238 PTO10-0246859 - 0246884

<b>Exemplary Office Actions and Responses</b>	<b>Bates Ranges</b>
	PTO10-0246796 - 0246828
Application No. 08/460,718	PTO10-0253485 - 0253518 PTO10-0252728 - 0252750 PTO10-0252281 - 0252308
Application No. 08/460,737	PTO10-0259889 - 0259922
Application No. 08/461,288	PTO10-0264412 - 0264445
Application No. 08/461,567	PTO10-0269849 - 0269882
Application No. 08/463,111	PTO10-0275715 - 0275748 PTO10-0274095 - 0274135
Application No. 08/463,583	PTO10-0277356 - 0277389
Application No. 08/463,821	PTO10-0279091 - 0279124
Application No. 08/463,822	PTO10-0281362 - 0281395
Application No. 08/463,823	PTO10-0286702 - 0286735 PTO10-0285894 - 0285934
Application No. 08/463,824	PTO10-0291116 - 0291149
Application No. 08/464,007	PTO10-0297384 - 0297417 PTO10-0296913 - 0297023 PTO10-0296148 - 0296208
Application No. 08/464,034	PTO10-0302288 - 0302321
Application No. 08/464,497	PTO10-0308887 - 0308920
Application No. 08/464,512	PTO10-0311706 - 0311739
Application No. 08/464,992	PTO10-0317326 - 0317359
Application No. 08/464,998	PTO10-0322603 - 0322636
Application No. 08/464,999	PTO10-0328341 - 0328374
Application No. 08/465,071	PTO10-0334012 - 0334045 PTO10-0333173 - 0333195 PTO10-0332668 - 0332695



<b>Exemplary Office Actions and Responses</b>	<b>Bates Ranges</b>
Application No. 08/465,083	PTO10-0340526 - 0340559
Application No. 08/465,173	PTO10-0347415 - 0347448 PTO10-0346323 - 0346428
Application No. 08/465,198	PTO10-0353036 - 0353069
Application No. 08/465,199	PTO10-0355483 - 0355516
Application No. 08/465,200	PTO10-0361228 - 0361261
Application No. 08/465,201	PTO10-0367254 - 0367287
Application No. 08/465,657	PTO10-0372173 - 0372206
Application No. 08/465,658	PTO10-0377518 - 0377551
Application No. 08/466,557	PTO10-0382973 - 0383006
Application No. 08/466,599	PTO10-0389002 - 0389035 PTO10-0388464 - 0388481 PTO10-0388110 - 0388131
Application No. 08/466,600	PTO10-0395287 - 0395320
Application No. 08/466,992	PTO10-0403047 - 0403080
Application No. 08/469,001	PTO10-0409785 - 0409818
Application No. 08/469,018	PTO10-0416697 - 0416730 PTO10-0416295 - 0416425 PTO10-0415618 - 0415677
Application No. 08/469,060	PTO10-0421624 - 0421657
Application No. 08/469,077	PTO10-0427130 - 0427163
Application No. 08/469,261	PTO10-0432262 - 0432295
Application No. 08/469,262	PTO10-0438801 - 0438834
Application No. 08/469,263	PTO10-0444373 - 0444406 PTO10-0443956 - 0444065
Application No. 08/469,321	PTO10-0446730 - 0446763 PTO10-0446975 - 0446997 PTO10-0445577 - 0445605

