

Binding Precedent in the Trial Section of the BPAI¹

By

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I. Introduction

The stunning fact about binding precedent in the Trial Section of the BPAI is that there is very little of it. Over the past four years, the following opinions labeled as binding precedent of the Trial Section of the BPAI have been published in the USPQ³:

- (1) Therriault v. Garbe, 53 USPQ2d 1179 (PTOBPAI 1999) (expanded panel);
- (2) Winter v. Fujita, 53 USPQ2d 1234 (PTOBPAI 1999) (expanded panel)⁴;
- (3) Winter v. Fujita, 53 USPQ2d 1478 (PTOBPAI 2000) (expanded panel);
- (4) Tropix Inc. v. Lumigen Inc., 53 USPQ2d 2018 (PTOBPAI 2000) (expanded panel);

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³ Some of these opinions are arguably binding precedent of the board, but not binding precedent of the Trial Section. See Gholz, A Critique of Recent Opinions in Patent Interferences, 83 JPTOS 161 (2001), at pages 189-190, “The Trial Section Has Three Times Suggested that Pre-Trial Section Binding Precedents Are Not Binding on It.”

⁴ According to an “Editor’s Note” in the USPQ:

The Board of Patent Appeals and Interferences states that “[p]arts 1-A, III-A, III-B, and IV of this opinion are binding precedent of the Trial Section.”

- (5) Waterman v. Birbaum, 53 USPQ2d 2024 (PTOBPAI 2000) (expanded panel) (per curiam);
- (6) Basmadjian v. Landry, 54 USPQ2d 1617 (PTOBPAI 1997)⁵;
- (7) Hillman v. Shyamala, 55 USPQ2d 1220 (PTOBPAI 2000) (expanded panel);
- (8) Lee v. McIntyre, 55 USPQ2d 1137 (PTOBPAI 2000) (expanded panel);
- (9) Lee v. McIntyre, 55 USPQ2d 1406 (PTOBPAI 2000) (expanded panel);
- (10) Shiokawa v. Maienfisch, 56 USPQ2d 1970 (PTOBPAI 2000) (expanded panel);
- (11) Glaxo Wellcome Inc. v. Cabilly, 56 USPQ2d 1983 (PTOBPAI 2000);
- (12) GN v. SW, 57 USPQ2d 1073 (PTOBPAI 2000) (expanded panel);
- (13) Cromlish v. D.Y., 57 USPQ2d 1318 (PTOBPAI 2000) (expanded panel);
- (14) LeVeen v. Edwards, 57 USPQ2d 1406 (PTOBPAI 2000) (expanded panel) (per curiam);
- (15) LeVeen v. Edwards, 57 USPQ2d 1416 (PTOBPAI 2000) (expanded panel) (per curiam);
- (16) Louis v. Okada, 57 USPQ2d 1430 (PTOBPAI 2000) (expanded panel);

and

⁵ According to an “Editor’s Note” in the USPQ:

The Board of Patent Appeals and Interferences states that this opinion “has been designated by the Board as precedential with respect to Part I of the opinion relating to the summary judgment practice of the Board. The remainder of the opinion (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.”

(17) Louis v. Okada, 59 USPQ2d 1073 (PTOBPAI 2001) (expanded panel).

In contrast, during these same four years the following opinions labeled as not being binding precedent of the Trial Section of the BPAI have been published in the USPQ:

- (1) Cabilly v. Boss, 55 USPQ2d 1238 (PTOBPAI 1998);
- (2) Fang v. Pischel, 55 USPQ2d 1383 (PTOBPAI 2000) (single APJ);
- (3) Bamberger v. Cheruvu, 55 USPQ2d 1523 (PTOBPAI 1998);
- (4) Ex parte Kimura, 55 USPQ 1537 (PTOBPAI 2000);
- (5) Argyropoulos v. Swarup, 56 USPQ2d 1794 (PTOBPAI 2000);

