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February 20, 2018

VIA CM/ECF

Peter R. Marksteiner, Clerk of Court
U.S. Court of Appeals for the Federal Circuit
717 Madison Place, N.W.
Washington, D.C. 20439

Re: *Rule 28(j) Notice of Supplemental Authority in* Hyatt v. U.S. Patent & Trademark Office*, No. 17-1722*

Dear Mr. Marksteiner:

U.S. ex rel. Steinmetz v. Allen, 192 U.S. 543 (1904), has belatedly come to my attention.

Steinmetz held that, under the predecessors to Sections 6(b) and 134(a), an applicant whose claims were twice rejected had a statutory right to have his appeal proceed to the Board and that an examiner therefore could not refuse to file an Examiner's Answer so as to defeat the appeal. *Id*. at 565. "It was the duty of the primary examiner…to grant an appeal. It was the duty of the Commissioner to compel the appeal." *Id*. Those "ministerial" duties are "rights which the statutes confer on inventors," enforceable through mandamus. *Id*. at 565–66. *Steinmetz* thereby confirms Plaintiffs' statutory argument against MPEP § 1207.04, which purports to authorize examiners to terminate appeals by reopening prosecution. Pls. Br. 17–22.

Accord Svenson v. Coe, 69 App.D.C. 359, 360 (1938) (describing *Steinmetz* as a mandamus case in which "the Patent Office had refused to permit an appeal which was expressly authorized by statute"); *U.S. ex rel. Dunkley Co. v. Ewing*, 42 App.D.C. 176, 178–79 (1914) (describing how, in *Steinmetz*, mandamus laid when "the Primary Examiner had declined to forward an appeal prayed by the petitioner to the [Board] to review the ruling of the Examiner"); *Frasch v. Moore*, 211 U.S. 1, 2 (1908) (similar).

See also 60 Am. Jur. 3d Patents § 467 (citing *Steinmetz*) ("Mandamus will lie…to compel the Director to require an examiner to forward an appeal to the Board[.]"); 27 A.L.R. Fed. 2d 151 § 13 (2008) ("mandamus lies to compel the Commissioner of Patents to require the primary

patent examiner to forward to the [Board], the appeal to which an inventor is entitled"); 9 Encyclopedia of U.S. Supreme Court Reporters 215 (1910) (describing *Steinmetz* as holding that a second rejection renders "the petitioner thereby entitled to an appeal under the patent laws to the board").

There is no relevant distinction between the provisions then in force (quoted in *Steinmetz*) and Sections 6(b) and 134(a). *In re Hengehold*, 440 F.2d 1395, 1401 n.6 (C.C.P.A. 1971).

Accordingly, *Steinmetz* controls the merits of this appeal.

Sincerely,

Andrew M. Grossman

Attachment

CC: All counsel of record via CM/ECF

THE ENCYCLOPEDIA OF UNITED STATES SUPREME COURT REPORTS

BEING A

Complete Encyclopedia of All the Case Law of the Federal Supreme Court up to and including Volume 206 U. S. Supreme Court Reports (Book 51 Lawyers' Edition)

UNDER THE EDITORIAL SUPERVISION OF

THOMAS JOHNSON MICHIE

Volume IX

THE MICHIE COMPANY, LAW PUBLISHERS
CHARLOTTESVILLE, VA.
1910

plicant, the court may authorize the commissioner to issue the patent for the invention specified in the claim, or any part thereof.[34]

2. APPEAL—a. *Appeal from Decision of Primary Examiner.*—Any applicant whose claim has been twice rejected, or any party to an interference, may appeal from the decision of primary examiner or the examiner in charge of interferences in such case, to the board of examiners in chief.[35] Mandamus to the commissioner of patents is the proper remedy for the refusal of the primary examiner to allow such appeal.[36] But the patent office may provide by rule that there shall be no appeal from a ruling of a primary examiner, upon motion to dissolve an interference.[37]

b. *Appeal from Decision of Examiner in Chief.*—If a party is dissatisfied with the decision of the board of examiners in chief, he may appeal from their decision to the commissioner in person.[38]

c. *Appeal from Decision of Commissioner*—(1) *Jurisdiction*—(a) *Courts of District of Columbia.*—The statutes provide for an appeal from the decision of the commissioner refusing a patent, or in interference cases, to the proper court in the District of Columbia.[39] Formerly, this appeal was to be taken to the supreme court of the district sitting in general term, but, since the creation of the court of appeals of the district, jurisdiction of such cases has been vested in that court.[40]