<b>Exemplary Office Actions and Responses</b>	<b>Bates Ranges</b>
Application No. 08/469,407	PTO10-0452533 - 0452566
Application No. 08/469,580	PTO10-0458252 - 0458285 PTO10-0457524 - 0457547 PTO10-0457095 - 0457123
Application No. 08/469,592	PTO10-0464895 - 0464928
Application No. 08/469,888	PTO10-0470858 - 0470891
Application No. 08/469,889	PTO10-0477003 - 0477036
Application No. 08/470,569	PTO10-0483361 - 0483394
Application No. 08/471,042	PTO10-0490995 - 0491028
Application No. 08/471,123	PTO10-0498289 - 0498322 PTO10-0497360 - 0497383 PTO10-0496877 - 0496906
Application No. 08/471,252	PTO10-0502330 - 0502363
Application No. 08/471,255	PTO10-0505015 - 0505048 PTO10-0504398 - 0504419
Application No. 08/471,425	PTO10-0512752 - 0512785
Application No. 08/471,542	PTO10-0520068 - 0520101
Application No. 08/471,553	PTO10-0527371 - 0527404
Application No. 08/471,600	PTO10-0533488 - 0533521
Application No. 08/471,633	PTO10-0541637 - 0541670
Application No. 08/471,695	PTO10-0545227 - 0545260
Application No. 08/471,846	PTO10-0552086 - 0552119 PTO10-0551648 - 0551732 PTO10-0550913 - 0550978
Application No. 07/128,659	PTO11-0008778 - 0008838
Application No. 07/182,709	PTO11-0010621 - 0010682 PTO11-0009671 - 0009728

Exemplary Office Actions and Responses	Bates Ranges
	PTO11-0009733 - 0009759 PTO11-0009733 - 0009759
Application No. 08/445,456	PTO11-0013437 - 0013498 PTO11-0012580 - 0012736
Application No. 08/445,458	PTO11-0017213 - 0017273 PTO11-0015753 - 0015789 PTO11-0015753 - 0015789 PTO11-0015615 - 0015636
Application No. 08/454,810	PTO11-0020480 - 0020540
Application No. 08/454,873	PTO11-0023452 - 0023512 PTO11-0021898 - 0021936 PTO11-0022573 - 0022590 PTO11-0022546 - 0022569
Application No. 08/454,874	PTO11-0026076 - 0026136
Application No. 08/454,875	PTO11-0030327 - 0030387 PTO11-0028522 - 0028669 PTO11-0027813 - 0027863
Application No. 08/454,878	PTO11-0032836 - 0032896
Application No. 08/454,886	PTO11-0036153 - 0036213 PTO11-0034994 - 0035048 PTO11-0034332 - 0034480 PTO11-0034527 - 0034551
Application No. 08/454,887	PTO11-0038955 - 0039015 PTO11-0038181 - 0038204 PTO11-0037588 - 0037626 PTO11-0037864 - 0037889
Application No. 08/454,984	PTO11-0042242 - 0042302 PTO11-0041441 - 0041461 PTO11-0040686 - 0040722 PTO11-0040957 - 0040981

<b>Exemplary Office Actions and Responses</b>	<b>Bates Ranges</b>
Application No. 08/455,297	PTO11-0044934 - 0044994
Application No. 08/455,303	PTO11-0047995 - 0048055 PTO11-0046430 - 0046468
Application No. 08/455,309	PTO11-0052247 - 0052307 PTO11-0050474 - 0050504 PTO11-0049546 - 0049601 PTO11-0050449 - 0050473
Application No. 08/455,310	PTO11-0055456 - 0055516
Application No. 08/455,320	PTO11-0058290 - 0058350
Application No. 08/455,924	PTO11-0061326 - 0061386
Application No. 08/456,128	PTO11-0064252 - 0064312
Application No. 08/456,129	PTO11-0067460 - 0067520 PTO11-0066249 - 0066276 PTO11-0065785 - 0065839 PTO11-0065842 - 0065871
Application No. 08/456,130	PTO11-0070146 - 0070206 PTO11-0068912 - 0069096
Application No. 08/456,138	PTO11-0073411 - 0073471 PTO11-0072092 - 0072260
Application No. 08/432,478	PTO12-0003827 - 0003863
Application No. 08/435,033	PTO12-0005858 - 0005893 PTO12-0005296 - 0005473
Application No. 08/435,894	PTO12-0007675 - 0007710
Application No. 08/435,901	PTO12-0010942 - 0010977
Application No. 08/466,164	PTO12-0012709 - 0012744
Application No. 08/466,953	PTO12-0014891 - 0014926 PTO12-0014271 - 0014460
Application No. 08/468,501	PTO12-0016498 - 0016533

