HYATT V. DOLL, ACTING DIRECTOR, PATENT AND TRADEMARK OFFICE

By: Michael Badagliacca

FEDERAL CIRCUIT UPHOLDS EXCLUSION OF DECLARATION AS NOT TIMELY

Hyatt is a registered patent agent and sole listed inventor or U.S. Patent Application No. 08/471,702. Hyatt appealed the final rejection of all claims for lack of adequate written description and lack of enablement. Hyatt argued that the specification was presumptively valid, and did not indicate where in the specification support could be found for the relevant limitations. The Board of Patent Appeals and Interferences upheld the rejection of the claims.

Hyatt then filed an action under 35 U.S.C. 145 with the United States District Court for the District of Columbia. The USPTO filed a motion for summary judgment, arguing that the rejection based on lack of written description and enablement was supported by substantial evidence. In opposition to the motion, Hyatt submitted a declaration as evidence. The District Court excluded the declaration because Hyatt had been negligent in submitting the declaration during the proceedings before the USPTO. Hyatt appealed to the Federal Circuit.

The Federal Circuit upheld the exclusion. The Federal Circuit reasoned that the Hyatt's refusal to provide the evidence earlier was willful, and therefore was properly excluded. The Federal Circuit stated that Hyatt had the burden of rebutting the Examiner's prima facie case, but failed to provide any support for the claimed features.