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17 **UNITED STATES DISTRICT COURT**
18 **DISTRICT OF NEVADA**

19 GILBERT P. HYATT and AMERICAN)
20 ASSOCIATION FOR EQUITABLE TREATMENT,)
21 INC.,)

22 Plaintiffs,)

23 v.)

24 UNITED STATES PATENT AND TRADEMARK)
25 OFFICE and MICHELLE K. LEE, in her official)
26 capacity as Under Secretary of Commerce for)
27 Intellectual Property and Director of the United States)
28 Patent and Trademark Office,)

29 Defendants.)

Case No: 2:16-cv-01490-RCJ-PAL

**COMBINED MOTION FOR
SUMMARY JUDGMENT AND
OPPOSITION TO PLAINTIFFS'
MOTION FOR SUMMARY
JUDGMENT**

30 Pursuant to Federal Rule of Civil Procedure 56 and the scheduling order in this case,
31 Defendants Michelle K. Lee and the United States Patent and Trademark Office (collectively
32 “USPTO”) move for summary judgment and oppose plaintiffs’ motion for summary judgment.
33 As shown in the following Memorandum of Points and Authorities, (1) plaintiffs lack standing,
34 (2) their claims are barred by res judicata, and (3) many of their claims are time-barred. Even if
35 this Court were to reach the merits of plaintiffs’ claims, the agency action at issue is lawful.

MEMORANDUM OF POINTS AND AUTHORITIES**I. INTRODUCTION**

Over twenty years ago, shortly before a series of patent reforms went into effect, plaintiff Gilbert Hyatt filed several hundred related patent applications with the USPTO. Over the course of many years, Mr. Hyatt went on to amend those applications repeatedly, in a manner that the Federal Circuit and another district court in separate suits have recently described as “extraordinary,” with the end result that the applications contained more than 115,000 total claims. The size and volume of these applications, and especially their interconnectedness and shifting nature, posed significant examination challenges for the USPTO.

Since 2012, the USPTO has devoted substantial institutional resources to the project of bringing Mr. Hyatt’s applications to a final resolution, in a coordinated and consistent manner. Fourteen examiners have been devoted full-time to examining Mr. Hyatt’s applications. In 2013, the examiners issued in almost all of Mr. Hyatt’s applications a “Requirement” that sought answers from Mr. Hyatt on the interrelationships among his applications so the agency could treat his applications consistently. In 80 of his approximately 400 total applications, Mr. Hyatt had most recently filed an appeal to the USPTO Patent Trial and Appeal Board (“Board”) and filed an appeal brief. To implement the coordinated approach, the examiners reopened prosecution in those applications, using MPEP § 1207.04—the provision Mr. Hyatt challenges here. Mr. Hyatt has made clear his displeasure with the mechanism chosen by the USPTO to streamline and expedite examination of his applications. He has sued the USPTO challenging the publication of the Requirements. *See Hyatt v. USPTO*, 797 F.3d 1374 (Fed. Cir. 2015). He has sued the Office of Management and Budget alleging that his having to respond to the Requirements constitutes a violation of the Paperwork Reduction Act. *See Hyatt v. Office of Mgmt. and Budget*, No. 2:16-cv-01944-JAD (D. Nev.). He has sued the USPTO alleging unreasonable delay in the 80 applications that had prosecution reopened by the Requirements. *Hyatt v. USPTO*, 146 F. Supp. 3d 771 (E.D.Va. 2015). And here, he alleges that the USPTO lacks authority to reopen prosecution at all once a notice of appeal to the Board has been filed. This suit suffers from fatal defects.

1 As an initial matter, plaintiffs allege only one injury—the reopening in 2013 of
2 prosecution in 80 of Mr. Hyatt’s applications. But Congress implemented a specific review
3 scheme for patent applicants, and Mr. Hyatt must raise his alleged injury in the context of a
4 particular patent application, not in a freestanding collateral attack on the agency’s ongoing
5 proceedings through a challenge to the agency’s procedures. And any allegation that he is
6 prevented from obtaining review has already been resolved by a final court decision, based on the
7 same 2013 reopening of prosecution in the same 80 applications; neither Mr. Hyatt nor anyone
8 else is free to relitigate that claim. Furthermore, the provision plaintiffs challenge has been in
9 effect since at least 1953. They cannot now challenge the USPTO’s adoption of a policy over 60
10 years ago, especially because Mr. Hyatt has known about that policy for decades.

11 If this Court were to reach the merits of plaintiffs’ claims, they should be rejected. The
12 provision plaintiffs challenge—allowing an examiner to reopen prosecution with the permission
13 of a supervisor—is reasonable and necessary to the USPTO’s ability to process patent
14 applications, does not conflict with the USPTO’s statutory and regulatory authority, and was
15 appropriately adopted as guidance without notice and comment. Applicants’ Board appeals often
16 present changed circumstances that make reopening prosecution the more efficient course,
17 whether because the applicant raises new issues in the appeal brief, or the examiner determines
18 that the existing rejections should be modified or additional rejections should be made. The
19 challenged provision simply restates the examiner’s inherent authority to reconsider his decisions
20 by allowing him to reopen prosecution before an appeal passes from his jurisdiction to the
21 Board’s. And it presents no conflict with a regulation that was written with the challenged
22 provision in mind, where the two were designed to work together.

23 **II. STATUTORY AND REGULATORY BACKGROUND**

24 **A. The USPTO is governed by the Patent Act and its own regulations, and the 25 MPEP provides further guidance**

26 The Patent Act established the USPTO, making the USPTO “responsible for the granting
27 and issuing of patents,” and authorizing it to establish regulations to “govern the conduct of
28 proceedings in the Office.” 35 U.S.C. § 2(a)(1), (b)(2)(A). The USPTO—like all federal agencies

1 operating under the Administrative Procedure Act (APA)—may also adopt guidance, consistent
2 with its statutes and regulations, covering “interpretative rules, general statements of policy, or
3 rules of agency organization, procedure, or practice.” 5 U.S.C. § 553(b)(A). To adopt guidance,
4 the USPTO is not required to provide the public with notice and an opportunity to comment. *Id.*

5 The Manual of Patent Examination Procedure (MPEP)¹ is a more-than-2600-page
6 (excluding appendices) document that lays out, in detail, procedures that guide patent examination
7 by the USPTO. It interprets relevant regulations, provides explanations of specific scenarios that
8 may arise, and gives patent examiners guidance on how to respond to certain situations.

9 **B. Before any patent can issue, each application must undergo a back-and-forth**
10 **examination process between the USPTO and the applicant**

11 The USPTO examines patent applications and is charged with determining when patents
12 should issue. *See, e.g., In re Alappat*, 33 F.3d 1526, 1535 (Fed. Cir. 1994) (en banc). Indeed,
13 “[t]he [Director] has an obligation to refuse to grant a patent if he believes that doing so would be
14 contrary to law.” *Id.* Thus, the USPTO, beginning with an examiner who has the relevant scientific
15 or technical competence, examines the application. *In re Berg*, 320 F.3d 1310, 1315 (Fed. Cir.
16 2003). If the examiner believes the claims are unpatentable for any reason, he is *obligated* to reject
17 them. *Alappat*, 33 F.3d at 1535.

18 A patent application consists of a written description, which describes the invention,
19 35 U.S.C. § 112, and one or more claims, which “provide[] the metes and bounds of the right
20 which the patent confers on the patentee to exclude others,” *Corning Glass Works v. Sumitomo*
21 *Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989). Because the applicant’s rights will be
22 determined by the scope of the claims, much of the examination process focuses on the claims.

23 Specifically, patent examination (also known as “prosecution”) generally consists of a
24 back-and-forth between the patent examiner and the applicant. The examiner initially looks at
25 each proposed claim and reviews it for novelty, support in the written description, and compliance
26 with the USPTO’s other statutory directives and rules. *See, e.g.,* 35 U.S.C §§ 101, 102, 103, 112.
27 After initial examination, the examiner sends the applicant an “office action,” which may allow

28 ¹ The MPEP is publicly available at <http://www.uspto.gov/web/offices/pac/mpep/>, including current and archived versions. Unless noted otherwise, citations refer to the current version.

1 or reject each claim. If claims are rejected, the applicant may respond with amendments, evidence
2 of patentability, arguments in favor of patentability, or some combination thereof. The goal of
3 this back-and-forth communication is to either reach an agreement on allowable claims or have
4 the examiner and the applicant set forth their positions in the administrative record for appeal to
5 the Board. 35 U.S.C. § 134. Beyond the statutory mandate that an applicant be allowed to appeal,
6 Congress did not give a procedure for how Board appeals are conducted.

7 For an application to reach the Board's jurisdiction, the applicant must file a notice of
8 appeal and an appeal brief, the examiner may file an "examiner's answer," and the applicant may
9 file a reply brief. 37 C.F.R. §§ 41.37(a), 41.39(a), 41.41(a). Only after the reply brief is filed or
10 the time for filing a reply brief expires does jurisdiction over the application pass from the
11 examiner to the Board. 37 C.F.R. § 41.35(a). USPTO regulations thus contemplate that an
12 applicant's filing of an appeal does not yet transfer jurisdiction to the Board. *See, e.g.*, 37 C.F.R.
13 § 41.31(c). Consistent with those regulations, before jurisdiction passes to the Board, the
14 examiner may realize that something about the appealed rejection requires further attention. For
15 example, he may determine upon reading the applicant's appeal brief that the existing rejection
16 lacks merit, that there is a different statutory basis for rejecting the applicant's claims (e.g., under
17 35 U.S.C. §§ 101, 102, 103, or 112), or that there is some other reason (e.g., an equitable reason)
18 beyond those already stated that the application should not be allowed to issue as a patent. Thus,
19 procedures exist for the examiner to enter new grounds of rejection in response to the applicant's
20 appeal brief.