(b) *Secretary of Interior.*—The secretary of the interior has no power by law

nical appeal from the patent office, nor confined to the case as made in the record of that office, but is prepared and heard upon all competent evidence adduced and upon the whole merits, yet the proceeding is, in fact and necessarily, a part of the application for the patent. Gandy *v.* Marble, 122 U. S. 432, 439, 30 L. Ed. 1223; Butterworth *v.* Hoe, 112 U. S. 50, 61, 28 L. Ed. 656; In re Hien, 166 U. S. 432, 439, 41 L. Ed. 1066.

34. Order for issuance of patent.—Hill *v.* Wooster, 132 U. S. 693, 33 L. Ed. 502; In re Hien, 166 U. S. 432, 439, 41 L. Ed. 1066.

35. Appeal from decision of primary examiner.—Rev. Stat., § 4909; Ex parte Frasch, 192 U. S. 566, 48 L. Ed. 564; Lowry *v.* Allen, 203 U. S. 476, 51 L. Ed. 281; Steinmetz *v.* Allen, 192 U. S. 543, 48 L. Ed. 555; Mahn *v.* Harwood, 112 U. S. 354, 28 L. Ed. 665.

36. Remedy where primary examiner refuses to allow appeal.—Ex parte Frasch, 192 U. S. 566, 48 L. Ed. 564; Steinmetz *v.* Allen, 192 U. S. 543, 48 L. Ed. 555.

Where the primary examiner refuses to allow an appeal to the board of examiners in chief from his decision requiring a division between claims for a process and claims for an apparatus in related and dependent inventions, mandamus to the commissioner of patents, not appeal to the court of appeals of the district, is the proper remedy. Ex parte Frasch, 192 U. S. 566, 48 L. Ed. 564.

Mandamus will lie to compel the commissioner of patents to require the primary examiner to forward an appeal, prayed by the petitioner, to the board of examiners in chief, to review the ruling of the primary examiner requiring petitioner to cancel certain of his claims to his application, where the decision of the primary examiner was final, and the petitioner thereby entitled to an appeal under the patent laws to the board of examiners in chief. Steinmetz *v.* Allen, 192 U. S. 543, 48 L. Ed. 555.

37. Appeal from decision on motion to dissolve interference.—Lowry *v.* Allen, 203 U. S. 476, 51 L. Ed. 281.

Such a rule is not contrary to the Revised Statutes (§§ 482, 483, 4904, 4909, 4910, 4911), which provide only for appeals upon the question of priority of invention, leaving appeals on other questions to the regulation of the patent office under the grant of power contained in § 483. Lowry *v.* Allen, 203 U. S. 476, 51 L. Ed. 281.

38. Appeal from examiner in chief to commissioner.—Rev. Stat., § 4910.

39. Appeal from decision of commissioner.—Rev. Stat., § 4914; In re Hien, 166 U. S. 432, 439, 41 L. Ed. 1066; United States *v.* Duell, 172 U. S. 576, 587, 43 L. Ed. 559; Butterworth *v.* Hoe, 112 U. S. 50, 28 L. Ed. 656; Shepard *v.* Carrigan, 116 U. S. 593, 29 L. Ed. 723; United States *v.* American Bell Tel. Co., 167 U. S. 224, 267, 42 L. Ed. 144.

The government is not entitled to appeal, but only the applicant. United States *v.* American Bell Tel. Co., 167 U. S. 224, 267, 42 L. Ed. 144.

Time of taking appeal.—See ante, "Prosecution or Abandonment of Proceedings," VI, B, 2.

40. Jurisdiction on appeal.—Rev. Stat., § 4914; Act of Feb. 9, 1893, ch. 74, 27 Stat. 436; United States *v.* American Bell Tel. Co., 167 U. S. 224, 267, 42 L. Ed. 144; In re Hien, 166 U. S. 432, 439, 41 L. Ed. 1066.