- (6) Fulano v. Abrano, 57 USPQ2d 1091 (PTOBPAI 2000) (per curiam);
- (7) Yamada v. Aggarwal, 57 USPQ2d 2002 (PTOBPAI 2000);
- (8) O'Young v. Powers, 58 USPQ2d 1242 (PTOBPAI 2000) (single APJ);
- (9) Shiokawa v. Maienfisch, 58 USPQ2d 1479 (PTOBPAI 2001);
- (10) Edwards v. Strazzabosco, 58 USPQ2d 1836 (PTOBPAI 2001);
- (11) Glaxo Wellcome Inc. v. Cabilly, 58 USPQ2d 1859 (PTOBPAI 2001) (per curiam);

- (12) Singer v. Rehfuss, 59 USPQ2d 1190 (PTOBPAI 2001);
- (13) XX v. YY, 59 USPQ2d 1245 (PTOBPAI 1999);
- (14) Gluckman v. Lewis, 59 USPQ2d 1542 (PTOBPAI 2001) (single APJ);
- (15) Furman v. Cheng, 59 USPQ2d 1668 (PTOBPAI 2001) (per curiam);
- (16) Johnston v. Beachy, 60 USPQ2d 1584 (PTOBPAI 2001) (expanded panel)
- (17) Cabilly v. Boss, 60 USPQ2d 1752 (PTOBPAI 2001);
- (18) Tsuruta v. Nardella, 60 USPQ2d 1822 (PTOBPAI 2001);

- (19) Ellsworth v. Moore, 61 USPQ2d 1499 (PTOBPAI 2001);
- (20) Wojciak v. Nishiyama, 61 USPQ2d 1573 (PTOBPAI 2001) (single APJ);
- (21) Wojciak v. Nishiyama, 61 USPQ2d 1576 (PTOBPAI 2001);
- (22) Rose v. Frazier, 61 USPQ2d 1606 (PTOBPAI 2001);
- (23) Bronshtein v. Roser, 61 USPQ2d 1738 (PTOBPAI 2001) (single APJ);
- (24) Bronshtein v. Roser, 61 USPQ2d 1742 (PTOBPAI 2001) (single APJ);
- (25) Eli Lilly & Co. v. Cameron, 61 USPQ2d 1863 (PTOBPAI 2001);
- (26) Rohrmann v. Alt, 61 USPQ2d 1957 (PTOBPAI 2001);
- (27) Scott v. Gbur, 62 USPQ2d 1959 (PTOBPAI 2002); and
- (28) Han v. Livak, 63 USPQ2d 1364 (PTOBPAI 2002);
- (29) Morrison v. Lakes, 63 USPQ2d 1742 (PTOBPAI 2002);
- (30) Stampa v. Jackson, 65 USPQ2d 1942 (PTOBPAI 2002) (single APJ); and
- (31) Anderson v. Epstein, 66 USPQ2d 1113 (PTOBPAI 2002).

Moreover, note that, in 2002, the USPQ published five non-precedential Trial Section opinions and no precedential Trial Section opinions.⁶

According to the BPAI's "Standing Operating Procedure 2 (Revision 4):
Publication of opinions and binding precedent":

When authoring an opinion, a panel or a single judge may determine that the opinion may be published or not published. The fact that a panel or judge determines that an opinion may be published does not mean that it must be published; it means only that the authoring panel or

⁶ The precipitous drop-off in published Trial Sections opinions of any kind after mid-2002 is no doubt due to the third retirement of SAPJ McKelvey.

judge has no objection to its being published.

When the panel or the judge has no objection to publication of the opinion, the opinion should contain the appropriate one of the following headings on the first page:

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

The opinion in support of the decision being entered today is binding precedent of the Interference Trial Section of the Board of Patent Appeals and Interferences. The opinion is otherwise *not* binding precedent of the Board.

When a panel does not consider publication of the opinion warranted, the opinion should contain the following heading on the first page:

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Opinions of the Trial Section that bear the second of these three possible headings are indicated as being precedential opinions by the USPQ.