21 One route is outlined in Rule 39, 37 C.F.R. § 41.39. Rule 39, titled "Examiner's answer,"
22 provides information about the content of the examiner's answer, including that it may include a
23 new ground of rejection. *Id.* at § 41.39(a)(2). It then provides the procedural choices available to
24 the applicant if the answer includes a new ground, specifically that the applicant can either (1)
25 request that prosecution be reopened or (2) maintain the appeal by filing a reply brief responding
26 to the new ground. *See id.* at § 41.39(b). Rule 39 does not specify that it is the only procedural
27 option for the examiner to issue a new ground of rejection before jurisdiction passes to the Board.

1 MPEP § 1207.04, titled “Reopening of Prosecution After Appeal,” explains that the
2 “examiner may, with approval from the supervisory patent examiner, reopen prosecution to enter
3 a new ground of rejection in response to appellant’s brief. A new ground as used in this subsection
4 includes both a new ground that would not be proper in an examiner’s answer . . . and a new
5 ground that would be proper (with appropriate supervisory approval).” A63-64. The same section
6 provides the USPTO’s interpretation of what constitutes a “new ground of rejection” in deciding
7 how to exercise their discretion. *See* A64 (citing MPEP § 1207.03).

8 The substance of the MPEP guidance regarding reopening of prosecution to enter a new
9 ground of rejection predates Rule 39. Rule 39 was enacted pursuant to notice-and-comment
10 rulemaking; it was first proposed on November 26, 2003, and became final on August 12, 2004.
11 A version of MPEP § 1207.04, which is substantively similar to the current version, was issued
12 soon after that in August 2005. *See* MPEP § 1207.04 (Aug. 2005). But before Rule 39 was
13 proposed and adopted, MPEP § 1208.02 explained that an “examiner may, with approval from
14 the supervisory patent examiner, reopen prosecution to enter a new ground of rejection after
15 appellant’s brief or reply brief has been filed.” *See, e.g.*, MPEP § 1208.02 (Feb. 2003); MPEP
16 § 1208.02 (Aug. 2001). Indeed, the MPEP has contained the same or similar guidance going back
17 to at least 1953. *See* MPEP § 1208.01 (Nov. 1953) (“A new ground of rejection (new reference
18 or otherwise) may be introduced after appeal either by reopening the prosecution or by including
19 the rejection in the Examiner’s Answer”). The USPTO thus adopted Rule 39 with the
20 preexisting ability to reopen prosecution in mind. A6-9.

21 **III. STATEMENT OF FACTS THAT ARE NOT GENUINELY IN DISPUTE**

22 1. Plaintiff Gilbert Hyatt is the named inventor on nearly 400 pending patent applications
23 that were filed in 1995 or earlier. Complaint ¶ 9; *Hyatt v. USPTO*, 146 F. Supp. 3d 771, 775
24 (E.D.Va. 2015) (“*Hyatt Requirement Suit*”).

25 2. Mr. Hyatt’s applications represent a unique situation in the history of the USPTO. As
26 originally filed, each of Mr. Hyatt’s approximately 400 applications contained approximately 20
27 to 100 claims. *Hyatt Requirement Suit*, 146 F. Supp. 3d at 776. Over time, Mr. Hyatt repeatedly
28 amended his patent applications, such that in August 2013, his web of interconnected applications

1 contained a total of approximately 115,000 claims. *Id.* at 773, 776. This number is unprecedented
2 for any single applicant. *Id.* at 781. For comparison, in 2015, only about 5% of patents issued
3 contained more than 30 claims. *See* Dennis Crouch, “Compact Patents,” [http://patentlyo.com/](http://patentlyo.com/patent/2015/06/compact-patents.html)
4 [patent/2015/06/compact-patents.html](http://patentlyo.com/patent/2015/06/compact-patents.html) (dated June 9, 2015; last visited Nov. 2, 2016). Indeed, *each*
5 of Mr. Hyatt’s applications constitutes one of the largest claim sets the USPTO has ever
6 encountered. *Hyatt Requirement Suit*, 146 F. Supp. 3d at 776.

7 3. Given the unprecedented size, volume, and interconnectedness of Mr. Hyatt’s
8 applications, in 2012, the USPTO dedicated twelve full-time patent examiners to the sole task of
9 examining Mr. Hyatt’s patent applications. *Hyatt Requirement Suit*, 146 F. Supp. 3d at 778; *see*
10 *id.* at 779 (later fourteen examiners).

11 4. In August 2013, the USPTO began issuing the Requirements in Mr. Hyatt’s applications.
12 The Requirements recited the “confluence of multiple factors” that made examination of Mr.
13 Hyatt’s applications “unmanageable,” including (i) the number of related pending applications,
14 (ii) the length of the specifications and number of applications incorporated by reference, (iii) the
15 number of claims, (iv) the multiplication of claims over the course of prosecution, and (v) the
16 similarity of claims. *Id.* (quoting Requirements). To remove those barriers to effective
17 examination, the Requirements instructed Mr. Hyatt to (i) select a number of claims from each
18 “family” (i.e., group of related applications), not to exceed 600 claims absent a showing that more
19 claims are necessary, (ii) identify the earliest possible priority date and supporting disclosure for
20 each selected claim, and (iii) present a copy of the selected claims to the USPTO. *Id.* Most of Mr.
21 Hyatt’s applications were before examiners at the time of the Requirements, but in 80, Board
22 appeal briefs had been filed. To effect the changes collectively and consistently, the Requirements
23 also reopened prosecution in those 80, placing the applications before the examiners.

24 5. In February 2014, Mr. Hyatt sued the USPTO in this Court, alleging that the USPTO’s
25 reopening of prosecution under MPEP § 1207.04 to issue the Requirements in 80 of his
26 applications constituted unreasonable delay. Mr. Hyatt requested “the Court to order the PTO not
27 to reopen prosecution on the appeals or otherwise delay final resolution on the merits of the
28 appeals as presented to the [Board] in each of these 80 appealed patent applications.” *Hyatt v.*

1 *USPTO*, No. 2:14-cv-00311-LDG, Compl., ECF No. 2-1 at 18, ll. 10-18 (D. Nev. Feb. 27, 2014).
2 This Court, lacking jurisdiction, transferred the case to the Eastern District of Virginia. *Hyatt v.*
3 *USPTO*, No. 2:14-cv-00311-LDG, 2014 WL 4829538 (D. Nev. Sept. 30, 2014).

4 6. The Eastern District of Virginia court granted summary judgment to the USPTO in
5 November 2015, determining that the USPTO “has already done what it is statutorily required to
6 do, namely to cause an examination of the applications. Indeed, the Requirements [which
7 reopened prosecution after appeal] expressly state that they were issued to achieve this very
8 purpose.” *Hyatt Requirement Suit*, 146 F. Supp. 3d at 783. According to the court, the USPTO in
9 those 80 applications “is now doing all that it is required to do.” *Id.* Mr. Hyatt “has no right to an
10 examination free from . . . reopened prosecution.” *Id.* at 785.

11 7. Mr. Hyatt did not appeal the Eastern District of Virginia’s decision, and it is now final.

12 8. Mr. Hyatt filed a petition in the USPTO in July 2014 seeking to repeal MPEP § 1207.04,
13 arguing that MPEP § 1207.04 is inconsistent with the USPTO’s statutes and regulations and
14 invalid because it was promulgated without notice and an opportunity to comment. A50-62.

15 9. The USPTO denied Mr. Hyatt’s petition, and he sought rehearing. A28-49. The USPTO
16 denied rehearing, explaining that “[n]o additional filings from Mr. Hyatt on this matter will be
17 entertained.” A1-27. Plaintiffs filed this suit in June 2016.

18 **IV. LEGAL STANDARDS**

19 **A. Subject matter jurisdiction**

20 Federal courts are courts of limited jurisdiction and are presumed to lack jurisdiction until
21 proven otherwise. *See Kokkonen v. Guardian Life Ins. Co. of Am.*, 511 U.S. 375, 377 (1994). The
22 party invoking jurisdiction therefore bears the burden of establishing the existence of subject
23 matter jurisdiction. *Id.* Standing, ripeness, and a time bar are all bases for finding that the Court
24 lacks subject matter jurisdiction over a case. *Chandler v. State Farm Mut. Auto Ins. Co.*, 598 F.3d
25 1115, 1122 (9th Cir. 2010) (standing and ripeness); *Miguel v. Country Funding Corp.*, 309 F.3d 1161,
26 1164 (9th Cir. 2002) (time bar). “If the court determines at any time that it lacks subject-matter
27 jurisdiction, the court must dismiss the action.” Fed. R. Civ. P. 12(h)(3). This Court must
28

1 determine whether it has subject matter jurisdiction before addressing the merits of the complaint.
2 *Steel Co. v. Citizens for a Better Env't*, 523 U.S. 83, 93-95 (1998).

3 **B. Summary judgment**

4 Summary judgment avoids unnecessary trials when there is no dispute as to the facts
5 before the Court. *Northwest Motorcycle Ass'n v. USDA*, 18 F.3d 1468, 1471-72 (9th Cir. 1994).
6 In cases involving review of a final agency determination under the APA, resolution “does not
7 require fact finding” by the Court. *Id.* at 1472. “Rather, the [C]ourt’s review is limited to the
8 administrative record.” *Id.* Here, the parties have stipulated to the administrative record.

