1-1-1993

Access to and Authority to Cite Unpublished Decisions of the PTO

Thomas G. Field Jr
Franklin Pierce Law Center

ACCESS TO AND AUTHORITY TO CITE UNPUBLISHED DECISIONS OF THE PTO*

BY THOMAS G. FIELD, JR.**

I. Introduction

In 1986, Deputy Commissioner Peterson stated:[1]

> As in the case of unpublished opinions of the U.S. Court of Appeals for the Federal Circuit..., unpublished opinions of the *Patent and Trademark Office* may not be cited as precedent, except in support of a claim of res judicata, collateral estoppel, or law of the case. This opinion will be published in order to make the Commissioner's practice known. (emphasis added.)

Nevertheless, he went on to quote an earlier unpublished decision in order to inform the public of an exception to a published rule.[2]

More recently both the Board of Patent Appeals and Interferences [BPAI] and the Trademark Trial and Appeal Board [TTAB] have made similar, apparently redundant, statements concerning the precedential value of "unpublished" decisions in the PTO. In 1991, the BPAI stated:[3]

---

* I thank Hayden A. Carney, Christie, Parker & Hale in Pasadena CA and colleague on the U.S.P.Q. Editorial Advisory Board, for alerting me to the problem and reading an earlier draft of the paper. I also thank Professor William O. Hennessey, Director of the Masters of Intellectual Property Program at Franklin Pierce Law Center, for helpful comments. Finally, I thank Fred E. McKelvey, Solicitor, U.S. Patent and Trademark Office (PTO), for comments based on an earlier draft that are treated below at length.

** Professor of Law, Franklin Pierce Law Center. Professor Field is a former patent examiner and has taught both intellectual property and administrative process for over twenty years.

[1] *In re* Zacharin, 1 U.S.P.Q.2d 1413, 1415 n.2 (Comm'r PTO 1986).

This statement does not appear to be limited to the particular matter at hand (a government employee dispute). Yet, in the same year, PTO Commissioner Quigg stated: "In the future, any party in an interference citing an unpublished order of the Board shall serve and file a copy of the order." Clevenger v. Martin, 230 U.S.P.Q. 374, 375 n.2 (1986).

[2] Zacharin, 1 U.S.P.Q.2d at 1415 n.2

[3] *Ex parte* Holt, 19 U.S.P.Q.2d 1211, 1214 (BPAI 1991).

> Unpublished Board opinions, except as they may be the "law of the case", may not be binding precedent, since the opinions are often fact driven by the specific facts present in the appeal before the Board. . . . Of course, previously decided points of law must be followed unless overruled, and the application of the law to particular facts must be consistent from case to case.

Also, in 1992, the TTAB expressed similar sentiments with less ambiguity:[4]

> Upon reflection the Board has decided that citation of "unpublished" or "digest" Board decisions as precedent will no longer be allowed. In the future, the Board will disregard citation as precedent of any unpublished or digest decision. Even if a complete copy of the unpublished or digest decision is submitted, the Board will disregard citation as precedent thereof. An exception exists, of course, for those situations in which a party is asserting issues of claim preclusion, issue preclusion, judicial estoppel, law of the case or the like based on a decision of the Board rendered in a nonprecedential (i.e., unpublished or digest) decision. In those situations, the Board necessarily will consider the prior decision (assuming that a complete copy is submitted) to determine the preclusive effect, if any, of that decision.

These statements raise the question of the extent to which administrative decisionmakers have the power to do what those within the PTO have said they intend to do. Such statements also raise the question of what decisions are *available*, whether or not *published*, and what is intended by use of the term "*unpublished*."

In trying to answer those questions, this paper begins with the Solicitor's explanation of the term "published." It then reviews various kinds of published PTO decisions where the precedential effect of unpublished opinions has been addressed. There, we see, notwithstanding statements quoted above, that the PTO has generally not ignored unpublished precedent — at least, deliberately — and that the Solicitor agrees that this may not be done. Next, this paper briefly examines the almost universal[5] practice of federal appeals courts disallowing use of their unpublished decisions as precedent — and some of the reasons for widespread criticisms of that practice. It also discusses some of the reasons that judges, regardless of their own practices, do not permit agencies to ignore prior decisions.

Last, the paper turns to the Freedom of Information Act [FOIA].[6] There, we see that, while the FOIA addresses the use of precedent by *agencies against parties*, it does not explicitly deal with the use of precedent *by parties against agencies or other parties*. We also find that

---

[4] General Mills, Inc. v. Health Valley Foods, 24 U.S.P.Q.2d 1270, 1275 (TTAB 1992).

[5] *See* 83 LAW LIBR. J. 2079 (1991), listing the rules of the federal circuits. All except the Third Circuit have a rule limiting the precedential effect of unpublished decisions.

[6] Pub. L. 89-554, 80 Stat. 383 (1966). The act with amendments, is codified at 5 U.S.C. § 552.

the PTO often discloses more information than the FOIA requires. Nevertheless, it seems that, given current technology, still more could be cost-effectively made available — in a form that could more easily be used.[7] This would go a long way toward addressing the unfairness in access that seems primarily to have motivated TTAB hostility toward using unpublished opinions as precedent.[8] Indeed, from examining this situation, I have concluded that Congress should further amend the FOIA to permit affected persons to obtain critical information more easily from all agencies.