<b>Exemplary Office Actions and Responses</b>	<b>Bates Ranges</b>
Application No. 08/469,058	PTO12-0018298 - 0018333
Application No. 08/469,098	PTO12-0019739 - 0019774
Application No. 08/469,565	PTO12-0021406 - 0021441
Application No. 08/469,573	PTO12-0022954 - 0022989 PTO12-0022416 - 0022572
Application No. 08/469,885	PTO12-0024846 - 0024881
Application No. 08/469,939	PTO12-0027244 - 0027279 PTO12-0027999 - 0028212
Application No. 08/470,079	PTO12-0028743 - 0028778 PTO12-0028237 - 0028409
Application No. 08/470,080	PTO12-0030391 - 0030426
Application No. 08/470,082	PTO12-0031835 - 0031870 PTO12-0031203 - 0031385
Application No. 08/470,084	PTO12-0033877 - 0033912
Application No. 08/470,177	PTO12-0035496 - 0035531 PTO12-0034814 - 0035106
Application No. 08/470,882	PTO12-0036893 - 0036928
Application No. 08/470,888	PTO12-0038733 - 0038768
Application No. 08/470,899	PTO12-0041308 - 0041343 PTO12-0041693 - 0041896
Application No. 08/471,070	PTO12-0042326 - 0042361
Application No. 08/471,135	PTO12-0045003 - 0045038
Application No. 08/471,138	PTO12-0046658 - 0046693
Application No. 08/471,428	PTO12-0048959 - 0048994 PTO12-0048348 - 0048565
Application No. 08/471,543	PTO12-0051615 - 0051650
Application No. 08/471,549	PTO12-0053073 - 0053109
Application No. 08/471,587	PTO12-0054517 - 0054935

<b>Exemplary Office Actions and Responses</b>	<b>Bates Ranges</b>
Application No. 08/471,598	PTO12-0056983 - 0057018
Application No. 08/471,700	PTO12-0058776 - 0058811
Application No. 08/471,704	PTO12-0062963 - 0062998 PTO12-0062390 - 0062532 PTO12-0061943 - 0062386
Application No. 08/471,707	PTO12-0064937 - 0064972
Application No. 08/471,708	PTO12-0067153 - 0067188 PTO12-0066603 - 0066776
Application No. 08/471,709	PTO12-0068982 - 0069017
Application No. 08/471,710	PTO12-0071147 - 0071182
Application No. 08/479,088	PTO12-0088403 - 0088439 PTO12-0087896 - 0088071
Application No. 08/483,016	PTO12-0091017 - 0091052
Application No. 08/471,925	PTO12-0078389 - 0080514

<b>Laches Appendix</b>	<b>Bates Ranges</b>
Laches Appendix - Volume I	PTO15-0014816 - PTO15-0021722 (A200000 - A206906)
Laches Appendix - Volume II	PTO15-0021723 - PTO15-0023598 (A206907 - A208782)

<b>Overlapping Claims 08/456,398</b>	<b>Bates Ranges</b>
Application No. 08/457,208	PTO10-0081518 - 0081580 at PTO10-0081553
Application No. 08/458,608	PTO10-0178789 - 0178824 at PTO10-0178798 - 0178799
Application No. 08/464,497	PTO10-0309673 - 0309737 at PTO10-0309683 - 0309684  PTO10-0309673 - 0309737 at PTO10-0309675 - 0309676
Application No. 08/469,580	PTO10-0462158 - 0462207 at PTO10-0462173  PTO10-0461862 - 0461950