9 **V. ARGUMENT**

10 **A. This Court lacks jurisdiction to hear plaintiffs’ claims**

11 This Court lacks jurisdiction over this case for multiple independent reasons. First,
12 plaintiffs lack standing because their only alleged injury—reopening of prosecution in Mr.
13 Hyatt’s 80 applications in 2013—must be reviewed through the review process prescribed by
14 Congress. Indeed, another federal court has already made that legal determination, meaning
15 plaintiffs’ claims are separately barred by res judicata. And to the extent that plaintiffs raise a
16 freestanding facial challenge to the USPTO’s guidance, the complaint is time-barred.

17 **1. Plaintiffs lack standing because this Court cannot redress their alleged 18 injury**

19 “Article III of the Constitution limits federal courts’ jurisdiction to certain ‘Cases’ and
20 ‘Controversies.’” *Clapper v. Amnesty Int’l USA*, 133 S. Ct. 1138, 1146 (2013). “One element of
21 the case-or-controversy requirement is that plaintiffs must establish that they have standing to
22 sue.” *Id.* (quotation marks omitted). To establish standing, “an injury must be [1] concrete,
23 particularized, and actual or imminent; [2] fairly traceable to the challenged action; and [3]
24 redressable by a favorable ruling.” *Id.* at 1147 (quotation marks omitted). The party invoking
25 federal jurisdiction bears the burden of establishing standing. *Id.* at 1148. “[A] plaintiff must
26 demonstrate standing separately for each form of relief sought.” *DaimlerChrysler Corp. v. Cuno*,
27 547 U.S. 332, 352 (2006).
28

1 In this case, the only injury plaintiffs allege is that the USPTO wrongly reopened
2 prosecution in 80 of Mr. Hyatt's applications in 2013 after he had filed appeal briefs in those
3 applications. Pls. Mem. 1-2. The alleged injury for one plaintiff, the American Association for
4 Equitable Treatment (AAET), is nonexistent,² and Mr. Hyatt's alleged injury is the USPTO's
5 having already reopened prosecution in his 80 applications in 2013. Plaintiffs here seek only to
6 collaterally attack the ongoing proceedings through a purported "facial" challenge to the MPEP
7 provision providing for reopening of prosecution.

8 But Congress has prescribed a particular route for review of agency action within a
9 particular application: After receiving final agency action, an applicant can seek judicial review
10 in the U.S. District Court for the Eastern District of Virginia or the Federal Circuit. 35 U.S.C.
11 §§ 141, 145. Thus, Mr. Hyatt cannot obtain that review through this separate collateral attack.
12 Indeed, the APA authorizes review in district court only of "final agency action for which there
13 is no other adequate remedy in court." 5 U.S.C. § 704. "A preliminary, procedural, or intermediate
14 agency action or ruling not directly reviewable is subject to review on the review of the final
15 agency action." *Id.*; *see Automated Merch. Sys., Inc. v. Lee*, 782 F.3d 1376, 1380-81 (Fed. Cir.
16 2015); *Elm 3DS Innovations, LLC v. Lee*, No. 1:16-cv-1036, ECF No. 61, slip op. at 8-9 (E.D.Va.
17 Dec. 2, 2016) ("Collateral APA attacks in the district court on ongoing [USPTO] proceedings
18 improperly contravene the Congressional intent to confer . . . jurisdiction [over review of USPTO
19 proceedings] solely on the Federal Circuit."). Mr. Hyatt may seek redress for the 2013
20 Requirement when he appeals a final agency action in one of his applications.

21
22
23 ² AAET has not shown that it meets any of the threshold requirements to sue under the APA, such
24 as suffering any "legal wrong" or being "adversely affected or aggrieved" by USPTO action.
25 5 U.S.C. § 702. AAET does not allege that it was party to Mr. Hyatt's applications or his petitions,
26 does not allege that it has any patent applications pending, and does not allege that it is otherwise
27 subject to MPEP § 1207.04. It asserts merely that it was "founded in 2016 to promote and
28 advocate for the fair, efficient, and effective administration of laws related to technology,
innovation, and intellectual property, including the Patent Act and related statutes." Compl. ¶10.
Yet "a mere interest in a problem . . . is not sufficient by itself to render the organization adversely
affected or aggrieved." *Sierra Club v. Morton*, 405 U.S. 727, 739 (1972) (marks omitted). To the
extent that AAET asserts standing because Mr. Hyatt is a member, the standing inquiry collapses
into Mr. Hyatt's standing inquiry. *See Warth v. Seldin*, 422 U.S. 490, 511 (1975).

1 To the extent that Mr. Hyatt believes that he is “threatened” by MPEP § 1207.04, any such
2 future injury is “speculative.” *Clapper*, 133 S. Ct. at 1147. A “threatened injury must be *certainly*
3 *impending* to constitute injury in fact, and . . . allegations of *possible* future injury are not
4 sufficient.” *Id.* (marks omitted). In fact, the USPTO explained in court that it intended to quickly
5 process any future appeals, including filing examiner’s answers and issuing Board decisions, with
6 respect to the 80 applications in which prosecution was reopened in 2013 to issue the
7 Requirements. *Hyatt Requirement Suit*, 146 F. Supp. 3d at 779-80.

8 Mr. Hyatt’s allegation that he is somehow injured by the MPEP suffers from another
9 defect: He cannot be injured by the MPEP. The MPEP does not *require* examiners to reopen
10 prosecution in any particular application. Rather, it simply states that reopening is permissible in
11 certain circumstances. And the agency would have been free to reopen prosecution, even absent
12 that statement in the MPEP. *See infra* 18-19; A12-14 & n.4. Thus, MPEP § 1207.04 did not cause
13 Mr. Hyatt’s alleged injury, and vacating MPEP § 1207.04 would not redress the alleged injury.
14 *See Scenic Am., Inc. v. U.S. Dep’t of Transp.*, 836 F.3d 42, 52-53 (D.C. Cir. 2016) (explaining
15 that plaintiff lacked standing because there was no evidence that, absent the challenged guidance,
16 the agency would have behaved any differently).

17 Finally, to the extent that Mr. Hyatt asserts that the USPTO’s ability to reopen prosecution
18 hampers his ability to *receive* an appealable final agency action, his route to make that argument
19 was a suit for unreasonable delay under the APA. Mr. Hyatt already brought that suit and lost.
20 *Hyatt Requirement Suit*, 146 F. Supp. 3d at 783. The court explained that the USPTO in Mr.
21 Hyatt’s 80 applications “is now doing all that it is required to do.” *Id.* at 783. Mr. Hyatt “has no
22 right to an examination free from . . . reopened prosecution.” *Id.* at 785 & n.33 (addressing MPEP
23 § 1207.04). Plaintiffs cannot, through this lawsuit, collaterally attack the USPTO’s reopening of
24 prosecution in 2013.

25 2. Plaintiffs’ claims are barred by res judicata

26 Given Mr. Hyatt’s complaint in the *Hyatt Requirement Suit* and the Eastern District of
27 Virginia’s decision denying relief, plaintiffs’ complaint in this case is also barred by res judicata.
28 In the *Hyatt Requirement Suit*, Mr. Hyatt focused on the argument that the USPTO should not

1 have been allowed to reopen prosecution in 2013 in his 80 applications because it prevented his
2 applications from receiving a Board decision. 146 F. Supp. 3d at 778, 780. And the court
3 determined that the USPTO in Mr. Hyatt's 80 applications "is now doing all that it is required to
4 do." *Id.* at 783. To the extent that Mr. Hyatt believed that the MPEP provision that supports the
5 USPTO's ability to reopen prosecution in those applications was invalid for any reason, Mr. Hyatt
6 should have raised it then because that issue is inextricably intertwined with the issues he did
7 raise. *See, e.g., Finch v. Hughes Aircraft Co.*, 926 F.2d 1574, 1577 (Fed. Cir. 1991) ("Count I of
8 the complaint arises out of substantially the same subject matter as the 1980 complaint (i.e., the
9 same patents), and thus is barred by res judicata because it *could* have been, but was not, raised
10 in the 1980 complaint."); *Stewart v. U.S. Bancorp*, 297 F.3d 953, 959 (9th Cir. 2002). Thus, to
11 the extent that Mr. Hyatt alleges standing here based on the reopening of prosecution in 2013 of
12 his 80 patent applications, that claim should have been raised in the *Hyatt Requirement Suit*. The
13 same is true for AAET, to the extent that it bases its standing on Mr. Hyatt's applications.

14 **3. Most of plaintiffs' claims are time-barred**

15 Even if plaintiffs had standing, most of their claims are time-barred. "[E]very civil action
16 commenced against the United States shall be barred unless the complaint is filed within six years
17 after the right of action first accrues." 28 U.S.C. § 2401(a). This statute of limitations applies to
18 facial challenges to agency regulations brought under the APA. *See Wind River Mining Corp. v.*
19 *United States*, 946 F.2d 710, 712-13 (9th Cir. 1991); *Sierra Club v. Penfold*, 857 F.2d 1307, 1315
20 (9th Cir. 1988); *Cordis Corp. v. Kappos*, No. 1:11-cv-127, 2011 WL 4369118, *4 (E.D.Va. Sept.
21 16, 2011) (dismissing facial challenge to USPTO regulation as time-barred).

