

DIRECT JUDICIAL REVIEW OF PTO DECISIONS: JURISDICTIONAL PROPOSALS

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I. INTRODUCTION

Judicial review of U.S. Patent and Trademark Office (“PTO”)¹ decisions is complex — perhaps more than that of any other agency. One source of complexity is that courts review its decisions both collaterally and directly.

Collateral review occurs when those appearing before the agency are satisfied, but potential infringers of rights the PTO confers are not. The validity of PTO grants may always be challenged in litigation to enforce them,² and jurisdiction is unlikely to pose an issue.³ Straight-forward

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¹ Many following references to the PTO (“the Office”) are explained by the fact that not until 1975 did the name of the Office reflect its trademark role; Pub. L. No. 93-596, 3, 88 Stat.1949 (1975).

² See 35 U.S.C. § 282 ¶ 2(2) (1994 & Supp. V 1999) (invalidity is a defense to infringement), but the first sentence of § 282 states: “A patent shall be presumed valid.” See also, e.g., 15 U.S.C. § 1119 (power of courts over registrations in the context of infringement litigation) and § 1115(b) (1994 & Supp. V 1999) (incontestability under certain circumstances).

³ See 28 U.S.C. § 1338(a) (1994 & Supp. V 1999) (“The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents . . . and trade-marks.”). But see, e.g., *PHC, Inc. v. Pioneer Health Care, Inc.*, 75 F.3d 75, 37 U.S.P.Q.2d 1652 (1st Cir. 1996) (addressing a situation where both the PTO and a district court had jurisdiction).

collateral review, however, will be put aside in favor of taking a closer look at anything-but-straight-forward possibilities for direct review of PTO decisions.

The latter, alone, are more complex than those for judicial review of most other agencies.⁴ They have long posed jurisdictional traps for the unwary — although some may be reduced since passage of the Federal Courts Improvement Act of 1982.⁵

Yet, inefficient and time-consuming detours, if not traps, remain. As discussed below, difficulties may be exacerbated by the PTO's providing only partial information about review options.⁶ One goal of this article is to map possible routes to judicial review and suggest strategies for avoiding jurisdictional uncertainties and delay.

The core thesis of this article, however, is that parties should not need to cope with arcane review schemes. Direct PTO review can and ought to be simplified. That could be accomplished by adjusting the Federal Circuit's original and appellate jurisdiction. The Court's upcoming 20th anniversary⁷ affords an especially auspicious occasion to at least consider it.

To that end, in part II, the article explores limits to the court's original jurisdiction to review the PTO. In part III, it discusses the alternative — so-called “nonstatutory” review — which must be initiated in district courts. In part IV, the article discusses the Federal Circuit's appellate jurisdiction over those and other *patent* cases that must also begin in district courts.

Building on part IV, the article suggests that 28 U.S.C. § 1295 be amended to make the Court's appellate jurisdiction explicit in light of an implicit jurisdiction that is already widely conceded. With that foundation,

⁴ *But see Earth Island Inst. v. Christopher*, 6 F.3d 648 (9th Cir. 1993) (addressing jurisdiction to review the Secretary of State under 16 U.S.C. § 1537); *Ramey v. Bowsher*, 9 F.3d 133 (D.C. Cir. 1993) (addressing jurisdiction to review the General Accounting Office's Personnel Appeals Board under 31 U.S.C. § 755(a)).

⁵ Pub. L. No. 97-164, 96 Stat 25 (1982). Tit. III § 301(a) enacted 28 U.S.C. § 1631 (Transfer to cure want of jurisdiction). *See also, Trustees for Alaska v. U.S. Dept. Interior*, 919 F.2d 119, 123 (9th Cir. 1990) (transferring a misfiled direct appeal to the District of Alaska).

⁶ PTO rules address *statutory* review; *see, e.g., In re Marriott-Hot Shoppes, Inc.*, 411 F.2d 1025, 1028, 62 U.S.P.Q. 106, 109-10 (CCPA 1969) (discussing 37 C.F.R. § 2.145). Yet, nothing was found in its rules or practice manuals concerning *nonstatutory* review — discussed *infra* in part III.