	at PTO10-0461862  PTO10-0462408 - 0462510 at PTO10-0462464
Application No. 08/471,846	PTO10-0555068 - 0555181 at PTO10-0555159
Application No. 08/471,255	PTO10-0509823 - 0509902 at PTO10-0509878
Application No. 08/456,339	PTO10-0040373 - 0040490 at PTO10-0040387
Application No. 08/459,158	PTO10-0195296 - 0195319 at PTO10-0195296 PTO10-0195296 - 0195319 at PTO10-0195300
<b>Overlapping Claims 08/456,062</b>	<b>Bates Ranges</b>
Application No. 08/471,702	PTO12-0061367 - 0061445 at PTO12-0061411 - 0061412 PTO12-0061367 - 0061445 at PTO12-0061419 PTO12-0061367 - 0061445 at PTO12-0061392 - 0061393
<b>Overlapping Claims 08/431,639</b>	<b>Bates Ranges</b>
Application No. 08/464,510	PTO8-0084539 - 0084655 at PTO8-0084552 - 0084553
Application No. 08/472,041	PTO4-0051767
<b>Overlapping Claims 08/457,211</b>	<b>Bates Ranges</b>
Application No. 08/464,497	PTO10-0308657 - 0308801 at PTO10-0309677 - 0309678
Application No. 08/460,612	PTO10-0244643 - 0244746 at PTO10-0244679 - 0244680

<b>Documents Cited in USPTO Interrogatories 12 - 17</b>		
<b>No.</b>	<b>Application</b>	<b>Bates Ranges</b>
12a.	Application No. 08/459,648, Reply to Office Action, 7/11/2016, Amendment to Claim No. 121	PTO10-0206242 PTO10-0206284 - 0206285
12b.	Application No. 08/459,508, Reply to Office Action, 3/11/2015, Amendment to Claim No. 248	PTO9-0086896 PTO9-0087154 - 0087156
12c.	Application No. 07/493,061, Reply to Office Action, 6/16/2015, Amendment to Claim 3	PTO1-0001435 PTO1-0001478
13a.	Application No. 08/458,144 Claim 263, Amendment date 5/28/2003	PTO6-0093316 PTO6-0093323

<b>Documents Cited in USPTO Interrogatories 12 - 17</b>		
<b>No.</b>	<b>Application</b>	<b>Bates Ranges</b>
	Application No. 08/459,090 Claim 396 to Office Action date 12/03/2013	PTO6-0099006 PTO6-0099081
13b.	Application No. 08/458,144 Claim 265, Amendment dated 5/28/2003	PTO6-0093316 PTO6-0093323
	Application No. 08/459,090 Claim 151, Amendment dated 5/23/2003	PTO6-0099552 PTO6-0099554
13c.	Application No. 08/458,144 Claim 240, Amendment dated 5/28/2003	PTO6-0093316 PTO6-0093320
	Application No. 08/459,090 Claim 398 to Office Action dated 12/03/2013	PTO6-0099006 PTO6-0099081
13d.	Application No. 08/479,097 Claim 269 to Office Action dated 1/13/2014	PTO4-0055784 PTO4-0055826
	Application No. 08/470,665 Claim 183, Amendment dated 10/20/2004	PTO4-0019365 PTO4-0019376 - 0019377
13e.	Application No. 08/479,097 Claim 279 to Office Action dated 1/13/2014	PTO4-0055784 PTO4-0055828
	Application No. 08/470,665 Claim 188, Amendment dated 10/20/2004	PTO4-0019365 PTO4-0019379
13f.	Application No. 08/470,859 Claim 532, Amendment dated 10/20/2004	PTO4-0027792 PTO4-0027810 - 0027811
	Application No. 08/471,434 Claim 255, Amendment dated 10/20/2004	PTO4-0036060 PTO4-0036080
13g.	Application No. 08/418,212 Claim 232 and Amendment dated 5/25/2006	PTO7-0023447 PTO7-0023494
	Application No. 08/417,532 Claim 267, Amendment dated 10/19/2004	PTO7-0010811 PTO7-0010883
13h.	Application No. 08/470,879 Claim 314, Amendment dated 10/20/2004	PTO2-0037926 PTO2-0037969
	Application No. 08/471,599 Claim 173 dated 9/20/2005	PTO2-0069478 PTO2-0069507
13i.	Application No. 08/470,879 Claim 460, Amendment dated 10/20/2004	PTO2-0037926 PTO2-0038007
	Application No. 08/471,713 Claim 229 and Amendment dated 11/04/2004	PTO2-0083546 PTO2-0083583 - 0083584
13j.	Application No. 08/456,339 Claim 169, Reply to Office Action dated 8/8/2016	PTO10-0037763 PTO10-0037771
	Application No. 08/465,201 Claim 310 and Amendment dated 11/15/2004	PTO10-0369281 PTO10-0369435
13k.	Application No. 08/464,034 Claim 124 dated 3/24/2014	PTO10-0302079 PTO10-0302087
	Application No. 08/465,201 Claim 306 and Amendment dated 11/15/2004	PTO10-0369281 PTO10-0369433 - 0369434