II. "Published" vs. "Unpublished" Decisions: The Solicitor's View

Apparently nothing has been officially promulgated by the PTO stating what the term "published" means. Solicitor McKelvey has been kind enough to send me a letter explaining current practice, dating from the tenure of Commissioner Quigg,[9] and to authorize my quoting his explanation here. It appears that initial screening of decisions proposed for publication has been delegated to the Solicitor's Office:[10]

> Commissioner Quigg determined that it might be a good idea if all decisions to be "published" were reviewed in a central place in the PTO. The review is not one to change or "quasi-judicially review" internal decisions on the merits.... We look at decisions to determine whether they are consistent with other "published" decisions; to be sure sufficient facts are recited so that the decision will serve as meaningful precedent; to be sure that citations are correct; to eliminate any obvious typographical errors; and to determine whether they are consistent with PTO policy. If a review reveals that there is a reason why a decision should not be published, we consult with the official who entered the decision to see if publication is still desired. . . . If the official disagrees with our assessment (something which rarely happens), we refer the matter to the Commissioner for decision.
>
> . . . .
>
> . . . "Published" is not a precise term as applied to what PTO does. When it is decided that a particular decision should be "published," [it]. . . is forwarded to BNA (for publication in USPQ), to Mead Data. . . , and to

---

[7] Those presumed to know the law must be able to determine in advance what the law is and how it will be applied in particular circumstances. *See, e.g.*, Rydeen v. Quigg, 16 U.S.P.Q.2d 1876, 1881 n.9 (Dist. Ct. D.C. 1990), where the Court observed, in part, "Mr. Bruzga [Rydeen's attorney] is expected to keep apprised of changes in PTO rules."

[8] Although the specific topic is somewhat beyond the scope of this paper, a much more compelling situation appears in Zirco Corp. v. AT&T 21 U.S.P.Q. 1542 (TTAB 1992). There, a *user* of a trademark was unable to oppose a bona-fide-intent-to-use applicant where its application predated the opposer's use. In such circumstances, users are severely affected [bound] by information that is *unknowable* for a short period of time and not "officially" known until an intent-to-use mark is published for opposition.

[9] Letter from Fred E. McKelvey, Solicitor, U.S. Patent and Trademark Office, to Author (Jan. 13, 1993).

[10] *Id.* at 2-3.

> West.... At present, BNA's policy is to publish... only those decisions which PTO forwards.... Decisions [otherwise submitted]... are forwarded by BNA to PTO for a determination of whether PTO sees anything publishable. We in turn forward [it]... to the deciding official.... Most (99%) *do not* result in "publication." Mead Data and West apparently "publish"... decisions from any source.
>
> What is the significance of "publication" in the USPQ? Quite simply it means that PTO has considered the decision and feels confident enough to publish [it]... as citable precedent.... Obviously, it would be nice if personnel and financial resources permitted issuance of a "publishable" opinion in every case. ... The public interest dictates that PTO move its business along and not impede the administration of justice by writing "publishable" decisions in every case. ... (Emphasis in original. One note omitted).

III. PTO Statements on the Precedential Effect of "Unpublished" Decisions

The BPAI

Before ending with the paragraph quoted earlier, in *Holt* the BPAI had observed:[11]

> We take this occasion to explain what precedents are considered binding in proceedings *in the Patent and Trademark Office* (PTO). Where the... Federal Circuit has addressed a point of law in a published opinion, [that] decision is controlling. Similarly controlling are decisions considered to be binding precedent by the Federal Circuit, i.e., decisions of the former Court of Claims and the former Court of Customs and Patent Appeals, as well as the former Customs Court. ... In those relatively rare cases where the Federal Circuit has not addressed an issue, but there is "authorized published" Board precedent, that published Board precedent is binding on panels of the Board and Examiners in the Patent Examining Corps.
>
> Generally the Board authorizes publication of its opinions only in those instances in which the opinion is (a) consistent with other decisions which have been rendered by the Board and (b) consistent with binding precedent by the Federal Circuit. In most instances, a "published" Board opinion will be one which (1) significantly adds to the body of law by addressing a substantive legal point not specifically previously addressed by the Federal Circuit..., or (2) discusses proper procedure within, or interpretation of a rule of the PTO, or (3) informs the patent bar and examining corps how the Board is interpreting prior court or Board decisions as they relate to particular factual situations before the Board. A published Board opinion may be overruled only by the Board sitting en banc, or by an expanded panel of the Board (i.e., one with more than three members). (Citations omitted; emphasis added).

This case purports to change prior practice,[12] but its effect remains to be seen. *Holt* is not cited in two later BPAI cases involving unpublished opinions. In the first, *Gustavsson v. Valentini*, itself unpublished,[13]

---

[11] *Ex Parte* Holt, 19 U.S.P.Q.2d at 1214.

[12] *See, e.g.*, Asari v. Zilges, 8 U.S.P.Q.2d 1117, 1270 (BPAI 1987), citing *Clevenger* at 375 n.2. *Compare* Perrin v. Kalk, 1 U.S.P.Q.2d 1881 (BPAI 1986), where one party to an interference was not permitted to rely on materials not available to the other party.