⁷ *See generally, South Corp. v. U.S.*, 690 F.2d 1368, 215 U.S.P.Q. 657 (Fed. Cir. 1982). As related there, the Court was created by the Federal Courts Improvement Act, *supra* n. 5. The Act went into effect on Oct. 1, 1982, and *South Corp.*, its first decision, was handed down on Oct. 28, 1982.

the article ends by returning to issues raised by part III and arguing that the Federal Circuit's original jurisdiction should be expanded.

II. LIMITS TO ORIGINAL FEDERAL CIRCUIT JURISDICTION

Original appellate court jurisdiction is conferred by 35 U.S.C. § 141 (patents) and 15 U.S.C. § 1071(a) (trademarks).⁸ Before creation of the Federal Circuit, the Court of Customs and Patent Appeals ("CCPA") had jurisdiction under essentially the same provisions.

That neither court was, or is, able to review all PTO decisions has been addressed repeatedly during at least the past seventy years.⁹ Moreover, statutory language is not alone dispositive. That was established over thirty years ago in an appeal brought by Marriott-Hot Shoppes¹⁰ ("Marriott") to challenge the composition of the Trademark Trial and Appeal Board ("TTAB"). As related by the CCPA:

Appellant's sole objective on this appeal apparently is to change the practice in *ex parte* trademark appeals within the Patent Office to require that they be heard either by the entire Trademark Trial and Appeal Board or by a 'common law quorum' thereof, which is alleged to be at least four.¹¹

Because Marriott was challenging a decision of the Commissioner's Office,¹² not of the TTAB, the Solicitor moved to dismiss for lack of jurisdiction.¹³ The court granted the motion.

At the time, 15 U.S.C. § 1071(a)(1) read in relevant part: "An applicant for registration of a mark . . . who is dissatisfied with the *decision of the Commissioner* . . . may appeal to the United States Court of Customs and Patent Appeals"¹⁴

⁸ See also 28 U.S.C. § 1295(a)(4)(A) & (B) (1994 & Supp. V 1999). Jurisdiction is not exclusive, however; see 35 U.S.C. §§ 146 (1994 & Supp. 1999) and 15 U.S.C. § 1071(b) (2000).

⁹ See, e.g., *Sundback v. Blair*, 47 F.2d 378, 379-80, 8 U.S.P.Q. 220, 223 (CCPA 1931).

¹⁰ *In re Marriott-Hot Shoppes, Inc.*, 411 F.2d 1025, 162 U.S.P.Q. 106 (CCPA 1969).

¹¹ *Id.* at 1025, 162 U.S.P.Q. at 107. "Appellant says the board . . . has eight members if the First Assistant Commissioner is a member and seven if he is not. In the former case, the quorum is five and in the latter four." *Id.* at 1025 n. 1, 162 U.S.P.Q. at 107 n. 1.

¹² *Id.* at 1026-27, 162 U.S.P.Q. at 108 ("The Decisions Appealed From").

¹³ *Id.* at 1027-28, 162 U.S.P.Q. at 108-09 ("Question Raised by the Motion").

¹⁴ Lanham Act, § 21; 15 U.S.C. § 1071 (2000) (emphasis added) — unlike the Patent Act, section numbers in the Act and the U.S. Code differ.

The provision still reads the same except that the Federal Circuit has been substituted for

Because *Marriott* relied solely on the stressed language for its jurisdictional foundation, that was described as “simplistic.”¹⁵ Its position was said to ignore, as argued by the Office, “the classic distinction between appealable and petitionable matters, which is observed in both the patent and trademark examining operations” and

the myriad of “decisions” on various interlocutory and administrative questions . . . which are . . . certainly not appealable to this court, notwithstanding § 21. For that matter, not every “decision” of the *Board* is appealable under § 21. It must be “a dispositive decision in which a right has been adjudicated.” In [the quoted] case we dismissed an appeal from the Board’s decision on appellant’s motion to strike portions of an answer to an opposition and pointed out that it was not such a “decision” as is appealable.¹⁶

