

Applicant's Unreasonable Delays During Patent Prosecution Can Lead to Prosecution Laches

Article By:

Christina Ji-Hye Yang

Elizabeth D. Ferrill

In [*Hyatt v. Hirshfeld*, No. 2018-2390 \(Fed. Cir. June 1, 2021\)](#), the Federal Circuit vacated and remanded the district court's rejection of the PTO's arguments for prosecution laches. In 1995, Hyatt bulk-filed 381 patent applications during the "GATT Bubble," each being a photocopy of one of 11 earlier applications. Hyatt's GATT Bubble applications were atypically long and complex spanning hundreds of pages. Four of those applications were finally rejected. On appeal, the Board affirmed in part and added a § 101 rejection. Hyatt filed a § 145 action in a district court challenging the unpatentability rejections. The district court rejected the PTO's arguments regarding prosecution laches. The PTO appealed.

As a threshold matter, the Federal Circuit held that the PTO could deny patent issuance and defend rejections on prosecution laches. Then, the Federal Circuit held that the PTO carried its burden of proof by showing that Hyatt delayed the prosecution for 12-28 years through unreasonable prosecution conduct, forcing the PTO to spend more than \$10M to administer Hyatt's claims. The Federal Circuit held that an applicant's delays exceeding six years raised a presumption of prejudice, including intervening rights. Abusing the patent examination system shifted the burden of proof to Hyatt.

Sumaia Tabassum also contributed to this article.

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National Law Review, Volume XI, Number 168

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