[13] 1991 Westlaw 428109 (BPAI 1991).

the Board found reliance on another unpublished opinion to be improper, but apparently only because of untimeliness in advancing an argument.

Also, in *Ex parte Ochiai*,[14] the Board discussed two previously unpublished opinions.[15] This case highlights the short-sightedness of *Holt*. It would seem that the decisions discussed there had gone unpublished, not for lack of significance,[16] but because of 35 U.S.C. § 122.[17] Also, the Board failed to address an issue raised in *Ex parte Stalego*,[18] where a predecessor to the BPAI was confronted with an unpublished district court decision.

The TTAB

Prior to *General Mills*, TTAB decisions had sent conflicting signals concerning the precedential value of unpublished opinions.[19] Following the earlier-quoted paragraph, in attempting to resolve such conflicts, the Board continued:[20]

> With a view toward clearing up any confusion..., the Board feels compelled to set a firm policy on whether to allow, in ex parte appeal cases and/or inter partes proceedings, the citation, as legal precedent, of unpublished Board decisions or [ones] published only in digest form.

---

[14] 24 U.S.P.Q.2d 1265 (BPAI, 1992).

[15] *Id.* at 1267-78, as well as at 1269 n.2 and 1270 n.3.

[16] One involved a dissent in which seven members of the Board had joined — facially a significant case.

[17] "Applications for patents shall be kept in confidence...." *But see* 37 C.F.R. § 1.14:

> (d) Any decision of the [BPAI], or any decision of the Commissioner on petition, not otherwise open to public inspection shall be published or made available for public inspection if: (1) The Commissioner believes the decision involves an interpretation... that would be of important precedent value; and (2) the applicant... does not within two months... object in writing.... If a decision discloses [secret or confidential] information, the applicant or party shall identify the deletions... considered necessary... If... the entire document must be withheld..., the applicant or party must explain why.

This rule clearly does not contemplate that all decisions of precedential value will be "published."

See also Ex parte Holt and Randell, 214 U.S.P.Q. 381 (Bd.App. 1982). At 383, the Board notes reliance of the examiner on an unpublished opinion involving the same assignee and attorneys; at 386, Magil, dissenting, would have affirmed the examiner on the basis of that unpublished opinion.

[18] 154 U.S.P.Q. 52 (Bd. App. 1966) — the Board managed to evade the problem insofar as the district court decision appeared to be at odds with later decisions of that and other courts

[19] General Mills, 24 U.S.P.Q.2d at 1275. The Board discusses some of its conflicting cases in the paragraph preceding the one quoted above.

[20] *Id.* The citation to McCarthy is incomplete, the quoted language appears only in supplements to the second edition of his treatise.

> We agree with the following commentary found in 1 J.T. McCarthy, Trademarks and Unfair Competition, § 20:26 (2d ed. 1984):
>
> > [The Board's allowance of citation to unpublished Board decisions] is an unfair practice to follow because it gives an advantage to the litigant and attorney who can afford the time and resources to locate, file and index these "unpublished" decisions.
>
> Decisions are not published because, in virtually all cases, they do not add significantly to the body of existing law and/or they are not of widespread legal interest. By deciding that a decision will not be recommended for publication, the Board has in effect declared that the decision has no value as legal precedent. With respect to prior decisions published only in digest form, the Board reasons that such decisions *are meaningless as precedent because they fail to report the facts on which the decisions were based.* Thus, the Board sees no compelling reason to allow unpublished or digest decisions to be cited as precedent. This view is more in line with the view of *other courts*, including the Federal Circuit. The Federal Circuit currently marks each of its unpublished decisions with a notation to the effect that the decision is not citable as precedent. . . .
>
> Although the Board may determine, at the time of issuance, that a decision does not merit publication, any interested person may request that the decision be published, giving reasons therefor. Assuming that the Board is persuaded that a valid reason exists for publication, the decision will be marked accordingly, thereby becoming a precedential disposition. (Emphasis added).

As did the BPAI in *Holt*, the TTAB failed to address the problem of how to treat unpublished court decisions. However, the issue, at least as posed by unpublished CAFC decisions, was resolved in a 1987 case.[21] There, the Board was faced with an applicant asserting that its facts were indistinguishable from those in a favorable, unpublished CAFC decision. While the applicant attempted to equate stare decisis and res judicata to avoid the CAFC rule against using the case as precedent, the Board overcame this argument using *BLACK'S LAW DICTIONARY*.[22]

Yet, even within the PTO, the TTAB has not covered all bases. For example, in *Chicopee Mfg. Corp. v. Madison Research and Development Corp.*,[23] the Commissioner vacated a TTAB order on the basis of an unpublished decision and directed the Board to complete consideration of a motion for summary judgment.[24]

Finally, although the Board discusses the unfairness that can arise when parties have unequal access to information, such inequalities are

---

[21] *In re* Brown & Portillo, Inc., 5 U.S.P.Q.2d 1381 (TTAB 1987)

[22] *Id.* at 1383.

[23] 134 U.S.P.Q. 261, 262 (Comm'r 1962).