22 The statute of limitations begins to run on a facial challenge when the regulation is
23 promulgated. *Dunn-McCampbell Royalty Interest, Inc. v. Nat'l Park Serv.*, 112 F.3d 1283, 1287
24 (5th Cir. 1997) (citing, among others, *Friends of Sierra Railroad, Inc. v. Interstate Commerce*
25 *Comm'n*, 881 F.2d 663, 667-68 (9th Cir. 1989)). That is because the person bringing suit is
26 deemed to have notice of the regulation as of that date. *Dunn-McCampbell*, 112 F.3d at 1287
27 (citing 44 U.S.C. § 1507 for proposition that "filing a document in the Federal Register is
28 sufficient to give notice of the contents to any person subject to or affected by it").

1 Here, plaintiffs challenge MPEP § 1207.04. But the substance of that provision has been
2 in the MPEP since at least 1953. *See supra* 6. Plaintiffs assert that the provision conflicts with
3 several statutes and regulations: 35 U.S.C. §§ 6(b)(1), 6(c), and 134(a), and 37 C.F.R. §§ 41.39
4 and 41.31(a)(1). Pls. Mem. 7-23. But those provisions have all been in the law for many years as
5 well—the substance of the statutory provisions was enacted in 1952, and the substance of the
6 regulations was enacted in 2004.³

7 Thus, here, the statute of limitations began to run, at the latest, when the USPTO
8 promulgated Rules 39 and 31(a)(1), in 2004. Plaintiffs filed their complaint in 2016, twelve years
9 later, long after the six-year statute of limitations had expired.⁴

10 The time bar unquestionably operates against any challenge to the USPTO’s procedure in
11 adopting MPEP § 1207.04, which has been on the books for decades. Pls. Mem. 17-23; Complaint
12 Count I. Mr. Hyatt filed a petition seeking repeal of MPEP § 1207.04 in 2014, but that cannot
13

14 ³ The substance of section 6(b)(1) was enacted, as 35 U.S.C. § 7, in 1952. *Compare* 35 U.S.C. § 7
15 (1952) (The “Board . . . on written appeal of the applicant, shall review adverse decisions of
16 examiners upon applications for patents.”) *with* 35 U.S.C. § 6(b) (2012) (The “Board shall—(1)
17 on written appeal of an applicant, review adverse decisions of examiners upon applications for
18 patents pursuant to section 134(a).”). The substance of section 6(c) was also part of 35 U.S.C. § 7
19 in 1952. *Compare* 35 U.S.C. § 7 (1952) (“Each appeal shall be heard by at least three members
20 of the [Board], the members hearing such appeal to be designated by the Commissioner [now
21 Director]. The [Board] has sole power to grant rehearings.”) *with* 35 U.S.C. § 6(c) (2012) (“Each
22 appeal . . . shall be heard by at least 3 members of the [Board], who shall be designated by the
23 Director. Only the [Board] may grant rehearings.”). The substance of section 134(a) was enacted
24 in 1952. *Compare* 35 U.S.C. § 134 (1952) (“An applicant for a patent, any of whose claims has
25 been twice rejected, may appeal from the decision of the primary examiner to the [Board], having
26 once paid the fee for such appeal.”) *with* 35 U.S.C. § 134(a) (2012) (“An applicant for a patent,
27 any of whose claims has been twice rejected, may appeal from the decision of the primary
28 examiner to the [Board], having once paid the fee for such appeal.”). And Rules 39 and 31(a)(1)
have been substantially the same since they were promulgated in 2004. *See* Pls. Mem. 16 (stating
that amendments to Rule 39 did not change the examiners’ authority regarding reopening
prosecution).

⁴ The statute of limitations also cannot be tolled. Even if equitable tolling were available—which
is questionable, *see P & V Enters. v. U.S. Army Corps of Eng’rs*, 516 F.3d 1021, 1026-27 (D.C.
Cir. 2008); *Ctr. for Biological Diversity v. Hamilton*, 453 F.3d 1331, 1335-36 (11th Cir. 2006);
Aloe Vera of Am., Inc. v. United States, 580 F.3d 867, 872 (9th Cir. 2009)—Mr. Hyatt has known
of the practice since at least 1983, when an examiner reopened prosecution in one of Mr. Hyatt’s
applications after an appeal brief had been filed. *See* U.S. Patent Application No. 06/160,872,
office action of Dec. 27, 1983, at 2, *available at* portal.uspto.gov/pair/PublicPair.

1 excuse the delay in his challenge to the procedure the USPTO used to adopt it. As the Ninth
2 Circuit has explained, regardless of whether a recent petition was filed, “[i]f a person wishes to
3 challenge a mere procedural violation in the adoption of a regulation or other agency action, the
4 challenge must be brought within six years of the decision [adopting the regulation].” *Wind River*,
5 946 F.2d at 715. “The grounds for such challenges will usually be apparent to any interested
6 citizen within a six-year period following promulgation of the decision; one does not need to have
7 a preexisting [specific claim] . . . to discover procedural errors in the adoption of a policy.” *Id.*
8 The D.C. Circuit agrees, explaining that a “petitioner’s contention that a regulation suffers from
9 some *procedural* infirmity such as an agency’s unjustified refusal to allow affected parties to
10 comment on a rule before issuing it in final form, will not be heard outside of the statutory
11 limitations period.” *NLRB Union v. Fed. Labor Relations Auth.*, 834 F.2d 191, 196 (D.C. Cir.
12 1987). “Countenancing such challenges . . . would on balance waste administrative resources and
13 unjustifiably impair the reliance interests of those who conformed their conduct to the contested
14 regulation.” *Id.* The USPTO and its millions of applicants have such a strong interest in finality.
15 *See id.*; *Wind River*, 946 F.2d at 715. Thus, plaintiffs’ argument that “MPEP § 1207.04 Is Invalid
16 Because It Was Not Subject to Notice-and-Comment Rulemaking” (Pls. Mem. 17-23) cannot be
17 raised now.

18 The time bar also applies against plaintiffs’ arguments that the MPEP provision conflicts
19 with various statutory and regulatory provisions (Pls. Mem 7-17, Complaint Counts II and IV).
20 In *Wind River*, the Court explained that the time bar to bring a facial challenge to a rule begins to
21 run from promulgation of the rule. 946 F.2d at 715 (“Similarly, if the person wishes to bring a
22 policy-based facial challenge to the government’s decision, that too must be brought within six
23 years of the decision.”). As discussed above, that clock long expired.

24 The Court explained that there is an exception: The statute of limitations can restart when
25 a party is challenging an agency rule *as applied to him*. *Id.* at 715-16 (“The challenge must be
26 brought within six years of the agency’s application of the disputed decision [i.e., regulation] to
27 the challenger.”). But to the extent Mr. Hyatt is challenging the agency’s application of MPEP
28

1 § 1207.04 to him in 2013, he lacks standing to raise such an as-applied challenge, as explained
2 above. The facial challenge is time-barred.

3 The only claim that can survive the time bar (but not the other jurisdictional bars) is the
4 argument that the USPTO unlawfully declined to implement a new rulemaking. Pls. Mem. 23-24.
5 For the vast majority of plaintiffs' claims, the statute of limitations is a bar.

6 **B. MPEP § 1207.04 does not conflict with the Patent Act or USPTO regulations**

7 Even if this Court had jurisdiction to hear plaintiffs' claims regarding MPEP § 1207.04,
8 plaintiffs' summary judgment motion fails to provide any basis to invalidate that provision. The
9 USPTO's interpretation of its own statute and regulations are entitled to deference. *See Chevron*
10 *USA Inc. v. NRDC*, 467 U.S. 837 (1984); *Auer v. Robbins*, 519 U.S. 452 (1997). And contrary to
11 plaintiffs' argument (Pls. Mem. 8-9 n.3), the USPTO was clear that MPEP § 1207.04 interprets
12 the statute and regulations because it, for example, "clarifies the USPTO's authority in the context
13 of Board appeals under 35 U.S.C. § 134 and related USPTO regulations." A25; *see Refac Int'l,*
14 *Ltd. v. Lotus Dev. Corp.*, 81 F.3d 1576, 1584 n.2 (Fed. Cir. 1996) (MPEP is "the agency's official
15 interpretation of statutes and regulations").

16 Plaintiffs assert that MPEP § 1207.04 conflicts with 35 U.S.C. §§ 6(b)(1) and 134(a) and
17 Rule 39. The substance of MPEP § 1207.04 has coexisted with those two statutory provisions
18 since just after the Patent Act was enacted in 1952, *see supra* 13 & n.3, and Rule 39 was written
19 with the already-existing MPEP provision in mind. There is no conflict.

20 **1. MPEP § 1207.04 does not conflict with or exceed the USPTO's**
21 **authority under the Patent Act**

22 The Patent Act gives the broad outlines of the patent examination process, in which an
23 examiner first examines an application, and if the applicant is dissatisfied with the examiner's
24 decision and his claims have been twice rejected by the examiner, he may appeal the rejection to
25 the Board. *See* 35 U.S.C. § 134(a). The Patent Act establishes the Board and lists its "Duties,"
26 including "review[ing] adverse decisions of examiners." 35 U.S.C. § 6(b)(1).

27 The USPTO regulations governing appeals to the Board explain that jurisdiction passes to
28 the Board only after the applicant files a reply brief or the time for filing one passes. 37 C.F.R.

1 § 41.35(a). As already mentioned, an examiner may realize, before jurisdiction passes to the
2 Board, that something about an appealed rejection requires adjustment. Thus, procedures exist for
3 the examiner to enter new grounds of rejection in response to the applicant's appeal brief, rather
4 than requiring the applicant, the examiner, and the Board to undergo an entire appeal before the
5 examiner has the chance to issue the appropriate rejection on remand. The examiner may follow
6 the route outlined in Rule 39 and issue a new ground of rejection in the examiner's answer, or he
7 may follow the route discussed in MPEP § 1207.04 and reopen prosecution to issue it.

