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COMMENTARY: THE TALE OF THE UNPUBLISHED DECISION

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Once upon a time the United States Patent and Trademark Office (PTO) assumed responsibility for its actions. Decisions of its Board of Appeals (now the BPAI) were open and readily available to the public when a patent issued or when released by applicants or their assignees. Now, however, for some years the PTO has virtually precluded the publication of all BPAI decisions. This has held true even after patents on the involved applications issued.

The PTO's practice of not publishing BPAI decisions is unfortunate, and a complete disservice to applicants. Members of the patent law community have a right to know and rely upon all decisions rendered by the BPAI that are open to the public. By precluding publication of such decisions, the PTO has undoubtedly increased the number of appeals. Thus the burden is placed on the BPAI to make additional decisions because previous cases are unavailable to practitioners, including the reasoning behind those decisions.

The PTO pretends to reflect a desire to improve its operations by providing questionnaires and requesting input from interested practitioners. Meanwhile, the PTO precludes applicants from having access to the holdings that could help them obtain patent protection without going through the appeal process.

Patent practitioners now face a significant change in practice as the life of any patent is restricted to 20 years from the filing date of the first application. This means that, in the absence of a significant effort to obtain an extension, any appeal materially decreases the value of a resulting patent by reducing the patent term.

The PTO should be making every effort to reduce the pendency of prosecution, not unnecessarily forcing appeals or refilings. The PTO should streamline examination, and eliminate grounds of rejection that *598 have been reversed by prior decisions of the BPAI. Further, the PTO should make certain that Examiners and practitioners are promptly made aware of all official actions by the BPAI, particularly those that involve commonly-encountered issues.

In the final issue of 1995 for the weekly advance sheets of The United States Patents Quarterly there were only two decisions of the BPAI, and each of these were designated

"unpublished." In fact, these may be the first unpublished decisions by the BPAI. One of these decisions, Ex parte Isshiki, [n1] was held up for publication for more than a year after the application issued as a patent.

The other of the two decisions, Ex parte Casagrande, Montanari, and Santangelo, [n2] involved issues that are frequently encountered in the prosecution of applications involving synthetic organic compounds. The compounds of the applicants' generic claims differed from their closest prior art counterparts merely by replacing a prior art hydrogen atom with a methyl group. The applicants presented evidence for several different compounds that the difference of substituting the methyl group for hydrogen was significant, but the Examiner maintained that the evidence was not commensurate with the scope of the claims.

As the evidence was directed to the point of distinction over applied art, the BPAI reversed. A further basis for reversal was that the prior art relied on disclosed the presence of either hydrogen or methyl at other positions of substitution, but not at the position in question. Such issues frequent the practice of a patent practitioner--what possible reason can there be for precluding practitioners, prosecuting an application on similar facts, from knowing and relying on that decision?

It is possible that the PTO may analogize the practice to that of courts which designate decisions as "unpublished and not citable as precedent." Unfortunately, this argument fails. The PTO is in a unique position, quite different from that of Article III courts. The Commissioner can reconstitute a new and expanded panel to review any decision of the BPAI with which he disagrees. [n3] Thus, by signing a patent, the Commissioner confirms the propriety of any decision of the BPAI involved in obtaining allowance of claims appearing in the patent.

*599 Since the Commissioner has complete control over actions of the BPAI, decisions that result in a patent grant must be regarded as precedent upon which the world can rely. To require them to be published with an editor's note: "The U.S. Patent and Trademark Office states that this decision was not prepared for publication and is not binding precedent on the Board of Patent Appeals and Interferences" should not be condoned nor supported by the community of patent practitioners.

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[n1]. 36 U.S.P.Q.2d (BNA) 1863 (BPAI 1995).

[n2]. 36 U.S.P.Q.2d (BNA) 1860 (BPAI 1995).

[n3]. The Commissioner is not bound by a BPAI decision that an applicant is entitled to a patent. The ultimate authority regarding the granting of patents lies with the Commissioner. If the BPAI approves an application, the Commissioner has the option of refusing to sign a patent; an action which would be subject to a mandamus action by the applicant. In re Alappat, 31 U.S.P.Q.2d 1545, 1550 (Fed. Cir. 1994).

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