HYATT v. STEWART, Appeals Nos. 2018-2390, 2018-2391, 2018-2392, 2019-1049, 2024-1992, 2024-1993, 2024-1994, 2024-1995, 2019-1038, 2019-1039, 2019-1070 (Fed. Cir. August 29, 2025). Before Reyna, Wallach, and Hughes. Appealed from D. D.C. (Judge Lamberth).

Background:

In the months leading up to the June 8, 1995 effective date for certain commitments undertaken at the Uruguay Round for the General Agreement on Tariffs and Trade ("GATT"), Mr. Hyatt filed nearly 400 patent applications ("GATT Bubble Applications"). Four of those are at issue here. The patent examiner rejected most, if not all, of the claims for each of these applications. Mr. Hyatt then appealed. And for each application, the Board affirmed the examiner's rejections of certain claims and, for some applications, the Board reversed the examiner's rejections of certain claims.

Mr. Hyatt then filed in 2005 and 2009 four district court actions under 35 U.S.C. §145 to secure allowance of all his claims. §145 allows an applicant "dissatisfied with" a Board decision to appeal that decision to the district court. The USPTO asserted affirmative defenses of prosecution laches and invalidity for anticipation and lack of written description. The district court found in Mr. Hyatt's favor, so the USPTO appealed the four judgments, and Mr. Hyatt cross-appealed on whether the district court had Article III jurisdiction over the set of claims for which the Board reversed the examiner's rejections. The Federal Circuit held that Mr. Hyatt engaged in unreasonable and unexplainable delay in prosecuting his applications at issue, but it remanded this issue to the district court for determination on whether that delay was prejudicial. Following a nearly three-week bench trial, the district court issued its decision on remand, finding that "the complete trial record require[s] a singular result—judgment for the PTO. No other result is even colorable." Mr. Hyatt filed notices of appeal in each underlying action, which were consolidated with actions from the prior appeals that were held in abeyance.

Issues/Holdings:

Did the district court err by finding for the USPTO on the affirmative defense of prosecution laches? Did the district court err by determining that it lacked Article III jurisdiction over claims for which the Board reversed the examiner's rejections? No for both.

Discussion:

Citing its decision in the prior appeal ("Hyatt I"), the Federal Circuit quickly held that prosecution laches is available for a §145 action. And it held that the district court did not abuse its discretion by ruling in the USPTO's favor here. Mr. Hyatt argued on appeal that his prosecution conduct from 1992 to 2002 was justified by a 1992 Board Decision that reversed a rejection based on prosecution laches and that he had no reason to change until a 2002 Federal Circuit decision holding that prosecution laches was available. But the Federal Circuit held that this argument was forfeited because Mr. Hyatt had not made it before the district court. And in any event, the district court had ruled in favor of the USPTO despite having been aware of Mr. Hyatt's reliance on that 1992 Board Decision as support for his serial prosecution practice.

Finally, the Federal Circuit agreed with the USPTO that Mr. Hyatt had failed to establish Article III standing over the pending claims for which the Board reversed the examiner's rejections. His bare allegations of dissatisfaction with the Board's decision do not arise to a "case or controversy" as required by Article III.