[24] *Id.* — notwithstanding three published decisions cited by the Board!

common and sometimes far more severe.[25] In any event, it does not seem unfair to permit citation to decisions that are, in fact, widely available.[26]

Published Views of Other Decision-Makers in the Department of Commerce

Notwithstanding Deputy Commissioner Peterson's statement quoted earlier,[27] other Commissioners ruling on petitions and those higher in the hierarchy within the Department of Commerce seem to have no qualms about relying on "unpublished" decisions.[28]

In fact, in a *later* decision involving the same problem being addressed by Peterson, Murphy, the Deputy Under Secretary for Technology, found the Air Force not to have rights in a government employee's invention on the basis of previously unpublished decisions involving Bureau of Mines employees.[29]

Last, while the Solicitor's letter previously quoted expresses doubt about the ability of the PTO to refuse to consider "unpublished" opinions, he agrees with the BPAI and TTAB[30] that the problem is: How to deal with opinions that may not contain all of the facts needed to understand them?[31] In addressing this problem, he states:[32]

> Maybe we should not say "published." Maybe . . . we should say "precedential." I agree that [available decisions under the FOIA] . . . can be cited to the agency in a subsequent case. Thus, the question becomes [the weight to give an "unpublished" PTO decision]. . . . If the decision is not "published," the individual citing [it] . . . will have to [submit a copy of the file wrapper] . . . to the deciding official with a full explanation (referencing paper, page and line) of the facts relied upon. If the "facts" were contested (i.e., the examiner said one thing and the applicant another), the person citing the . . . decision had better be sure that the deciding official accepted the version of the facts being argued. In short, if the decision was not written for publication, it may not recite all the relevant facts *as found by the deciding official*. By citing the decision in a subsequent case, collateral issues are raised as to what was actually decided. The bottom line is that all decisions of PTO which are available to the public (i.e., those not protected by 35 U.S.C. §

---

[25] *See supra* note 8.

[26] *See, e.g., supra* note 13.

[27] *Supra*, at note 1.

[28] *See* Chicopee Mfg., 134 U.S.P.Q. at 262.

[29] Morrison v. Air Force, 15 U.S.P.Q.2d 1392 (Dept. Commerce 1990).

[30] *See* the quotation at supra note 3 and the next-to-last paragraph of the quotation at *supra* note 20.

[31] In fact, Mr. McKelvey describes a situation where, prior to instituting the current practice of reviewing "published" decisions to ensure that they contain all of the facts needed to understand them, a "published" decision had turned out not to mean what it seemed to mean in light of facts available only in the file wrapper.

[32] *Supra* note 9, at 3-5.

> 122) can be cited. What PTO is telling the public is that the decisions published in USPQ are decisions which can be cited and be given weight without resort to the underlying file wrapper.
>
> ....
>
> . . . Hence by now reviewing cases to determine if enough facts are stated, PTO attempts to minimize difficulties for examiners (who may be talked into allowing a case based on a factually incomplete "published" decision) and attorneys (who may give advice based on factually incomplete "published" decisions). (emphasis in original).

Those who are confident that the current Solicitor's views ensure no further attempts by the BPAI and TTAB to limit the use of unpublished opinions into the foreseeable future can skip the next two Parts of this paper. However, those lacking such confidence should consider restrictions on the use of "unpublished" *court* opinions as well as critical differences between courts and agencies functioning in a quasi-adjudicatory capacity.

IV. "Unpublished" Decisions in the U.S. Courts of Appeal

While the TTAB erred by classifying itself as a *court*,[33] it correctly stated that courts do not "publish" all of their decisions; it seems that far more go unpublished. The ABA Journal recently reported that unpublished decisions in the U.S. courts of appeal range from 37.7% of the total in the First Circuit to 80.2% in the Fourth.[34] Also, as mentioned in *General Mills*, almost every circuit has a rule limiting the use of its or other circuits' unpublished opinions.[35]

Failure to "publish" does not pose a very serious problem because unpublished circuit decisions are, like many generated by the PTO, available from several sources.[36] Few people would argue that all decisions warrant "publication," but rules forbidding their use as precedent are widely criticized for a variety of reasons — some bearing directly on the availability and use of administrative decisions.

---

[33] *See* the next-to-last paragraph of the quotation at *supra* note 20.

[34] *Unpublished but Influential,* ABAJ, Jan. 1991, at 26 — (reporting data for July 1, 1986 to June 30, 1987. Data for the CAFC is not presented, but about 72% of its decisions have not been published). In this vein, see Erica U. Bodwell, *Published and Unpublished Federal Circuit Patent Decisions: A Comparison,* 30 IDEA 233 (1990).

[35] *See supra* note 5.

[36] However, none are "official" because no official reporter exists. *See, e.g.,* Julius J. Marke, *Unpublished and Uncitable Court Decisions,* N.Y.L.J., March 26, 1991, at 4, col. 4.

