



UNIVERSITY OF
MARYLAND
SCHOOL OF LAW

**PATENT LAW
UPDATE**

In re Bogese

No. 01-1354
Federal Circuit
Sept. 13, 2002

“[T]he PTO has authority to order forfeiture of rights for unreasonable delay [under the doctrine of prosecution laches].”

On September 13, 2002, the Federal Circuit, *inter alia*, affirmed the decision of the Board of Patent Appeals and Interferences that upheld the rejection of the claims of patent application Serial No. 08/376,290 for prosecution laches. The claimed subject matter related to a quick connector between telephone wires and electrical connectors used in computers. The Federal Circuit stated:

[T]he equitable doctrine of laches may be applied to bar enforcement of a patent that issued after unreasonable and unexplained delay in prosecution, even though the patent applicant complied with pertinent statutes and rules. [A] patent may be rendered unenforceable if it was obtained after an unreasonable and unexplained delay in prosecution. [W]e see no basis for denying the power to the PTO itself that we have recognized exists in the district courts in infringement actions. [T]he PTO has the authority to reject patent applications for patents that would be unenforceable [for prosecution laches].

Indeed, we think the PTO’s authority to sanction undue delay is even broader than the authority of a district court to hold a patent unenforceable. The PTO is the administrative agency that is “responsible for the granting and issuing of patents” Like other administrative agencies, the PTO may impose reasonable deadlines and requirements on parties that appear before it. The PTO has inherent authority to govern procedure before the PTO, and that authority allows it to set reasonable deadlines and requirements for the prosecution of applications.

To be sure, an administrative agency cannot impose a penalty or forfeiture without providing notice. Here, Bogese does not claim that he was not provided with notice of what the PTO required of him or the potential consequences of non-compliance. Bogese here received ample notice that an unreasonable delay could result in forfeiture. . . . During the course of adjudicating the patentability of Bogese’s patent claims and after Bogese had filed eleven file wrapper continuation applications over an eight-year period, the examiner required Bogese to make a “substantive amendment to advance prosecution” or risk losing his right to a patent. Bogese had an opportunity to respond to the PTO’s requirement after the PTO gave that notice, but he did not, and instead filed another file wrapper continuation application without making a substantive amendment to advance prosecution.

On appeal, Bogese makes no serious claim that the PTO acted unreasonably on the facts of this case in requiring him to make a “substantive amendment to advance prosecution” or in finding forfeiture. Rather, Bogese challenges the PTO’s authority to require applicants to advance prosecution, urging that he was entitled to continue his chain of continuation applications. We disagree and hold that the PTO has authority to order forfeiture of rights for unreasonable delay. There is no basis for finding the PTO’s action to be arbitrary on the facts of this case, given that Bogese filed twelve continuation applications over an eight-year period and did not substantively advance prosecution of his application when required and given an opportunity to do so by the PTO. [A] delay by the PTO cannot excuse the appellant’s own delay.