Moreover, showing remarkable deference to an Office rule¹⁷ — particularly one dealing with the jurisdiction of a court to review agency decisions — the court also stated that it:

like many other rules, expresses the Patent Office understanding of what the practice under statutory sections is intended to be. This rule makes it explicit that appeals to this court lie from decisions of the Commissioner only in the two categories of cases above mentioned.... This rule has existed as long as § 21 and has been amended in accordance with amendment of § 21. The administrative practice thereunder has been uniform and is of long standing. It is entitled to great weight in construing the statute.¹⁸

Also, despite clear sympathies to the contrary, the majority of the CCPA refused jurisdiction over *In re James*,¹⁹ a patent appeal, the next year.²⁰ Four members of the panel,²¹ agreed with the Solicitor that the Board of Patent Appeals and Interferences (“the board’s”) dismissing an appeal for

the CCPA and “Director” was substituted for “Commissioner.” See 35 U.S.C. § 3 (1994 & Supp. V 1999) (Officers and Employees), amended by Pub. L. No. 106-133 (1999). However, it appears that “Director” will soon again be replaced by “Commissioner;” see, e.g., 147 Cong. Rec. S11926 (daily ed. Nov. 15, 2001). The article attempts to ignore this blip in nomenclature.

¹⁵ *In re Marriott-Hot Shoppes, Inc.*, 411 F.2d at 1027-28, 162 U.S.P.Q. at 109.

¹⁶ *Id.* at 1028, 162 U.S.P.Q. at 109 (citations omitted).

¹⁷ 37 C.F.R. § 2.145 (2001).

¹⁸ *Id.*

¹⁹ 432 F.2d 473, 167 U.S.P.Q. 403 (CCPA 1970).

²⁰ *Id.* at 476, 167 U.S.P.Q. at 405 (CCPA 1970) (the board’s decision may have been “arbitrary” and “appear[ed] to have been less than fair”).

²¹ The CCPA had five judges and normally sat *en banc*. Yet, for reasons not apparent in the opinion, *Marriott, supra*, was decided by a three-judge panel.

appellant's failure to reply to an Examiner's new ground of rejection was not reviewable:

The board here appears to have been responding to what it thought to be the rulings of the Commissioner. . . . The action taken here, if dispositive, was so only in a procedural sense. Any error involved was solely an abuse of discretion. We have concluded that such action, standing by itself, was outside the scope of our authority to review and accordingly, this appeal must be dismissed.²²

The court went on to state, somewhat opaquely,²³ that the appellant should have filed a petition to the Commissioner and, if needed, sought review under the Administrative Procedure Act ("APA") — an option to be explored in the next section of this article. Still, one should consider the implications of this observation in Judge Rich's dissent:

In this case there is no doubt that a right has been adjudicated . . . , and there is no doubt that the decision was dispositive (the applicant will have lost his claims unless someone reverses the Board).²⁴

Yet, compare *In re Haas*,²⁵ where a patent petition was filed and denied, and an appeal to the board was denied *en banc* for lack of jurisdiction.²⁶ Despite the Solicitor's urging "that the board was not acting in its statutory capacity, reviewing on the merits an adverse decision of an examiner,"²⁷ the court took the case. It held that it had:

the right to determine whether the board properly refused to make such "decisions" in its statutory capacity. To hold otherwise would be to confer upon the board the power, albeit undoubtedly unwanted and unsought, to control the subject matter jurisdiction of this court.²⁸

The board had denied jurisdiction because the case was remarkably similar to one over which the CCPA had refused jurisdiction only two years before.²⁹ The court found it to implicate a practice said to have become widespread:

²² *In re Marriott-Hot Shoppes, Inc.*, 411 F.2d at 476, 162 U.S.P.Q. at 405-06.

²³ *Id.* at 476, 167 U.S.P.Q. at 405 ("Appellant's proper avenue for review was by recourse to Rule 181 and 5 U.S.C. §§ 701-706.")

²⁴ *Id.* at 477, 167 U.S.P.Q. at 407 (Rich, J. dissenting).

²⁵ 486 F.2d 1053, 179 U.S.P.Q. 623 (CCPA 1973).

²⁶ *Id.* at 1054, 179 U.S.P.Q. at 624.

²⁷ *Id.*, 179 U.S.P.Q. at 624.