For example, one particularly thorough article concludes that:[37]

> The case against the limited publication/no-citation rules is a strong one. The premises upon which the rules are based are subject to serious question, and powerful arguments can be advanced against the entire concept. It is not surprising, therefore, that a substantial number of critics have spoken against the system — critics from the bench, the bar, and the schools.
>
> . . . .
>
> The dilemma posed, then, is how to cope with steadily increasing caseloads without compromising the appellate process or undermining the virtues of stare decisis. The most appealing compromise we have seen is the system used in the Tenth Circuit. That court permits free citation of unpublished opinions, provided that a copy is served on opposing counsel. In addition, the court prepares a subject matter index of all unpublished opinions available to all at a modest fee. Copies . . . can be obtained from the clerk . . .
>
> . . . .
>
> Before endorsing the Tenth Circuit's plan too enthusiastically, however, more information . . . is required. . . . *The system can be no better than the index*. . . . (Notes omitted; emphasis added).

A later article by Lauren Robel is also of interest — primarily for its attention to the effects of unpublished circuit opinions on administrative practice. It begins by observing that:[38]

> [T]he large body of unpublished decisions creates a variety of incentives for those litigants who have unusual access. . . . The policies reflected by the publication plans do not anticipate these sorts of incentives. . . . [The rules] exacerbate the advantages that the selective publication plans give frequent litigants.

Subsequently, Robel observes that no-citation rules rest on three kinds of mistaken assumptions:[39]

> First, the central assumption . . . is wrong . . . because opinions tell lawyers more than simply what the law is. Second . . . if the plans work as expected, they will systematically leave unpublished much of what lawyers would routinely use in their work. Third, the plans do not operate neutrally . . ., so that most of the work of the courts in several subject areas appears only in unpublished form. . . . [A]ttorneys who work in these areas cannot develop a sense of what the courts consider "routine" . . . .

Perhaps most compelling are Robel's findings based on a survey of government litigators. Because all of the courts of appeal allow litigants

---

[37] William L. Reynolds & William M. Richman, *The Non-precedential Precedent — Limited Publication and No-citation Rules in the United States Courts of Appeals*, 78 COLUM. L.REV. 1167, 12056 (1978).

Since then, the Tenth Circuit seems to have since adopted a rule more akin to that of the CAFC. *Supra* note 6, at 209. However, one would hope, for reasons to be discussed below, that difficulty in indexing was not cause.

[38] Lauren K. Robel, *The Myth of the Disposable Opinion: Unpublished Opinions and Government Litigants in the United States Courts of Appeals*, 87 MICH. L.REV. 940, 940 (1989).

[39] *Id.* at 947.

to move for publication of otherwise unpublished opinions and because frequent litigators "play for rules,"[40] she concludes, e.g., that motions for publication "allow [them] to stack the precedential deck."[41] She also reports that a search of the 1982 records of the Seventh Circuit, revealed thirty opinions that changed status, twenty-two at the behest of a government litigator — all being favorable to the government![42]

A final paper of interest with regard to unpublished circuit decisions, reports on CAFC *patent* decisions over a thirty-four month period.[43] Data presented there dealing with the outcome of administrative appeals tend to reinforce points made by Robel. Fully 92% of the decisions affirming the Board were unpublished, but only 32% of reversals.[44] It also appears that, while published opinions indicate that disgruntled applicants have a 65% chance of getting something for their efforts, the actual odds are less than a third as favorable — about 19%.[45] One would hope that appellants do not file appeals based on gross odds. Still, were false signals were being sent at the same time that the court was complaining about frivolous appeals?[46] One must wonder, too, about the advantage conferred on the Solicitor in being able, in a way impossible for virtually anyone else, to see the big picture. Finally, it would be interesting to know the extent to which he can "stack the precedential deck"[47] in the CAFC — obviously in trademark as well as patent appeals.

---

[40] *Id.* at 958.

[41] *Id.*

[42] *Id.*

[43] Bodwell, *supra* note 34.

[44] *Id.* at 241.

[45] *Id.* Claim allowed: published cases = 17/26; total cases = 25/107. Because the data are not free from ambiguity, the table from which these conclusions are drawn is reproduced below.

Table 3. PTO Board Appeals

	Published	*Unpublished*	*Totals*
All claims refused	9	98	107
Claim allowed	17	8	25

[46] *See, e.g., Franklin Pierce Law Center: Second Patent Systems Major Problems Conference*, 30 IDEA 107, 177-79 (1989).

[47] *See supra*, at notes 41 and 42.

V. Why Agencies Cannot Ignore Prior Decisions

Many agencies can develop the law through rule making,[48] various kinds of pronouncements,[49] and formal or informal adjudication.[50] In circumstances where adjudications are unpublished or are otherwise not up to the challenge of ensuring consistent party treatment, rule making may be appropriate.[51] However, the Supreme Court has never required rule making in cases of first impression or when ad hoc decisions were available.[52]

Unlike many agencies, the PTO's options appear to be limited insofar as the CAFC has stated that the PTO does not have substantive rule making authority.[53] Whether that is true or not and regardless of whether the CAFC must defer to PTO interpretations of its statute, the PTO makes many rules that effectively bind parties, often for a long time.[54] Traditionally, most have been developed through decisions of the Commissioner, someone acting in his name, or the Boards.

However, the PTO is not, any more than the courts, forever bound by prior decisions. Reviewing courts require only reasoned decisions,[55] and a decision articulating a reason for, e.g., a change in position or an exception is apt to be acceptable as long as it is not, e.g., applied retroactively so as to have a significant impact on those acting in reliance on previously enunciated rules.[56] From this perspective, agencies can-

---

[48] The options are more thoroughly considered in Thomas G. Field, Jr. Commentary: *Review of PTO Intramural Appeal Procedures*; those comments appear earlier in this issue of IDEA.