8 The agency's decision to reopen prosecution instead of filing an answer does not violate
9 either section 6 or section 134(a) of the Patent Act. As an initial matter, section 6 does not create
10 any rights. *In re Hengehold*, 440 F.2d 1395, 1404 (CCPA 1971) (referring to predecessor § 7);
11 A9-10. Section 6 establishes the Board and lists its duties, including "review[ing] adverse
12 decisions of examiners." 35 U.S.C. § 6(b)(1). But section 6 does not provide an applicant with a
13 right to appeal to the Board; section 6 only "provides in general terms an organization or vehicle
14 for review of adverse decisions." *Hengehold*, 440 F.2d at 1404. Plaintiffs argue that *Hengehold*
15 actually supports their position because it confirms "that an applicant has a statutory right of
16 review for rejections." Pls. Mem. 9. But that is not the issue; contrary to plaintiffs' stark
17 characterization of the USPTO petition decision (Pls. Mem. 11), there is no dispute that the statute
18 provides applicants with an administrative vehicle for review of rejections.⁵ The central question
19 is whether section 6 obligates the Board to reach the merits of such a challenge simply because it
20 was filed. *Hengehold's* express holding that section 6 does not provide for any rights, but is
21 merely an organizational construct, does not support that conclusion.

22 Plaintiffs' position that later Federal Circuit precedent "recognized" that section 6
23 establishes an obligation on the Board to review rejections simply because a notice of appeal is
24 filed (Pls. Mem. 10) is not correct. First, the cases cited by plaintiffs were decided after *Hengehold*

25 ⁵ Plaintiffs' reading of the statute is absolute: the Board must reach the merits of an appeal once
26 filed. Yet plaintiffs would still permit the Board to be divested of that allegedly absolute
27 obligation by an applicant's reopening of prosecution under Rule 39. Indeed, plaintiffs' summary
28 judgment motion is based on the *premise* that Rule 39 is a valid regulation. The statute cannot be
absolutely binding on the agency charged with administering the statute, while it is permissive to
the party seeking a property right from that agency.

1 and thus cannot alter its holding absent en banc consideration. Second, the cited cases stand for
2 the proposition that *if* the appeal reaches the Board’s jurisdiction, *and* is disposed of on the merits,
3 the applicant must be given a chance to respond if the Board has issued a new rejection not
4 provided by the examiner. *See In re Leithem*, 661 F.3d 1316, 1319 (Fed. Cir. 2011); *In re*
5 *McDaniel*, 293 F.3d 1379, 1384 (Fed. Cir. 2002). Neither holds that section 6 (or any other
6 statutory section) creates an obligation for the Board to reach the merits of contested rejections
7 simply because a notice of appeal has been filed.⁶ Plaintiffs’ insistence on parsing section 6 to
8 support that “right” fails. Pls. Mem. 9-10.

9 Plaintiffs’ reliance on Section 134(a) fares no better. As an initial matter, Mr. Hyatt’s
10 petitions did not assert a violation of section 134(a). A31-32; *see also* A10. Thus, plaintiffs waived
11 the argument asserting a violation of section 134(a). *See Advocates for Highway and Auto Safety*
12 *v. Federal Motor Carrier Safety Admin.*, 429 F.3d 1136, 1150 (D.C. Cir. 2005) (“[A] party will
13 normally forfeit an opportunity to challenge an agency rulemaking on a ground that was not first
14 presented to the agency for its initial consideration.”).

15 Even if the argument were not waived, section 134(a) provides an applicant with a right
16 to appeal to the Board (*see Hengehold*, 440 F.2d at 1404), but nothing in that section or elsewhere
17 in the Patent Act creates an unavoidable duty for the Board to reach the merits of rejections or to
18 come to any particular result in an appeal, simply because a notice of appeal has been filed.
19 Indeed, as the USPTO explained to Mr. Hyatt, even though an applicant may file a notice of
20 appeal, there are a number of reasons the Board may never hear that appeal or may hear it at a
21 later time. A10-13. For example, within section 134(a) itself, the applicant must have claims that
22 have been twice rejected and must have “once paid the fee” for an appeal. A10. And, in fact,

23
24 ⁶ Plaintiffs’ focus on use of the word “shall” before listing the Board’s duties in section 6(b)(1),
25 in alleged contrast with sections 6(c) and 6(d), which use the word “may” (Pls. Mem. 9), is inapt.
26 Section 6(c) states, “*Only the Patent Trial and Appeal Board may grant rehearings.*” 35 U.S.C.
27 § 6(c) (emphasis added). That statement is not intended to contrast with the word “shall”; it is
28 intended to show that *no one other than the Board* may grant rehearings. And section 6(d) uses
the word “may” precisely because it is completely “in the Secretary’s discretion”; the Secretary
may decide to take a certain action but may decide not to. On the other hand, section 6(b) is not
permissive; it prescribes a list of duties exclusive to the Board.

1 section “134(a)’s recognition that the applicant need only have ‘once paid the fee’ for an appeal
2 recognizes that an applicant’s appeal might be reinstated later, after further action by the USPTO,
3 but that the applicant in that situation need not pay the fee again for that particular appeal.”⁷ A10.

4 Moreover, as the USPTO explained to Mr. Hyatt, the Patent Act and USPTO regulations
5 impose time limits, requirements for the contents of an applicant’s brief, and mandatory fees that
6 must accompany appeals. A11 (citing 35 U.S.C. §§ 133, 41(a)(6), 2(b)(2)(A) & (B); 37 C.F.R. §§
7 41.4, 41.35(b)(5), 41.37, 41.45); *see also* 37 C.F.R. § 41.31(c) (“Questions relating to matters not
8 affecting the merits of the invention may be required to be settled before an appeal can be
9 considered.”). An applicant’s failure to comply with those requirements prevents an applicant
10 from having an appeal heard by the Board and in some cases results in abandonment of the
11 application, even though the applicant has filed a “written appeal” as specified in section 6. A11.

12 Thus, as the Federal Circuit has made clear, the Board may adjudicate an appeal without
13 “review[ing] adverse decisions of examiners.” *See, e.g., In re Riggs*, 457 F. App’x 923, 925 (Fed.
14 Cir. 2011) (discussing approvingly the rules that require that an appeal be “properly prepare[d]”
15 before it reaches the Board); *In re James*, 432 F.2d 473, 475-76 (CCPA 1970) (holding that Court
16 lacked jurisdiction to review Board action disposing of appeal on procedural matters); *id.* at 475-
17 76 (statute only confers authority to Board and appeal may be disposed of without conducting
18 merits review) (Rich, J., dissenting); *In re Voss*, 557 F.2d 812, 816 (CCPA 1977). Plaintiffs’
19 summary judgment motion does not address this precedent, which was cited in the USPTO
20 petition decision. A11.

21 Furthermore, as explained above, the Board does not take jurisdiction over an appeal until
22 either the applicant files a reply brief or the time for filing one passes pursuant to 37 C.F.R.
23 § 41.35(a), which plaintiffs have never challenged (*see* Pls. Mem. 12 n.5). The examiner remains
24 the USPTO official responsible for considering the merits of the application when a Board appeal
25 brief is filed. The examiner’s obligation to consider the patentability of the proposed claims does
26 not terminate because an applicant has filed a Board appeal. A12. Examiners thus possess an

27 ⁷ Plaintiffs assert that having “once paid the fee” for an appeal applies only to when the applicant
28 chooses to reopen prosecution under Rule 39. Pls. Mem. 11. But the statute is not so limited.
Indeed, as explained above, that statutory language long predates Rule 39. *Supra* 13 n.3.

1 inherent ability to revisit their earlier patentability decisions, particularly in light of the arguments
2 advanced in the appeal brief (which are often new to the proceedings). *Id.*; *see, e.g., Tokyo Kikai*
3 *Seisakusho, Ltd v. United States*, 529 F.3d 1352, 1360-61 (Fed. Cir. 2008) (“[T]he courts have
4 uniformly concluded that administrative agencies possess inherent authority to reconsider their
5 decisions, subject to certain limitations, regardless of whether they possess explicit statutory
6 authority to do so.”); *Last Best Beef, LLC v. Dudas*, 506 F.3d 333, 340-41 (4th Cir. 2007) (as a
7 federal agency, USPTO possesses “inherent discretion to correct its own errors and to manage its
8 own docket”); *see Ivy Sports Med., LLC v. Burwell*, 767 F.3d 81, 86 (D.C. Cir. 2014); *Macktal v.*
9 *Chao*, 286 F.3d 822, 825-26 (5th Cir. 2002) (collecting cases). Indeed, plaintiffs recognize that
10 an appellate body can only hear an appeal “where jurisdiction properly lies,” in this case once the
11 time for filing a reply brief passes. Pls. Mem. 11, 12 n.5.

12 That legal principle has particularly strong application in the patent examination context,
13 given that the Director “has an obligation to refuse to grant a patent if [s]he believes that doing
14 so would be contrary to law.” *Alappat*, 33 F.3d at 1535; *see In re Packard*, 751 F.3d 1307, 1311-
15 12 (Fed. Cir. 2014); *Blacklight Power, Inc. v. Rogan*, 295 F.3d 1269, 1274 (Fed. Cir. 2002)
16 (approving reopening after issue fee was paid and observing that “the PTO’s responsibility for
17 issuing sound and reliable patents is critical to the nation” and “[t]he object and policy of the
18 patent law require issuance of valid patents”). Nothing in section 6 or 134(a) precludes the
19 examiner from reopening prosecution where necessary to exercise the USPTO’s statutory duty to
20 assess patentability, and MPEP § 1207.04 merely reflects that authority.

