United States Patent and Trademark Office

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February 26, 2018
Via CM/ECF

Col. Peter R. Marksteiner, USAF, Ret.
Circuit Executive and Clerk of the Court
U.S. Court of Appeals for the Federal Circuit
717 Madison Place, NW
Washington, DC 20439

Re: Response to Hyatt's Fed. R. App. P. 28(j) citation of supplemental authority in *Hyatt v. U.S. Patent & Trademark Office*, Appeal No. 2017-1722

Dear Colonel Marksteiner:

The Director submits this response to Appellant's February 20, 2018 letter, citing *U.S. ex. rel. Steinmetz v. Allen*, 192 U.S. 543 (1904). In *Steinmetz*, the examiner required the applicant to file a divisional application because, at the time, USPTO Rule 41 prohibited applications with both process and apparatus claims. 192 U.S. at 543-547. The Court held that Rule 41 was invalid because the statute did not explicitly prohibit such applications, and while the agency had discretion to limit some applications, Rule 41 did not account for the use of that discretion. *Id.* at 563. Because the applicant had a "right" to pursue both types of claims jointly, the examiner's divisional requirement was "a rejection of the application" and properly appealable.

This Court in *Pfizer, Inc. v. Teva Pharms. USA, Inc.*, 518 F.3d 1353, 1360-61 (Fed. Cir. 2008) recognized that *Steinmetz's* holding that "a patent applicant could appeal an examiner's requirement for division" was abrogated by 35 U.S.C. § 121. *See also* P.J. Federico, *Commentary on the New Patent Act* (1954), reprinted at 75 J. Pat. and Trademark Off. Soc. 161, 194-195 (§ 121 rendered *Steinmetz* "obsolete"). An abrogated decision recognizing a right to appeal from a divisional practice that is not at issue here and that no longer exists does not "control[] the merits of this appeal" (Ltr. 2), particularly when the merits face roadblocks to being heard in the first place. USPTO Br. 17-32.

Moreover, the Court in *Steinmetz* did not hold "that an examiner . . . could not refuse to file an Examiner's Answer so as to defeat the appeal." Ltr. 1. The Court merely observed in 1904 that then-existing PTO Rule 135 "made the duty of the examiner" to respond to the appeal brief. *Id.* at 564-66. Today's USPTO regulations and guidance provide otherwise: the examiner *may* file an Answer, but nothing otherwise compels a particular action. That practice is consistent with the patent statute. *See* USPTO Br. 33-43.

Respectfully submitted,

/s/ *Molly R. Silfen*
Molly R. Silfen
Associate Solicitor

cc: Counsel of Record

CERTIFICATE OF SERVICE

I hereby certify that on February 26, 2018, I electronically filed the foregoing with the Court's CM/ECF filing system, which constitutes service, pursuant to Fed. R. App. P. 25(c)(2) and Fed. Cir. R. 25(e).

/s/ Molly R. Silfen

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