[49] *See, e.g.*, Metropolitan School Dist. of Wayne Township v. Davila 969 F.2d 485 (7th Cir. 1992).

[50] "Formal" adjudication is usually regarded as adjudication satisfying the requirements of, e.g., 5 U.S.C. §§ 554, 556 and 557.

[51] *See, e.g.*, Sun Ray Drive-In Dairy, Inc. v. Oregon Liquor Control Comm., 517 P.2d 289 (1973); *see also* Heckler v. Campbell, 416 U.S. 458 (1983).

[52] *See, e.g.*, SEC v. Chenery Corp., 332 U.S. 194 (1947); see also, e.g., NLRB v. Wyman-Gordon Co., 394 U.S. 759 (1969).

[53] Animal Legal Defense Fund v. Quigg, 18 U.S.P.Q.2d 1677 (1991). Indeed, at 1685, the Court mentions that the Commissioner denies that they even bind examiners.

[54] Consider how long it took for the CAFC to have a chance to rule that the PTO had misconstrued the meaning of "commerce" as defined in 15 U.S.C. § 1127. *See, e.g.*, Peter C. Christensen and Teresa C. Tucker, *The "Use in Commerce" Requirement of Trademark Registration after* Larry Harmon Pictures, 32 IDEA 327 (1992).

[55] *See, e.g., Chenery, supra* note 52.

[56] *See, e.g.*, Retail Union v. NLRB, 466 F.2d 380, 38793 (D.C. Cir. 1972).

not refuse to consider rules explicit or implicit in prior decisions any more than they can refuse to consider other rules.[57]

Published rules no doubt have more impact than unpublished ones. However, this does not justify an agency's insistence that one has no right to rely on unpublished evidence of its position. In fact, parties frequently have no alternative, and courts will review established agency positions regardless of whether they appear in a formally published document.[58] Moreover, reliance is not the sole measure of fairness. It is difficult to imagine anything more at odds with fundamental due process than inconsistency in treatment of similarly situated parties.[59]

VI. The Freedom of Information Act

Clearly, one cannot cite prior decisions that are unavailable. If agencies attempt to influence development of the law by what is published by the courts,[60] it seems likely that they would also do so with internal documents. Frequent litigators know that "hard cases make bad law," with "bad" being defined, of course, from their own perspective. Thus, they have a strong incentive to settle "hard" cases and litigate easy ones — both internally and externally.[61] And, of course, they have an incentive to make sure that favorable results are widely known and available as precedent.

The FOIA is the primary authority controlling what information (other than about oneself) must be provided by, or any person can demand from, the U.S. government.[62] Many FOIA requests seem to be brought by not-so-frequent litigators attempting to learn what a particular agency is likely to regard as a "hard" case, and many agencies have stoutly resisted — even when they have virtually untrammeled prosecutorial discretion.[63]

For present purposes, the first two subsections are most important. Section 552(a) governs disclosure and the fees that may be charged; § 552(b) sets forth nine exceptions.

---

[57] *See, e.g.*, Morton v. Ruiz, 415 U.S. 199 (1974), holding that agencies are obligated to follow their own published positions on the law — whether or not they bind anyone else.

[58] *See, e.g.*, Continental Airlines v. CAB, 522 F.2d 107 (D.C. Cir. 1974).

[59] *See, e.g.*, *Sun Ray*, 517 P.2d 289; *see also*, the quotation from *Holt supra*, at note 3.

[60] *See* Robel, *supra*, at note 38.

[61] *See, e.g.*, J.T. O'REILLY, FEDERAL INFORMATION DISCLOSURE 316 (2d ed. 1990).

[62] 5 U.S.C. § 552.

[63] *See, e.g.*, NLRB v. Sears, Roebuck & Co., 421 U.S. 132 (1975).

Disclosure requirements

Section § 552(a) begins: "Each agency shall make available to the public information as follows." It then describes information that must be: (1) published, (2) made available for public inspection or (3) furnished on demand.

Material that must be published includes:

> (C) rules of procedure, descriptions of forms . . ., and instructions as to the scope and contents of all papers, reports, or examinations;
> (D) substantive rules of general applicability . . ., and statements of general policy or interpretations of general applicability . . .; and
> (E) each amendment, revision, or repeal of the foregoing.

Material that must be made available for public inspection and copying includes:

> (A) *final* opinions, including concurring and dissenting opinions, as well as orders, made in the adjudication of cases . . . unless the materials are promptly *published and copies offered for sale.* (emphasis added).

If that information is not already provided, then it must promptly be made available to any person on demand.[64] Although all pertinent FOIA litigation is based on the third provision, the other two are very important. For example, only final decisions[65] can be obtained — notwithstanding that the PTO makes some non-final orders available.[66]

Also, while the last clause of § 552(a)(2) might support a definition of "published" as requiring *the government* to offer copies for sale, the government itself currently publishes few, if any, PTO decisions.[67] Thus the term, "published," generally indicates only whether it has been so labeled.[68]

Following an apparently redundant exclusion,[69] § 552(a)(2) ends with

---

[64] Section 553(a)(3).