21 These regulations and court decisions—which reflect and endorse the unique nature of a
22 USPTO Board proceeding—answer Mr. Hyatt’s attempt to analogize the provisions in sections 6
23 and 134 to an “appeal” governed by the Federal Rules of Appellate Procedure. Pls. Mem. 10-12.
24 When a party files an appeal from a U.S. District Court to a U.S. Court of Appeals, the record is
25 fully formed. The district court’s decision has finally disposed of the issues based on that record.

26 The same is not true in an “appeal” from an examiner’s office action. Neither section 134,
27 nor any other statutory provision, prohibits further activity before the Board reaches the merits of
28

1 patentability. *See* Pls. Mem. 11-12.⁸ And with good reason. Unlike when a notice of appeal is
2 filed in federal court, the issues are often still being developed after the notice of “appeal” is filed
3 in patent examination. A patent applicant can still file new evidence after filing a notice of
4 “appeal.” 37 C.F.R. § 41.33. And, more typically, the applicant’s appeal brief often raises new
5 issues that the examiner must respond to. An examiner, pursuant to his statutory duty to police
6 patentability discussed above, may recognize patentability deficiencies not previously identified
7 and must raise them while he still has jurisdiction.

8 Put simply, examination often continues after the filing of the notice of “appeal” to the
9 Board. That is why jurisdiction does not transfer to the Board until both parties are sure the issues
10 are ready for the Board’s consideration, as reflected by filing of the reply brief and paying of the
11 appeal forwarding fee. *See* 37 C.F.R. §§ 41.35, 41.45. And unlike a decision on the merits by a
12 U.S. Courts of Appeals, the Board’s decision on the merits does not foreclose further action in
13 the application by either party. 37 C.F.R. § 41.54. At the end of the day, the Board is not deciding
14 whether a patent should issue; it is deciding whether the existing rejections are correct. If the
15 Board reverses the rejection(s) (or even if a court reverses them), the agency is free to make new
16 rejections. 37 C.F.R. § 1.198; *In re Gould*, 673 F.2d 1385, 1386 (CCPA 1982); *In re Fisher*, 448
17 F.2d 1406, 1420 (CCPA 1971) (“After our decision in an ex parte patent case, the Patent Office
18 can always reopen prosecution and cite new references, in which limited sense our mandates
19 amount to remands.”). If the rejection(s) are affirmed, the applicant may continue to pursue patent
20 claims by filing a continuation application. 37 C.F.R. § 1.78; 35 U.S.C. § 120. Plaintiffs do not
21 acknowledge the unique dynamic of a Board proceeding, embodied in regulations they do not
22 challenge. There are pragmatic and longstanding reasons to believe that Congress did not intend
23 to impose an immutable obligation on the Board to dispose of proceedings on the merits simply
24 by saying that an applicant may “appeal from the decision of the primary examiner” to the Board.
25 35 U.S.C. § 134(a).

26
27 ⁸ Plaintiffs’ reliance on *Util. Air Regulatory Grp. v. EPA*, 134 S. Ct. 2427, 2445-46 (2014) is
28 misplaced. No regulation or MPEP provision departs from the “numerical threshold[]” provided
in section 134(a). *See, e.g.*, 37 C.F.R. 41.31(a)(1). Plaintiffs conflate the “threshold” ability to file
the appeal with a right to force the Board to reach the merits, which section 134 does not impose.

1 Plaintiffs assert that the examiner's ability to reopen prosecution is essentially a delay
2 tactic that prevents the applicant from "obtain[ing] review of adverse decisions rejecting his
3 claims for a patent." Pls. Mem. 1, *see id.* at 5. As the USPTO explained, there are procedural
4 checks against an examiner simply "derailing" an applicant's appeal. The supervisor must agree
5 to reopening, and an applicant may petition for further review of such a reopening. A16. And
6 plaintiffs' position again ignores that Board appeals often present changed circumstances that
7 make reopening prosecution the more efficient course, such as the applicant raising new issues in
8 the appeal brief. In those situations, and other situations in which the examiner determines that a
9 change of circumstances has rendered the existing rejections not useful, it would not make sense
10 to require the applicant, the examiner, and the Board to undergo an entire appeal instead of simply
11 reopening prosecution.⁹ A16. In fact, Mr. Hyatt's applications present just such a situation, where
12 requiring the appeal to go forward would be a waste of time. *Id.*; *see also Hyatt Requirement Suit*,
13 146 F. Supp. 3d at 778, 775 (describing "unmanageable" and "impossible" state of 80 applications
14 when Requirements issued in 2013 to expedite examination). Hence, the Eastern District of
15 Virginia court determined that the reopening of prosecution "serves a useful purpose. . . . By
16 directing [Mr. Hyatt] to reduce the number of claims under review, the Requirements facilitate
17 effective examination of the relevant patent applications." *Id.* at 785.

18 **2. MPEP § 1207.04 does not conflict with Rule 39**

19 Nor does MPEP § 1207.04 conflict with Rule 39. Rule 39 provides a scenario in which
20 the applicant can reopen prosecution, so, according to plaintiffs, only the applicant possesses that
21 power. Plaintiffs argue that Rule 39 and MPEP § 1207.04 thus are irreconcilable. Pls. Mem. 12-
22 14. That is not correct.

23 Rule 39 is permissive: The examiner "*may* . . . furnish a written answer to the appeal brief."
24 Rule 39 does not purport to define all possible responsive actions, leaving room for the USPTO's
25 guidance in MPEP § 1207.04 on the issue. *See Shalala v. Guernsey Mem'l Hosp.*, 514 U.S. 87,
26 96 (1995) ("Nor is there any basis for suggesting that the Secretary has a statutory duty to

27 ⁹ Regardless, the examiner's reopening does not prevent the applicant from having a right to
28 appeal (Pls. Mem. 10) or "terminate" an appeal (*id.* at 12). It simply requires that the application
be in good order for the Board to address it.

1 promulgate regulations that, either by default rule or by specification, address every conceivable
2 question in the process of determining equitable reimbursement.”); *id.* at 97 (guidance was
3 appropriate to address a “question unaddressed by the otherwise comprehensive regulations on
4 this particular subject”).

5 Any alleged conflict between Rule 39 and MPEP § 1207.04 is thus illusory. Rule 39 does
6 not, and need not, define all possible responses by the examiner. And Rule 39 did not eliminate
7 the already-existing guidance in the MPEP that examiners could reopen prosecution to enter new
8 grounds of rejection. Granting applicants the ability to reopen prosecution in certain scenarios did
9 not somehow divest examiners of that ability. Indeed, as the USPTO explained, while MPEP §
10 1207.04 and Rule 39 both relate to reopening of prosecution, they do so for different purposes at
11 different stages of prosecution. A13-14. MPEP § 1207.04 reflects the examiner’s discretion to
12 reopen prosecution after considering the applicant’s appeal brief but before issuing an answer.
13 *See* A63-64 (reopening is “in response to appellant’s brief”). If the examiner deems it advisable
14 instead to file an answer, Rule 39 addresses the contents of that answer and defines the options
15 available to the applicant to respond to any new ground included in it, including allowing the
16 applicant to himself reopen prosecution. Rule 39 does not discuss the possible examiner actions
17 that might *precede* filing an examiner’s answer. *See* 76 Fed. Reg. at 72287 (issues relating to
18 examiner action before filing answer are outside the scope of Rule 39).

19 Plaintiffs argue that this reasoning is flawed because MPEP § 1207 cites Rule 39 for its
20 authority. Pls. Mem. 14. But that citation is authority for other parts of the MPEP section, such as
21 section 1207.04’s statement about “add[ing] a new ground of rejection to an examiner’s answer
22 where proper.” A64. The examiner’s ability to reopen obviously does not arise out of Rule 39,
23 when the MPEP provision predates the Rule by over 50 years.

24 Rule 39 was in fact written to mesh with MPEP §1207.04, not to supersede or eliminate
25 it, as the USPTO made plain in rejecting Mr. Hyatt’s petition. A4-9; A13-16. The notice-and-
26 comment discussion surrounding Rule 39 makes that clear. The discussion addressed the
27 examiner’s preexisting ability to reopen prosecution within the boundaries of that rule. *See Rules*
28 *of Practice Before the Board of Patent Appeals and Interferences*, 68 Fed. Reg. 66648, 66653

1 (Nov. 26, 2003) (Notice of Proposed Rulemaking); *Rules of Practice Before the Board of Patent*
2 *Appeals and Interferences*, 69 Fed. Reg. 49960, 49979-80 (Aug. 12, 2004) (Final Rulemaking).
3 The USPTO explained in the Notice of Proposed Rulemaking that, “[w]here, for example, a new
4 argument(s) or new evidence cannot be addressed by the examiner based on the information then
5 of record, the examiner may need to reopen prosecution rather than apply a new ground of
6 rejection in an examiner’s answer to address the new argument(s) or new evidence.” 68 Fed. Reg.
7 at 66653. The USPTO provided examples to illustrate its interpretation of Rule 39, including one
8 in which the examiner would be *expected* to reopen prosecution under MPEP § 1208.02 (now
9 § 1207.04) rather than issuing a new ground of rejection in an examiner’s answer. *See id.*
10 (Example 2).

