Why Parties Can Rely on "Unpublished" PTO Board Opinions

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Twelve years ago, I argued, contrary to what continues to be stated in many PTO opinions, that any opinion available to the public is precedential; see *Access and Authority to Cite Unpublished Decisions of the PTO,* 33 IDEA 153 (1993). In an opinion cited in TMEP § 705.05 and later decisions, the TTAB said that it saw "no compelling reason to allow unpublished or digest decisions to be cited as precedent.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," General Mills, Inc. v. Health Valley Foods, 24 U.S.P.Q.2d 1270, 1275 (TTAB 1992) (emphasis added).

The opinion in *General Mills* offers no primary authority for its holding and, more significantly, fails to cite Clevenger v. Martin, 230 USPQ 374 (Com'r 1986). At 375 n.2, the latter opinion explicitly permits citation of unpublished orders on condition that other parties be served with copies. If it was aware of *Clevenger,* the TTAB in *General Mills* may have regarded a ruling in a patent interference as inapposite. As quoted in my article, 44 IDEA at 159-60, however, then-Solicitor McKelvey concluded to the contrary. Moreover, rulings of the boards on procedural matters are subject to reversal on petition, and views of the Commissioner (now "Director") control. It is unfortunate that no one has yet pursued that avenue, but few seem inclined to challenge the PTO when officials refuse to consider "unpublished" opinions that are in fact publicly available — perhaps, as was untrue in 1993, even in BNA's USPQ 2d.

That most federal courts of appeal did not permit citation of "unpublished" opinions in 1992 may have encouraged the TTAB in *General Mills.* Contrary to the quoted suggestion in that opinion, however, PTO boards are not courts. Agencies such as the PTO that refine substantive law via ad hoc adjudication are not forever straddled with positions adopted in a particular cases; *see, e.g.,* Atchison, T. & S. F.

Ry. Co. v. Wichita Bd Trade, 412 U.S. 800, 807 (1973) (plurality). They may not, however, deviate from rules set out in prior opinions without explanation, *id.* at 808. The latter proposition was clearly acknowledged by the TTAB in In re Wilson, 57 U.S.P.Q.2d 1863, 1871 (2001), but it did not apply because individual examiners lack authority to make rulings that bind the boards. Although it was not cited, *see* Heckler v. Community Health Serv., Crawford Cnty., Inc., 467 U.S. 51, 65 n. 21 (1984).

Although it is beside the point, because the TTAB in *General Mills* referred to judicial practices, it is worth noting that many courts have reconsidered strict no-citation rules. As reported last April by Tony Mauro in *Legal Times,* nine of thirteen Circuits now permit citation of such opinions. Indeed, an Eighth Circuit panel in Anastasoff v. U.S., 223 F.3d 898 (2000), (later vacated as moot) went so far as to hold that the Circuit's no-citation rule was unconstitutional. Weighing in on the other side in Hart v. Massanari, 266 F.3d 1155 (2001), a Ninth Circuit panel soon concluded otherwise. Following considerable debate, federal appellate rule 32.1, since drafted to make it easier to cite unpublished opinions, has recently been relegated to the never-never land of "further study."

Problems giving rise to no-citation rules are significant, whether in courts or agencies, but lack of access is no longer among them. Especially since enactment of the Electronic Freedom of Information Act Amendments of 1996, P.L. No. 104–231 (Oct. 2, 1996), all who care to look should readily find all agency decisions (except perhaps a few excluded by 35 U.S.C. § 122).

Particularly in light of that, PTO decisionmakers need to consider more carefully Davila-Bardales v. INS, 27 F.3d 1, 5 (1st Cir. 1994). As quoted in *Wilson,* 57 U.S.P.Q.2d at 1871, the First Circuit said: "[T]reating virtually identical legal issues differently in different cases, without any semblance of a plausible explanation, raises precisely the kinds of concerns about arbitrary agency action that the

consistency doctrine addresses (at least where the earlier decisions were not summary in nature, but rather contained fully reasoned explications of why a certain view of the law is correct)." The parenthetical observation in *Davila-Bardales* may be seen to leave room for non-precedential summary dispositions, but that would be a mistake.

As stated in SEC v. Chenery, 332 U.S. 194, 196-97 (1947), "It will not do for a court to be compelled to guess at the theory underlying the agency's action; nor can a court be expected to chisel that which must be precise from what the agency has left vague and indecisive. … We must know what a decision means before the duty becomes ours to say whether it is right or wrong." (Citation and internal quotation marks omitted). Federal Circuit opinions such as Gechter v. Davidson, 116 F.3d 1454, 1459 (1997) and In re Lee, 277 F.3d 1338 (2002) have echoed that. In the latter at 1344, the Court notes that "Conclusory statements such as those here provided do not fulfill the agency's obligation."

Decisions that do not rest on well-articulated reasons are unlikely to be upheld. Because a decision maker may summarily endorse the reasoning of another official or incorporate by reference material from parties' briefs, reasons need not be fully set forth in accompanying opinions. Neither that nor the capacity to distinguish or overrule positions adopted in prior opinions should have any bearing. Whether published, "unpublished," or incorporated by reference, reasons given for prior decisions must, to avoid the appearance if not the reality of arbitrary action, bear on later cases.