Documents Cited in USPTO Interrogatories 12 - 17		
No.	Application	Bates Ranges
13l.	Application No. 08/464,034 Claim 196 dated 3/24/2014	PTO10-0302079 PTO10-0302109
	Application No. 08/465,201 Claim 381 and Amendment dated 11/15/2004	PTO10-0369281 PTO10-0369460 - 0369461
13m.	Application No. 08/464,034 Claim 206 dated 3/24/2014	PTO10-0302079 PTO10-0302112
	Application No. 08/465,201 Claim 536 and Amendment dated 11/15/2004	PTO10-0369281 PTO10-0369510
13n.	Application No. 08/464,034 Claim 220 dated 3/24/2014	PTO10-0302079 PTO10-0302115 - 0302116
	Application No. 08/469,261 Claim 259 to Office Action dated 3/27/2014	PTO10-0432060 PTO10-0432089
	Application No. 08/457,726 Claim 220 and Amendment dated 3/14/2005	PTO10-0116800 PTO10-0116932
13o.	Application No. 08/457,726 Claim 265 and Amendment dated 3/14/2005	PTO10-0116800 PTO10-0116950
	Application No. 08/458,141 Claim 158 and Amendment dated 9/8/2005	PTO10-0144258 PTO10-0144372 - 0144373
13p.	Application No. 08/458,006 <sup>7</sup> Claim 193 and Amendment dated 10/12/2005	PTO10-0136166 PTO10-0136295
	Application No. 08/457,726 Claim 575 dated 1/24/2014	PTO10-0114512 PTO10-0114669
13q.	Application No. 08/436,855 Claim 401	PTO8-0025251 PTO8-0025328
	Application No. 08/462,919 Claim 224	PTO8-0050784 PTO8-0050797
13r.	Application No. 08/464,114 Claim 318, Amendment dated 9/8/2003	PTO8-0076253 PTO8-0076351
	Application No. 08/436,855 Claim 197 dated 12/21/2004	PTO8-0025251 PTO8-0025291
13s.	Application No. 08/464,441 Claim 362, Amendment dated 4/30/2004	PTO8-0081272 PTO8-0081334 - 0081335
	Application No. 08/463,117 Claim 269, Amendment dated 5/28/2004	PTO8-0062260 PTO8-0062304 - 0062305
13t.	Application No. 07/774,159 Claim 93, Amendment dated 5/1/2002	PTO9-0006340 PTO9-0006350
	Application No. 08/419,681 Claim 340 to Office Action dated 3/24/2014	PTO9-0017547 PTO9-0017650
13u.	Application No. 08/430,089 Claim 256, Amendment dated 10/20/2004	PTO9-0030142 PTO9-0030193

<sup>7</sup> Application was listed as 08/456,006 under Interrogatory 13p. The correct application number is 08/458,006.