11 The USPTO received comments in response to the 2003 Notice of Proposed Rulemaking.
12 Several of the comments about proposed Rule 39 addressed the issue that the examiner now had
13 a choice within the boundaries of the proposed rule between (1) reopening prosecution and (2)
14 issuing new grounds of rejection in an examiner’s answer. 69 Fed. Reg. at 49979 (Comment 65
15 and Answer); *id.* at 49979-80 (Answer to Comment 68); *see* A7.

16 The USPTO has since repeated its interpretation that Rule 39 did not change the
17 examiner’s preexisting ability to reopen prosecution after an appeal brief. In July 2007, the
18 USPTO issued a notice of proposed rulemaking that concluded in November 2011 with a final
19 rule. *See Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte*
20 *Appeals*, 72 Fed. Reg. 41472 (July 30, 2007) (proposed rule); *Rules of Practice Before the Board*
21 *of Patent Appeals and Interferences in Ex Parte Appeals*, 76 Fed. Reg. 72270 (Nov. 22, 2011)
22 (final rule). That rulemaking included proposed changes to Rule 39. In response to the proposed
23 changes, two comments discussed the examiner’s option “to reopen prosecution after filing of an
24 appeal brief,” suggesting that Rule 39 should require a supervisor’s approval for the examiner to
25 reopen prosecution at that point. 76 Fed. Reg. at 72287. The USPTO declined to adopt that
26 suggestion because it was “outside the scope of the proposed rules. The proposed rules do not
27 address reopening of prosecution by the examiner after filing of an appeal brief.” *Id.* Rather,
28 according to the USPTO, proposed and final Rule 39(a)(2) “addresses only new grounds of

1 rejection raised in an examiner’s answer, and [final Rule 39(b)(1)] addresses the appellant’s right
2 to reopen prosecution in this instance. MPEP § 1207.04 already requires approval from the
3 supervisory patent examiner to reopen prosecution after appellant’s brief or reply brief has been
4 filed.” *Id.*

5 USPTO rulemaking on other subjects reflects the same interpretation. *See, e.g., Setting*
6 *and Adjusting Patent Fees*, 78 Fed. Reg. 4212, 4230-31 (Jan. 18, 2013) (revising fee structure to
7 permit applicants to avoid paying the majority of the fee in situations where the examiner reopens
8 prosecution, or allows an application, after an appeal brief is filed).

9 In short, as the USPTO explained, “the particular MPEP provision at issue here was
10 addressed during notice-and-comment rulemaking, and the rulemaking was done in view of that
11 procedural background. The USPTO and commenters all agreed and assumed that the examiner
12 could reopen prosecution to issue new grounds of rejection based on the existing MPEP
13 provisions.” A15; *see* A4-9; A13-16. Plaintiffs respond briefly to this extensive administrative
14 background (Pls. Mem. 15) but fail to address the full scope of the discussion; there is much more
15 to the considered administrative reasoning undercutting plaintiffs’ attempt to manufacture
16 “conflict” between the two provisions than just a “preamble to the notice of proposed rulemaking
17 for” Rule 39. And this is not a situation where a regulation controls over conflicting procedural
18 guidance (Pls. Mem. 14)—there simply is no conflict.

19 Nor is MPEP § 1207.04 inconsistent with the broader USPTO regulatory scheme. Pls.
20 Mem. 14-15. 37 C.F.R. § 41.31(a)(1) parrots 35 U.S.C. § 134 in providing that an “applicant, any
21 of whose claims has been twice rejected, may appeal” to the Board. The regulation does not
22 obligate the Board to review the merits of a particular rejection any more than the statute does,
23 for the reasons discussed above. And plaintiffs’ contention that none of the other USPTO
24 regulations discussing *ex parte* Board appeals provides for reopening of prosecution by the
25 examiner is true enough, but like their contention about Rule 39, it misses the point. None of the
26 cited regulations prevents the examiner from taking action necessary to fulfill his statutory
27 mandate to police patentability, authority that exists independent of any regulation and is
28 embodied in MPEP § 1207.04. This is not a situation where a statute expressly provides that only

1 an applicant has the ability to reopen prosecution, and the USPTO has “enlarge[ed]” that scope
2 to include examiners. Pls. Mem. 15 (quoting *Iselin v. United States*, 270 U.S. 245, 250-51 (1926)).
3 If anything, the statute and court decisions interpreting it—which recognize the continuing
4 responsibility of the USPTO to police patentability—compel that authority for examiners. *See*
5 *supra* 18-19 (cases explaining that agency has inherent right to correct mistakes).

6 Lastly, plaintiffs argue that even absent conflict between MPEP § 1207.04 and Rule 39,
7 the MPEP provision should be rejected as “at odds” with the “strict deadlines and priorities for
8 action on applications” in the Patent Act and USPTO regulations. Pls. Mem. 16. The Eastern
9 District of Virginia has already rejected this argument, explaining that neither Mr. Hyatt nor any
10 other applicant “has [a] right to an examination free from ... reopened prosecution.” 146 F. Supp.
11 3d at 785. In reality, the necessity of reopening prosecution is as much a byproduct of applicant
12 conduct as that of an examiner. That is certainly true in Mr. Hyatt’s situation, as the Requirements
13 explained. *Id.* at 778. And neither the statute nor the regulations set a deadline for the examiner
14 to respond to an appeal brief. Deliberately so: The examiner must have adequate time to execute
15 his obligation to consider patentability in light of the issues raised.

16 **3. MPEP § 1207.04 is not subject to notice-and-comment requirements**
17 **because it falls into multiple exceptions: it constitutes at least one of a**
18 **rule of agency procedure, a policy statement, and an interpretive rule**

19 As explained above, the time to challenge the procedures the USPTO used to adopt MPEP
20 § 1207.04 has long since passed, and plaintiffs do not have standing to challenge those procedures
21 here. *Supra* 9-14. But even if this Court had jurisdiction, plaintiffs’ challenge would fail. As the
22 USPTO explained, MPEP § 1207.04 falls into at least one, if not more, of three different
23 exceptions to the notice-and-comment requirements: It is a rule of agency procedure, a policy
24 statement, and an interpretive rule. A18-27.

25 1. MPEP § 1207.04 is a rule of agency procedure, exempting it from notice-and-comment
26 requirements, because “it covers agency actions that do not themselves alter the rights or interests
27 of parties, although it may alter the manner in which the parties present themselves or their
28 viewpoints to the agency.” *JEM Broad. Co. v. FCC*, 22 F.3d 320, 326 (D.C. Cir. 1994) (quotation

1 marks omitted); A18-23. MPEP § 1207.04 does not alter the substantive rules for patentability
2 but merely allows an applicant to present his viewpoint to the examiner in the first instance.

3 Plaintiffs argue that, even though MPEP § 1207.04 is a procedural rule, 35 U.S.C.
4 § 2(b)(2) nevertheless mandates the use of notice and comment. Pls. Mem. 17-22. Section 2(b)(2)
5 states that the USPTO “*may* establish regulations, not inconsistent with law, which—(A) shall
6 govern the conduct of proceedings in the Office; [and] (B) shall be made in accordance with [5
7 U.S.C. § 553].” 35 U.S.C. § 2(b)(2) (emphasis added). As the USPTO explained, section 2(b)(2)
8 does not command the agency to establish all procedure as regulation; it merely authorizes the
9 agency to establish procedure through regulations and then requires it to use notice-and-comment
10 rulemaking if it exercises that authority. A19. Indeed, courts have determined, for example, that
11 the USPTO is not “required to use notice-and-comment rulemaking” to issue a certain rule
12 because it is “a procedural rule, not a substantive rule.” *Actelion Pharm. v. Kappos*, 972
13 F.Supp.2d 51, 58 n.9 (D.D.C. 2013) (citing 5 U.S.C. § 553(b)(A)), *aff’d*, 565 F. App’x 887 (Fed.
14 Cir. 2014); *see Animal Legal Def. Fund v. Quigg*, 932 F.2d 920, 931 (Fed. Cir. 1991) (observing
15 that not “every action taken by an agency pursuant to statutory authority [is] subject to public
16 notice and comment,” since such a requirement “would vitiate the statutory exceptions in section
17 553(b) itself”).¹⁰

18 As the USPTO explained, there would be no benefit to exercising the option of notice-
19 and-comment procedures for MPEP § 1207.04 in particular. A21-22. At most, MPEP § 1207.04
20 imposes on the public “the incidental inconveniences of complying with an enforcement scheme,”
21 but “such derivative burdens hardly dictate notice and comment review.” *Am. Hosp. Ass’n v.*
22 *Bowen*, 834 F.2d 1037, 1051 (D.C. Cir. 1987) (applying § 553 exception for procedural rules).

23
24 _____
25 ¹⁰ Plaintiffs argue that *Tafas v. Dudas*, 541 F. Supp. 2d 805, 812 (E.D.Va. 2008), overrides these
26 cases and requires all USPTO procedure to be embodied in regulation. Pls. Mem. 20-21. In that
27 case, the district court had before it only whether the reference in 35 U.S.C. § 2 to the notice-and-
28 comment provisions of 5 U.S.C. § 553 empowered the USPTO with “substantive” rulemaking
authority, since the notice-and-comment requirement ordinarily applies only to substantive rules.
541 F. Supp. 2d at 812. Furthermore, the Supreme Court has questioned the Federal Circuit’s
reading of section 2(b)(2)(A) as limited to procedural rulemaking authority. *Cuozzo Speed Techs.,*
LLC v. Lee, 136 S. Ct. 2131, 2142-43.