²⁸ *Id.* at 1055, 179 U.S.P.Q. at 624. Compare *Marriott*, *supra* n. 15.

²⁹ *In re Hengehold*, 440 F.2d 1395, 1404, 169 U.S.P.Q. 473 (CCPA 1971) ("As the solicitor points out, action under 5 U.S.C. §§ 701-706 would appear appropriate to obtain that review.").

The impact of a denial of appellate review of that practice has been emphasized before us not only by appellant but by the American Patent Law Association in an amicus curiae brief.³⁰

It held, too, that “the Board of Appeals has jurisdiction . . . to review an adverse decision of an examiner when that decision, although designated a ‘withdrawal’ of a claim from further consideration, is in fact a rejection . . .”³¹

Moreover, that issues not open to direct challenge may be raised in appeals on the merits is illustrated by *In re Bose Corporation*.³² There, the validity of a TTAB decision was challenged because the opinion:

was signed by three board members, only two of whom were on the three member panel which had heard the oral argument. The third signatory replaced the original third panel member who resigned shortly after the argument. Bose was unaware of the change in composition of the panel until receipt of the decision.³³

When the Bose Corporation (“Bose”) became aware of the situation, it moved for rehearing, arguing that such a substitution violated the spirit of the statute requiring that each case be “heard by at least three members of the Board.”³⁴ After the board refused to grant its request voluntarily, Bose petitioned the Commissioner in his supervisory role; he refused to order a rehearing.³⁵

When both decisions were challenged in the Federal Circuit, the PTO questioned jurisdiction over the latter. The court agreed that the “statute does not provide a right of appeal generally from decisions of the Commissioner” but found that whether a petition had been filed and refused was essentially irrelevant:

No basis for questioning our jurisdiction over the *issue* is asserted, only our jurisdiction over the *Commissioner*. . . . [H]ad there been no petition, we would not hesitate to resolve the board composition question. As the Commissioner merely affirmed the board, we do not need to hold specifically that his decision is before us to address that issue. Accordingly, we determine only that, under the circumstances here, the petition has no effect on our jurisdiction to determine the validity of the

³⁰ *Haas*, 486 F.2d at 1054, 179 U.S.P.Q. at 624. It is unclear, however, exactly why such withdrawals were beyond review unless, perhaps, district courts entertaining action indicated in *Hengehold, supra*, were upholding the Office.

³¹ *Id.* at 1056, 179 U.S.P.Q. at 626.

³² 772 F.2d 866, 227 U.S.P.Q. 1 (Fed. Cir. 1985).

³³ *Id.* at 868, 227 U.S.P.Q. at 20.

³⁴ *Id.*, 227 U.S.P.Q. at 20 (quoting 15 U.S.C. § 1067).

³⁵ *Id.*, 227 U.S.P.Q. at 3.

board's decision.³⁶

Moreover, the court found the TTAB's interpretation of the statute to be correct and, beyond that, its action to be non-prejudicial:

The board is not required by the statute to grant oral argument in any case. There is no more reason for this court to mandate an oral argument in this case than in one where a request for argument was simply denied in the first instance. Bose advances no more than a technical claim of procedural error, without showing any harm. That in itself is sufficient reason to uphold . . .³⁷

Challenges to the Federal Circuit's original jurisdiction are both diverse and continuing.³⁸ Yet, this section can be concluded with brief consideration of *In re Alappat*,³⁹ where the Federal Circuit considered jurisdiction *sua sponte* and *en banc*⁴⁰ — despite challenge by neither PTO nor appellants.⁴¹

While the majority found that the court had jurisdiction,⁴² the real focus of attention was elsewhere. The challenged decision was the product of the Commissioner's "packing" a board following a decision he did not care for. His expanded panel, including himself, then reconsidered and reversed the original decision.⁴³

It is unclear what the dissenters had in mind.⁴⁴ Perhaps some thought that, if the Federal Circuit lacked jurisdiction, appellants would be forced to challenge the Commissioner's decision-making process in a district court. Where and how is discussed in the next part of the article, but it should be noted now that filing in the wrong court is not necessarily fatal — if the challenge is timely and at least facially meritorious. As mentioned above, 28 U.S.C. § 1631 may be used to avoid a loss of rights when jurisdiction is

³⁶ *Id.* at 869, 227 U.S.P.Q. at 3-4 (emphasis added).