Documents Cited in USPTO Interrogatories 12 - 17		
No.	Application	Bates Ranges
	Application No. 08/462,306 Claim 275, Amendment dated 7/8/2003	PTO9-0117611 PTO9-0117624
13v.	Application No. 08/430,089 Claim 232, Amendment dated 10/20/2004	PTO9-0030142 PTO9-0030187
	Application No. 08/462,306 <sup>8</sup> Claim 296, Amendment dated 7/8/2003	PTO9-0117611 PTO9-0117631
13w.	Application No. 08/431,638 Claim 114, Amendment dated 1/16/2004	PTO9-0035952 PTO9-0035967
	Application No. 08/435,924 Claim 116 to Office Action dated 1/24/2014	PTO9-0176631 PTO9-0176642 - 0176643
13x.	Application No. 08/431,638 Claim 118, Amendment dated 1/16/2004	PTO9-0035952 PTO9-0035968
	Application No. 08/435,924 Claim 176 to Office Action dated 1/24/2014	PTO9-0176631 PTO9-0176658
13y.	Application No. 08/431,638 Claim 120, Amendment dated 1/16/2004	PTO9-0035952 PTO9-0035968 - 0035969
	Application No. 08/435,924 Claim 177 to Office Action dated 1/24/2014	PTO9-0176631 PTO9-0176658 - 0176659
13z.	Application No. 08/431,638 Claim 124, Amendment dated 1/16/2004	PTO9-0035952 PTO9-0035969 - 0035970
	Application No. 08/435,924 Claim 212 to Office Action dated 1/24/2014	PTO9-0176631 PTO9-0176665
14a.	Application No. 08/418,215, Amendment dated 8/21/2014	PTO7-0034396 - 0034734
14b.	Application No. 08/423,081, Amendment dated 1/8/2015	PTO9-0023539 - 0023791
14c.	Application No. 08/423,235, Amendment dated 9/22/2014	PTO7-0108786 - 0109077
14d.	Application No. 08/438,598, Amendment dated 5/19/2015	PTO9-0069063 - 0069316
14e.	Application No. 08/445,458, Amendment dated 11/12/2014	PTO11-0016414 - 0016695
14f.	Application No. 08/454,884, Amendment dated 5/11/2015	PTO5-0015966 - 0016237
14g.	Application No. 08/455,202, Amendment dated 1/26/2015	PTO5-0040623 - 0041053
14h.	Application No. 08/455,303, Amendment dated 11/24/2014	PTO11-0047223 - 0047530

<sup>8</sup> Application was listed as 08/462,302 under Interrogatory 13v. The correct application number is 08/462,306.

<b>Documents Cited in USPTO Interrogatories 12 - 17</b>		
<b>No.</b>	<b>Application</b>	<b>Bates Ranges</b>
14i.	Application No. 08/456,327, Amendment dated 7/17/2014	PTO6-0011396 - 0011747
14j.	Application No. 08/457,715, Amendment dated 11/17/2014	PTO10-0108215 - 0108507
14k.	Application No. 08/459,090, Amendment dated 11/21/2014	PTO6-0098323 - 0098637
14l.	Application No. 08/463,109, Amendment dated 12/3/2014	PTO8-0053854 - 0054181
14m.	Application No. 08/463,820, Amendment dated 10/30/2014	PTO8-0068066 - 0068295
14n.	Application No. 08/469,061, Amendment dated 10/28/2014	PTO1-0021621 - 0021924
14o.	Application No. 08/471,152, Amendment dated 9/4/2014	PTO2-0052406 - 0052426
14p.	Application No. 08/471,549, Amendment dated 10/17/2014	PTO12-0052528 - 0052742
14q.	Application No. 08/471,553, Amendment dated 5/26/2015	PTO10-0526573 - 0526928
14r.	Application No. 08/471,599, Amendment dated 9/25/2014	PTO2-0068609 - 0068942
14s.	Application No. 08/471,810, Amendment dated 10/3/2014	PTO4-0040789 - 0041060
14t.	Application No. 08/472,041, Amendment dated 11/24/2014	PTO4-0052317 - 0052826
15a.	Application No. 05/101,881 Claim 40 filed 12/28/1970	PTO13-0001988 PTO13-0002128
	Application No. 08/470,879 Claim 314, Supplemental Amendment dated 10/19/1998	PTO2-0038516 PTO2-0038561
15b.	Application No. 05/101,881 Claim 40 filed 12/28/1970	PTO13-0001988 PTO13-0002128
	Application No. 08/471,599 Claim 173 dated 9/20/2005	PTO2-0069478 PTO2-0069507
16a.	Application No. 08/470,879, Claim 186 filed 4/10/2014	PTO2-0036389 PTO2-0036413
16b.	Application No. 08/470,671, Claim 180 filed 1/9/2014	PTO2-0032784 PTO2-0032815
16c.	Application No. 08/471,547 Claim 155 filed 1/9/2014	PTO2-0056256 PTO2-0056280
17a.	Application No. 08/419,586 Claim 38, Amendment filed 1/11/1996	PTO7-0080398 PTO7-0080429 - 0080430