1 Plaintiffs assert that the exception for procedural rules cannot apply to the USPTO because
2 in 1999 Congress added to the Patent Act a reference to 5 U.S.C. § 553, which establishes the
3 notice-and-comment rulemaking process and the exceptions to it. Pls. Mem. 19. But nothing in
4 the history of the 1999 revision to the Patent Act indicates an intent to do away with the
5 longstanding MPEP, which has never had the force of law and has never been promulgated
6 through notice and comment. Indeed, the MPEP is changed frequently, usually to address changes
7 in law that affect examination. *See* MPEP Change Summary.

8 In fact, the 1999 revision to the Patent Act was intended to allow the USPTO to take
9 advantage of the exceptions to section 553. In earlier drafts of the 1999 Act, the corresponding
10 provision explicitly stated that the USPTO “may establish regulations, not inconsistent with law,
11 which . . . shall be made after notice and opportunity for full participation by interested public
12 and private parties.” 21st Century Patent System Improvement Act, H.R. 400, 105th Cong. § 112
13 (1997) (proposing amendment to 35 U.S.C. § 2(b)(5)(B)). The enacted version simply refers to
14 section 553, which includes exceptions to the requirement for notice and comment.

15 Furthermore, plaintiffs’ argument would essentially require the entire 2600-plus-page
16 MPEP to undergo notice and comment. But none of the caselaw cited by plaintiffs compels
17 reading section 2(b)(2) to require that every single procedural rule contemplated by the USPTO
18 must be embodied in a regulation installed using notice-and-comment procedures. For example,
19 the Food Stamp Act rulemaking provision (7 U.S.C. § 2013(c)) at issue in *Levesque v. Block*, 723
20 F.2d 175, 177 (1st Cir. 1983), and *Klaips v. Bergland*, 715 F.2d 477, 483 (10th Cir. 1983),
21 *mandated* that regulations be promulgated: “The Secretary *shall* issue such regulations consistent
22 with this chapter as the Secretary deems necessary or appropriate for the effective and efficient
23 administration of the supplemental nutrition assistance program and *shall* promulgate all such
24 regulations in accordance with the procedures set forth in section 553 of Title 5.” 7 U.S.C. §
25 2013(c) (emphasis added); *see Levesque*, 723 F.2d at 177 (the “Secretary . . . is directed to ‘issue
26 such regulations’”) (quoting 7 U.S.C. § 2013(c)). By contrast, 35 U.S.C. § 2(b)(2) merely *permits*
27 the USPTO to promulgate regulations; it requires only that *if* the USPTO elects to exercise that
28 authority, notice-and-comment procedures must be used.

1 2. MPEP § 1207.04 also represents a “general statement of policy” exempted from notice-
2 and-comment rulemaking by 5 U.S.C. § 553(b)(A). A23-24. A rule constitutes a “policy
3 statement” when it (1) has only prospective effect, and (2) leaves the agency decision-makers free
4 to exercise their discretion. *See Chrysler Corp. v. Brown*, 441 U.S. 281, 302 n.31 (1979) (policy
5 statements under § 553 are “statements issued by an agency to advise the public prospectively of
6 the manner in which the agency proposes to exercise a discretionary power” (quotation marks
7 omitted)). MPEP § 1207.04 does not impose any “obligations or prohibitions on regulated
8 entities.” *Nat’l Mining Assoc. v. McCarthy*, 758 F.3d 243, 252 (D.C. Cir. 2014). Indeed, MPEP
9 § 1207.04 does not expressly “require anyone to do anything or[] prohibit anyone from doing
10 anything,” even examiners. *Id.* Instead, it gives discretion to examiners and their supervisors to
11 reopen prosecution on a case-by-case basis, which is a hallmark of a policy statement. *Chen Zhou*
12 *Chai v. Carroll*, 48 F.3d 1331, 1341 (4th Cir. 1995) (concluding that interim rule was general
13 statement of policy because it “merely provided that the Attorney General *may* grant asylum to
14 aliens” for particular reasons). Notably, plaintiffs’ motion for summary judgment does not address
15 this aspect of the USPTO’s rationale. Pls. Mem. 17-24.

16 3. Finally, MPEP § 1207.04 represents an interpretive rule, which is also exempted from
17 notice-and-comment procedures. A25. Plaintiffs concede that the USPTO has inherent authority
18 to issue interpretive rules. Pls. Mem. 21 n.12. “Interpretative rules . . . clarify or explain existing
19 law or regulation and are exempt from notice and comment under section 553(b)(A).” *Nat’l Org.*
20 *of Veterans’ Advocates, Inc. v. Sec’y of Veterans Affairs*, 260 F.3d 1365, 1375 (Fed. Cir. 2001)
21 (quotation marks omitted). The Federal Circuit recognizes that the MPEP “is entitled to judicial
22 notice as the agency’s official interpretation of statutes and regulations, provided that it is not in
23 conflict with the statutes or regulations.” *Refac Int’l, Ltd.*, 81 F.3d at 1584 n.2 (observing that the
24 MPEP “does not have the force and effect of law”); Pls. Mem. 4. MPEP § 1207.04 is an
25 interpretation: It clarifies the application of the general legal doctrine that the examiner inherently
26 has the authority to reopen prosecution and reconsider his earlier decision. *See supra* 18-19; A25.
27 Thus, MPEP § 1207.04 is interpretive guidance particularly because it merely makes explicit what
28 is already within the examiner’s authority.

1 In a logical fallacy, plaintiffs argue (1) that the USPTO has authority to issue only
2 procedural rules; (2) that a procedural rule cannot be interpretive; and (3) that the USPTO has
3 inherent authority to issue interpretive rules. Pls. Mem. 21-22 & n.12. At least one of those must
4 be incorrect: If the USPTO can only issue procedural rules, and those cannot be interpretive, that
5 would preclude the USPTO from issuing *any* interpretive guidance. But plaintiffs acknowledge,
6 as they must, that the USPTO has authority to issue interpretive guidance. Plaintiffs cite nothing
7 for the proposition that a rule cannot be both procedural and interpretive.

8 And plaintiffs fare no better in their attempt to avoid the jurisprudence defining
9 “interpretative rule” in a manner that captures MPEP § 1207.04. Pls. Mem. 22. Those decisions
10 contrasted “interpretative” and “substantive” rules. But regardless whether the USPTO can issue
11 “substantive rules,” those decisions do not speak to whether MPEP § 1207.04 meets the definition
12 of an “interpretative rule.” MPEP § 1207.04 clearly does, as it clarifies the examiner’s authority
13 to reopen prosecution while he still has jurisdiction over the application.

14 **C. The USPTO appropriately denied Mr. Hyatt’s petition**

15 Finally, the USPTO appropriately denied Mr. Hyatt’s petition for rulemaking. The
16 USPTO’s decision not to promulgate a rule proposed by plaintiffs is subject to judicial review,
17 but that review is “extremely limited” and “highly deferential.” *Massachusetts v. EPA*, 549 U.S.
18 497, 527 (2007). “An agency’s refusal to institute rulemaking proceedings is at the high end of
19 the range of levels of deference [courts] give to agency action under [their] arbitrary and
20 capricious review.” *Nat’l Mining Ass’n v. Mine Safety and Health Admin.*, 599 F.3d 662, 667
21 (D.C. Cir. 2010) (citation omitted). Furthermore, the Ninth Circuit has explained that it will not
22 countenance rulemaking petitions that are used to thwart statutory review schemes, such as the
23 specific provisions for judicial review of the denial of a patent application. *Nader v. EPA*, 859
24 F.2d 747, 753 (9th Cir. 1988) (“If parties were free simply to file petitions, await their denial, and
25 then be assured of jurisdiction in the court of appeals, there would be little incentive to comply
26 with the procedural provisions of the [Act] that require direct appeals from a regulation to be
27 made within the statutory time period. [The agency] could conceivably be forced to appear
28 continually in appellate courts defending regulations long established that parties failed to contest

1 at the time of their promulgation.”). And, as discussed above, at 12-14, plaintiffs’ argument that
2 MPEP § 1207.04 was improperly promulgated (Pls. Mem. 24) cannot be reviewed more than six
3 years after its promulgation, despite having been raised in Mr. Hyatt’s petitions.

4 To the extent that the USPTO’s decision is reviewable, the USPTO denied Mr. Hyatt’s
5 petition for the reasons discussed above, which were discussed extensively in its decision—MPEP
6 § 1207.04 does not conflict with the USPTO’s statute or regulations; it merely states explicitly
7 the examiner’s inherent authority to do his job to make sure unpatentable claims do not issue; and
8 it prevents a waste of resources of the applicant and the USPTO in adjudicating a dispute that is
9 no longer relevant. A9-18. That reasoning was more than sufficient. *See Preminger v. Secretary*
10 *of Veterans Affairs*, 632 F.3d 1345, 1354 (Fed. Cir. 2011).

11 **VI. CONCLUSION**

12 For the reasons discussed above and in the USPTO’s petition decisions, USPTO is entitled
13 to summary judgment. Plaintiffs’ motion for summary judgment should be denied.

14 Dated: December 9, 2016

Respectfully submitted,

15 DANIEL G. BOGDEN
16 United States Attorney

17 /s/ Molly R. Silfen
18 MOLLY R. SILFEN
Special Assistant United States Attorney

19 **PROOF OF SERVICE**

20 I, Molly R. Silfen, certify that on December 9, 2016, the foregoing **COMBINED**
21 **MOTION FOR SUMMARY JUDGMENT AND OPPOSITION TO PLAINTIFFS’**
22 **MOTION FOR SUMMARY JUDGMENT** was served on all counsel of record via CM/ECF.

23 /s/ Molly R. Silfen
24 MOLLY R. SILFEN
Special Assistant United States Attorney