³⁷ *Id.* at 870, 227 U.S.P.Q. at 4; *see also* the final clause of 5 U.S.C. § 706 (2000) ("due account shall be taken of the rule of prejudicial error").

³⁸ *See, e.g., Pep Boys v. Cherg Lian Ent. Co., Ltd.*, 215 F.3d 1342 (table), 1999 WL 595145 (Fed. Cir. 1999) (refusing to consider a challenge to a Commissioner's decision that refused to vacate a TTAB order concerning permissible grounds for opposition).

³⁹ 33 F.3d 1526, 31 U.S.P.Q.2d 1545 (Fed. Cir. 1994).

⁴⁰ *Id.* at 1526, 31 U.S.P.Q.2d at 1545.

⁴¹ *Id.* at 1530, 31 U.S.P.Q.2d at 1546.

⁴² *Id.* at 1532, 31 U.S.P.Q.2d at 1547.

⁴³ *Id.* at 1531, 31 U.S.P.Q.2d at 1546-47.

⁴⁴ *See, e.g., id.* at 1572, 31 U.S.P.Q.2d at 1580 (Mayer, J., dissenting) ("I do not agree that we have jurisdiction over this appeal. The Commissioner exceeded his statutory authority in convening a new, expanded panel to reconsider the board's original decision . . .").

misconstrued.

Although section 1631 seems not to have been used thus far to transfer a case from the Federal Circuit to a district court, the statute allows it. For example, in *Trustees for Alaska v. U.S. Dept. of Interior*,⁴⁵ when faced with a similar situation, the Ninth Circuit stated:

Trustees could have brought its petition to a district court Whenever a federal court finds that there is want of jurisdiction, it may, if it is in the interest of justice, transfer an action to a court in which the action could have been brought at the time it was filed. 28 U.S.C. § 1631. Such a transfer is warranted in this case, given the absence of a judicial interpretation of the relevant jurisdictional provision.⁴⁶

Still, it seems that the Federal Circuit did not do so in at least one case.⁴⁷ Unfortunately, the only reported account appears in a very brief First Circuit opinion.⁴⁸ From that, it seems that Robert Howitt filed a timely, but jurisdictionally-unsound, challenge in the Federal Circuit and, later, an untimely, but jurisdictionally-sound, complaint in the District of Massachusetts.⁴⁹ Under the peculiar circumstances presented there, the First Circuit refused to consider whether the Federal Circuit might have erred in dismissing rather than transferring Howitt's case:

We are aware of no legal authority that would permit one circuit to review another circuit's decision not to transfer. . . . Regardless, this is not an appropriate case to consider unusual procedural holdings Indeed, his case is sufficiently weak on the merits that we could not second guess a Federal Circuit determination that transfer was not 'in the interest of justice' even were we to possess the power to review that Howitt seeks to give us.⁵⁰

⁴⁵ 919 F.2d 119 (9th Cir. 1990).

⁴⁶ *Id.* at 123.

⁴⁷ *In re Howitt*, 818 F.2d 877 (Fed.Cir. 1987) (table); *cert. den. Howitt v. U.S. Dept. Commerce*, 484 U.S. 828 (1987).

⁴⁸ *Howitt v. U.S. Dept. Com.*, 897 F.2d 583 (1st Cir. 1990).

⁴⁹ *Id.*

⁵⁰ *Id.* at 584. *See also, In re Hengehold*, 440 F.2d at 1404, 169 U.S.P.Q. at 480.

In a similar vein, *see Duracell, Inc. v. ITC*, 778 F.2d 1578, 228 U.S.P.Q. 187 (Fed. Cir. 1985). The court found no jurisdiction to review an executive veto of an ITC exclusion. However, it nevertheless went on say: “[I]f our jurisdictional analysis is incorrect, in the interest of complete disposition should appellant be able to obtain further review, we conclude that Duracell's arguments with respect to the illegality of the President's disapproval must fail on the facts of this case.” *Id.* at 1581, 228 U.S.P.Q. at 188. That seems more efficient than transferring an unmeritorious claim to a district court for dismissal.