II. **The Contrast Between the Trial Section’s Practice and the Federal Circuit’s Practice with Respect to Non-Precedential Opinions**

According to Federal Circuit Rule 47.6(b), “An opinion or order which is designated as not to be cited as precedent [i.e., as being what is called a non-precedential opinion or order] is one unanimously determined by the panel issuing it as not adding significantly to the body of law.” According to Hamilton v. Brown, 39 F.3d 1574, 1581 (Fed. Cir. 1994):

They [nonprecedential opinions and orders] are nonprecedential for a reason—while the decision itself receives due care, as do all cases before us, the explanation given in the summary disposition does not necessarily contain a full recitation of all the relevant facts and legal authorities. The opinion or order is primarily for the benefit of the parties. It is error to assume that a nonprecedential order or opinion provides support for a particular position or reflects a new or changed view held by this court.

However, there is nothing remotely resembling the Federal Circuit’s standard in the board’s Standard Operating Procedure. Moreover, in my opinion, many of the Trial Section’s opinions not designated as binding on the Trial Section do “add[] significantly to the body of [interference] law”—particularly the law governing procedures in interferences handled by the Trial Section. According to section 14, “Citation of precedent and other authority,” of the Trial Section’s standing order:

Non-precedential decisions by the board may be cited, but are not binding.

This, of course, is in sharp contrast to the Federal Circuit rule that its non-precedential opinions cannot even be cited to the court.

III. A Plea for a Change in the Current Practice

I am convinced that, in practice, each of the APJs in the Trial Section does give respectful attention to the published opinions of his or her colleagues that are designated as not being binding precedent of the Trial Section. Moreover, I am persuaded that, in the overwhelming majority of cases, that is all that designating an opinion as binding precedent of the Trial Section really means. (If an APJ wants to not follow a precedent, he or she can always manage to distinguish it.) However, designating so many of its opinions as not being binding precedent of the Trial Section gives a very bad impression of the Trial Section to the general patent bar. It makes it seem that the APJs in the Trial Section decide their cases on whim (which I don't believe to be the case). Accordingly, this is to plead with the Chief Administrative Patent Judge and the Trial Section (1) to develop a new standard operating procedure modeled to a greater or lesser extent on the Federal Circuit's Rule 47.6(b) except that it continue to permit citation of non-precedential opinions⁷ and (2) to designate more opinions of the APJs in the Trial Section as binding precedent of the Trial Section.

⁷ After all, they taught us in law school that what a judge or a panel of judges does once, he, she, or it is likely to do again.

IV. **An Academic Perspective**

I sent a draft of this article to Prof. Carl Moy of the William Mitchell College of Law in St. Paul, Minnesota. Prof. Moy is an expert on many things, including non-precedential opinions, so I think that his perspective is especially illuminating.⁸

To me, the striking thing is that the Board is apparently acting without giving any thought to why its decisions are precedential in the first place. Do they mean to assert that they are free to adopt different substantive standards in future cases, regardless of the basis on which prior parties have been treated? This would be extreme. Do they instead mean to assert that, while they will give consideration to the treatment of prior parties, the question of what is or is not consistent treatment is for the Board to decide itself, without discussion or advice from the parties whose rights are under adjudication? This also seems very extreme. Do they mean that the entire area is governed by statutes and regulations, and that no cases matter? This seems to be contradicted by their designation of some decisions as precedential. Are they asserting that they are immune from common-law principles in some way because they are part of an agency?

⁸ Prof. Moy graciously authorized me to publish this slightly edited version of his email to me.

At its root, the Board's position seems to be at odds with the basic ways in which common-law adjudication works. One cannot use a common-law system of adjudication without making new law to some extent. That is both the system's beauty and its tyranny. It is almost as if the Board really wants to use some sort of rulemaking authority, turning it "on" when it designates its opinions as precedential, and turning it "off" when it designates them as non-precedential. In that case, it is troubling that the Board issues these precedential rules without notice and comment.

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