[65] *See, e.g.*, Leeds v. Commissioner of Patents and Trademarks, 21 U.S.P.Q. 2d 1771 (D.C. Cir. 1992). One of the more interesting aspects of this and other FOIA cases is that they have been decided by the DC Circuit rather than the CAFC. *Compare* Wyden v. Commissioner of Patents and Trademarks, 231 U.S.P.Q. 918, 921 (Fed. Cir. 1986) (Markey dissenting).

[66] *See, e.g., Clevenger*, 230 U.S.P.Q. at 375 n.2 — also referring to a long-standing practice concerning non-final interference discovery opinions and orders.

[67] In recent PTO decisions I examined, all citations to prior PTO cases were to the U.S.P.Q., not to, e.g., the O. G.

[68] *See supra* Part II.

[69] "To the extent required *to prevent a clearly unwarranted invasion of personal privacy, an agency may delete identifying details*. . . . However, in each case the justification for the deletion shall be explained. . . ." Compare § 552 (b)(6).

language directly bearing on the precedential value of administrative decisions:

> Each agency shall also maintain... current indexes... as to any matter issued, adopted, or promulgated *after July 4, 1967*, and required by this paragraph to be made available or published. Each agency shall promptly publish,... copies of each index or supplements thereto unless... unnecessary and impracticable, in which case the agency shall nonetheless provide copies of such index on request at a cost not to exceed the direct cost of duplication. A *final order*, opinion, statement of policy, interpretation, or staff manual or instruction *that affects... the public may be relied on... as precedent by an agency against a party... — only if*
> *(i) it has been indexed and either made available or published as provided by this paragraph; or*
> *(ii) the party has actual and timely notice of the terms thereof.* (emphasis added).

While this provision permits an agency to use a publicly available and indexed decision against a private party, it does not address the issue discussed earlier. Can such decisions can be used *by a party against the agency*? Nor does the provision address whether decisions can be used *against another party in inter partes proceedings*. While Part V of this paper did not explicitly address the last issue, the same considerations apply, i.e., a party should be allowed to rely on evidence of past agency practice and be entitled to the treatment afforded others similarly situated.[70]

The language at the end of § 552(a)(2) was also central to a ten-year fight by Edward Irons to secure access to unpublished decisions of the PTO.[71] While the court expressed considerable skepticism, it did not reach the issue of whether Irons could have access to decisions, not only rendered after 1967, but also going back to 1853.[72] Nor, unfortunately, did it decide whether the mere presence of an indexed, post-1967 decision in a patent file would satisfy the requirements of § 552(a)(2)(A).[73] No court has since ruled on either.

FOIA Exceptions

Three of the nine § 552 exceptions are also of interest with regard to the PTO:

---

[70] *See* McKelvey, supra at note 31. No place in his letter does he suggest or even address possible differences between the two situations.

[71] Irons v. Diamond, 214 U.S.P.Q. 81 (D.C. Cir. 1981).

[72] *Id.* at 83.

[73] *Id.* at 85; *see also Leeds, supra* note 65.

> (b) This section does not apply to matters that are — . . .
> (3) specifically exempted from disclosure by statute. . ., provided that such statute (A). . . *leave[s] no discretion* on the issue, or (B) establishes particular criteria. . .;
> (4) trade secrets and commercial or financial information obtained from a person and privileged or confidential;. . . .
> (6) personnel and medical files *and similar files* the disclosure of which would constitute a clearly unwarranted invasion of personal privacy; . . . . (emphasis added).

Exemption 3 resulted in conflicting interpretations that were resolved in *Irons*.[74] Notwithstanding that 35 U.S.C. § 122 seems to allow the Commissioner discretion with regard to disclosure,[75] the court found that the PTO could withhold entire documents, not just sensitive parts.[76] Yet, the current significance of this is unclear in light of 37 C.F.R § 114(d), clearly contemplating partial disclosure in the absence of "good reasons" to the contrary. That rule seems more in line with exemption 4 than 3.[77]

Exemption 6 was applied when William Carter sought records of dismissed PTO disciplinary investigations.[78] There, Chief Judge Wald held that it was proper for the PTO to withhold information invading the privacy of accused patent attorneys. She also held that the district court did not abuse its discretion by refusing to inspect the original documents *in camera* — particularly where agency affidavits were not conclusory and there was ample evidence of good faith.[79]

FOIA Fees

Section 552(a)(4) permits the government to recover the costs of complying with demands under § 552(a)(3) — at least when the request serves a "commercial" end. One bone of contention in *Irons* was: Who would bear the expense of putting together the information provided?[80] In any event, it is clear that costs were or would have been substantial in each of the FOIA cases. Thus, it is not surprising that fee provisions have been repeatedly amended.[81]

---

[74] *Irons*, 214 U.S.P.Q. at 82.

[75] By the language permitting the release of information "in such special circumstances as many be determined by the Commissioner. . . ."

[76] 214 U.S.P.Q. at 82.

[77] *See, e.g.*, Executive Order 12,600, 3 C.F.R. § 235 (1988).

[78] Carter v. Commerce Dept., 14 U.S.P.Q.2d 1454 (Fed. Cir. 1992). One cannot help wondering whether the CAFC might have reached a different conclusion. *See Wyden*, 231 U.S.P.Q. at 921; *see also*, supra note 61 and discussion.