III. NONSTATUTORY REVIEW AND ITS LIMITS

In *In re James*,⁵¹ the CCPA cited the proper alternative to seeking original review in that Court,⁵² but that rarely occurs. Usually described as “nonstatutory,” alternatives encompass all default mechanisms that supplement more focused statutory review provisions.⁵³

That such review has long been available is illustrated by an 1884 challenge to the disposition of a priority dispute between inventors.⁵⁴ In a scenario somewhat reminiscent of *Alappat*,⁵⁵ a Commissioner’s decision in favor of one contestant was reviewed and reversed by the Secretary of Interior.⁵⁶ The original winner then challenged the Secretary’s authority and ultimately prevailed. While the patent statute explicitly allowed judicial review of Commissioner’s decisions, it was silent about Secretary’s decisions.⁵⁷ From that, the Supreme Court concluded that the Secretary’s decision was *ultra vires*. Regarding the remedy, the court stated that mandamus would lie against the Commissioner insofar as “he had fully exercised his judgment and discretion when he decided that the relators were entitled to a patent.”⁵⁸

The availability of generic judicial review of PTO decisions was reinforced twenty years later, when the Supreme Court also rejected a suggestion that some decisions might escape review for lack of explicit provisions.⁵⁹ After observing that a statutory appeal had been found to be

⁵¹ 432 F.2d 473, 167 U.S.P.Q. 403 (CCPA 1970).

⁵² *Id.* at 476, 167 U.S.P.Q. at 405.

⁵³ To the extent that such generic review is predicated on statutes, the term is oxymoronic. *See, e.g., Patlex Corp., Inc. v. Mossinghoff*, 585 F.Supp. 713, 716 n.2, 220 U.S.P.Q. 342, 345 n. 2 (E.D. Pa. 1983) (“This Court has jurisdiction over the subject matter of this action under 28 U.S.C. § 1331, 28 U.S.C. § 1338(a) and 28 U.S.C. § 2201. Venue is proper in this district under 28 U.S.C. § 1391(e)(4).”), *aff’d in part* 758 F.2d 594 (Fed. Cir. 1985), *aff’d in full on reh’g* 771 F.2d 480 (Fed. Cir. 1985). However, the term “nonstatutory” is commonly applied to such provisions; *see, e.g., Administrative Conference of the U.S., Federal Administrative Procedure Sourcebook*, 208 (2d ed. 1992).

⁵⁴ *Butterworth v. Hoe*, 112 U.S. 50 (1884).

⁵⁵ 33 F.3d 1526, 31 U.S.P.Q.2d1545 (Fed. Cir. 1994).

⁵⁶ *Butterworth*, 112 U.S. at 67-68. Today 35 U.S.C. § 1(a) (1994 & Supp. V 1999) locates the Office within the Department of Commerce, but there is no reason to believe that the outcome would differ.

⁵⁷ *Butterworth*, 112 U.S. at 68-69.

⁵⁸ *Id.* at 68.

⁵⁹ *Steinmetz v. Allen*, 192 U.S. 543 (1904).

improper, the Court said: “In the case at bar it is contended that mandamus is [improper]. One or the other must be [proper].”⁶⁰

That suggestion of presumptive judicial review was further reinforced by passage of the Administrative Procedure Act (“APA”) in 1946.⁶¹ Indeed, then-Commissioner Ooms predicted soon after enactment that the APA would “have the effect of minimizing the technical aspects of the review . . . and that courts [would] welcome the appellant . . . and not merely treat him as a suppliant”⁶²

Moreover, the idea of presumptive process review received a further boost in the 1970s. The apogee of PTO due-process review may be represented by George Cogar’s⁶³ attempt to prevent a patent from issuing in his name.⁶⁴ As recounted by the D.C. Circuit Court in the only reported opinion, Cogar petitioned to prevent or defer a patent from issuing in his name to his assignee, Sperry Rand.⁶⁵ He also later “submitted technical objections, along with a letter from counsel specifically requesting an interview with the examiner.”⁶⁶

A Deputy Commissioner, having found no basis in the statute or rules for his demands,⁶⁷ informed Cogar that his correspondence would be entered in the file but that no interview with the Examiner would be permitted.⁶⁸

Cogar then brought suit. The district court denied preliminary relief, but the circuit court temporarily restrained the patent from issuing and remanded.⁶⁹ After further consideration, the district court dismissed the complaint and lifted the restraint. When Cogar appealed again; the court stated:

⁶⁰ *Id.* at 564.