<b>Documents Cited in USPTO Interrogatories 12 - 17</b>		
<b>No.</b>	<b>Application</b>	<b>Bates Ranges</b>
	Application No. 08/454,874 Claim 121, Amendment filed 4/22/1998	PTO11-0027092 PTO11-0027146 - 0027148
17b.	Application No. 08/455,750 Claim 150, Reply to Office Action dated 4/8/2015	PTO5-0063979 PTO5-0064012 - 0064013
	Application No. 08/419,586 Claim 93, Amendment dated 2/22/2016	PTO7-0075763 PTO7-0075843 - 0075844
17c.	Application No. 08/464,114 Claim 154, Reply to Office Action dated 1/25/2015	PTO8-0074801 PTO8-0074833 - 0074834
	Application No. 08/471,815 Claim 112, Reply to Office Action dated 1/27/2015	PTO2-0087174 PTO2-0087201 - 0087202
17d.	Application No. 08/464,114 Claim 159, Reply to Office Action dated 1/28/2015	PTO8-0074801 PTO8-0074839 - 0074840
	Application No. 08/471,815 Claim 381, Reply to Office Action dated 1/27/2015	PTO2-0087174 PTO2-0087300 - 0087301
17e.	Application No. 08/433,307 Claim 68, Reply to Office Action filed 10/7/2014	PTO1-0014160 PTO1-0014196 - 0014197
	Application No. 08/419,584 Claim 27, Reply to Office Action filed 10/10/2014	PTO7-0062852 PTO7-0062882 - 0062884

Dated: July 19, 2017

Respectfully submitted,

CHANNING D. PHILLIPS, D.C. Bar #415793  
United States Attorney  
for the District of Columbia

DANIEL F. VAN HORN, D.C. Bar #924092  
Chief, Civil Division

By: /s/ Robert E. McBride  
JASON T. COHEN, ME Bar #004465  
Assistant United States Attorney  
ROBERT E. McBRIDE  
Special Assistant United States Attorney  
ROBERT J. McMANUS  
Special Assistant United States Attorney  
THOMAS W. KRAUSE  
Special Assistant United States Attorney  
United States Attorney's Office, Civil Division  
555 Fourth Street, NW  
Washington, DC 20530  
Tel: 202.252.2523  
Fax: 202.252.2599  
Email: Jason.Cohen@usdoj.gov

*Counsel for Defendant*

**CERTIFICATE OF SERVICE**

I hereby certify that on July 19, 2017, the foregoing was delivered electronically to the following counsel for Plaintiff:


Aaron M. Panner  
Thomas B. Bennett  
KELLOGG, HUBER, HANSEN, TODD, EVANS & FIGEL, P.L.L.C.  
1615 M Street, N.W.  
Suite 400  
Washington, D.C. 20036  
[apanner@khhte.com](mailto:apanner@khhte.com)  
[tbennett@khhte.com](mailto:tbennett@khhte.com)

Andrew M. Grossman  
Paul M. Levine  
Mark DeLaquil  
Baker & Hostetler LLP  
1050 Connecticut Ave., N.W.  
Suite 1100  
Washington, D.C. 20036  
[agrossman@bakerlaw.com](mailto:agrossman@bakerlaw.com)  
[pmlevine@bakerlaw.com](mailto:pmlevine@bakerlaw.com)  
[mdelaquil@bakerlaw.com](mailto:mdelaquil@bakerlaw.com)

/s/ Robert E. McBride  
ROBERT E. MCBRIDE  
Special Assistant United States Attorney

I hereby declare under penalty of perjury that the foregoing responses to plaintiff's first set of Interrogatories (No. 1-7) are true and correct to the best of my knowledge, information, and belief.

July 19, 2017

A handwritten signature in black ink, appearing to read "Gregory Morse", is written over a horizontal line.

Gregory Morse

Supervisory Patent Examiner, USPTO, GAU 2615