[79] *Id.* at 58-9.

[80] *Irons*, 214 U.S.P.Q. at 84.

[81] *See, e.g.*, ADMINISTRATIVE CONFERENCE OF THE UNITED STATES, FEDERAL ADMINISTRATIVE PROCEDURE SOURCEBOOK 659 (2d ed. 1992)

More attention should be given to reducing the government's costs (regardless of who bears them) and to making whatever information is generated more readily available to those inside and outside the agencies. The cost of even superficial indexing is apt to be enormous and is unlikely to be useful to those seeking information. Without sophisticated subject matter indices — at least with regard to decisions, information is only *theoretically* available.

VII. Conclusions

At the moment, most documents are generated by computer. Such documents can be be made available as ASCII text files — a generic format that can be used by commonly available computers — enabling searches for words or phrases in context. If theoretically available government documents were available as ASCII files, it would permit *meaningful* access to otherwise virtually inaccessible information. Costs of distribution by modem[82] or floppy disk should be only a small fraction of the cost of, e.g, photocopying. Where demand proved sufficient to warrant CD-ROM production, the cost per unit of information would permit almost universal access.

More importantly, regardless of how ASCII files were made available, they would largely eliminate the need for indices. For administrative decisions, orders *and documents incorporated by reference*, the indexing requirement of 5 U.S.C. § 552(a) could be eliminated. Subject matter indexing is expensive — and problematic under the best of circumstances. Full text searching with commonly available software is vastly superior.[83] Being able to search in this way would be highly valuable in determining the final dispositions of controversies in factually similar circumstances, especially for types of controversy that

---

[82] Actually, the files could be *downloaded or searched* (as with Lexis or Westlaw) via modem. Delivering ASCII files to Mead Data and/or West Publishing would make it feasible to include more information in their databases than delivering hard copy. Converting hard copy to machine readable form is expensive, introduces the possibility of error, and, when hard copy has been generated by computer, is outrageously inefficient.

[83] *See, e.g., Using RISK on Disk*, 3 RISK: ISSUES IN HEALTH & SAFETY 316 (1992). I am editor-in-chief of that journal and publish it in both paper and disk formats. I am also the instigator of a project being undertaken by Franklin Pierce Law Center and the Licensing Executives Society to convert LES NOUVELLES into a form facilitating computer content searches.

This approach is necessary when, for whatever reason, it is not feasible to include the information in the Lexis or Westlaw databases. Moreover, searching local media may be considerably less expensive and faster insofar as, e.g., it eliminates long distance phone charges and can substantially exceed current baud rates for modem access.

tend to be highly fact specific and, thus, unlikely to result in an "opinion" suitable for publication.[84]

Distributing documents available under FOIA as ASCII text would eliminate most of the TTAB's recently expressed basis for concern.[85] It should also be better than, e.g., requiring parties who cite unpublished opinions to share them with opponents. If one party has much easier access to some cases, the other is nevertheless apt to feel short-changed.

Documents being available *in fact as well as theory* would also save the Solicitor's Office some of the burden of ensuring sufficient facts in opinions. For documents not exempt under 35 U.S.C. § 122, it would be feasible to append information that would otherwise be available only by calling up, copying, and visually searching file wrapper documents to determine whether they *might* contain anything useful.

To the extent that use of "unpublished" precedents is "unfair" because of differing ability to access them, access should be improved. For reasons that have been advanced by court critics,[86] and for others applicable only to agencies,[87] eliminating precedential status of "unpublished" administrative opinions seems to be a cure worse than any disease it might treat. Moreover, in light of current and quickly improving technology, it seems wholly unnecessary. Such technology makes it possible for everyone to have much better and cost-effective access than is possible with any alternative. Failure to take prompt measures to use that technology seems inexcusable.

---

[84] *Consider, e.g.*, petitions for extensions of time based on unavoidable delay as in *Rydeen*, supra note 7. It seems much more likely that decisions denying petitions would be published than decisions granting petitions. Yet, without the latter, how can petitioners evaluate their chances or argue that they are being treated differently from others similarly situated?

[85] *See supra* at note 20.

Moreover, it should go a long way toward addressing some of the difficulties discussed by Margaret Gilhooley, *The Availability of Decisions and Precedents in Agency Adjudications: The Impact of the Freedom of Information Act Publication Requirements*, 3 ADMIN. L.J. 53, 84-88 (1989). Of the agencies Professor Gilhooley examined, only the Social Security Administration (SSA) had a policy regarding use of its decisions as precedents (prohibiting such use); *id.* at 81.

See also J.L. MASHAW & R.A. MERRILL, ADMINISTRATIVE LAW: THE AMERICAN PUBLIC LAW SYSTEM 23940 (1985), reporting that SSA ALJs decided over 250,000 cases and the SSA Appeals Council over 40,000 per year as of 1982. It has been suggested that the number of decisions is too overwhelming for that agency to use precedent, but the PTO manages to do so in spite of almost 8,000 cases being decided by its Boards in 1991; *see* 57 F.R. 34123 (1992).

[86] *See supra* Part IV.

[87] *See supra* Part V.