⁶¹ The APA was originally enacted by Pub. L. No. 404, 60 Stat. 237 Ch. 324 §§ 1-12 (1946). Its central provisions are now codified at 5 U.S.C. §§ 551-59 & 701-06 (2000).

⁶² Caspar W. Ooms, *The United States Patent Office and the Administrative Procedure Act*, 38 Trademark Rep. 149, 159 (1948) (text of a speech delivered in February 1947).

⁶³ The court described him as “a well-known technical expert and inventor.” *Cogar v. Schuyler*, 464 F.2d 747, 173 U.S.P.Q. 389 (D.C. Cir. 1972).

⁶⁴ *Id.* at 748, 173 U.S.P.Q. at 389.

⁶⁵ *Id.* at 748-49, 173 U.S.P.Q. at 389-90.

⁶⁶ *Id.* at 749, 173 U.S.P.Q. at 390.

⁶⁷ Demands that were, indeed, sharply at odds with the interests of Sperry Rand, the assignee-applicant.

⁶⁸ *Cogar*, 464 F.2d at 749, 173 U.S.P.Q. at 390.

⁶⁹ *Id.*, 173 U.S.P.Q. at 390.

Concluding that this novel problem falls somewhere between a case of “giant conceit”, as the trial court described it, and one warranting due process vindication, as contended by appellant, we affirm. . . . Yet we have found the questions raised to be substantial, to have warranted the careful consideration given to them and to require something more than perfunctory treatment here.⁷⁰

Regarding the last, the court cited two then-recent Supreme Court decisions.⁷¹ These may have induced the court to refuse to find the appeal moot and to regard Cogar’s interests as warranting what, in retrospect, seems to be a remarkable degree of attention:

Technical arguments were advanced . . . which in other context might have merit. But we do not think . . . that such *pendente lite* action . . . controlled by one party, should divert us from the exercise of the appellate jurisdiction clearly vested with reference to the constitutional claim.⁷²

In the final analysis, however, the court concluded that:

neither the statutory duties of the Patent Office nor the Due Process clause compelled the Commissioner of Patents to grant appellant a personal hearing or interview or the other procedures now demanded.⁷³

Cogar lost, but his suit was entertained — in part because he did not face the hurdle represented by the first sentence of the APA section 703:

The form of proceeding for judicial review is the *special statutory review* proceeding relevant to the subject matter in a court specified by statute or, in the absence or inadequacy thereof, any applicable form of legal action . . . in a court of competent jurisdiction.⁷⁴

While all agency action is presumptively reviewable,⁷⁵ barring a constitutional challenge to a review provision itself, statutory review trumps nonstatutory review. This is illustrated by the outcome of Richard Franchi’s challenge to the PTO’s refusal to award him a passing grade on the examination for registration to practice in patent cases.⁷⁶ Although the statute does not state that jurisdiction is exclusive, the Federal Circuit noted

⁷⁰ *Id.* at 748, 173 U.S.P.Q. at 389.

⁷¹ *Id.* at 755, 173 U.S.P.Q. at 394-95 (citing *Goldberg v. Kelly*, 397 U.S. 254 (1970) and *Richardson v. Perales*, 402 U.S. 389 (1971) which were compared and contrasted with each other and with Cogar’s circumstances).

⁷² *Id.* at 749 n. 4, 173 U.S.P.Q. at 390 n. 7. By then, the patent had issued.

⁷³ *Id.* at 756, 173 U.S.P.Q. at 395.

⁷⁴ 5 U.S.C. § 703 (2000) (emphasis added). See also 5 U.S.C. § 704 (2000) (“Agency action made reviewable by statute and *final* agency action for which there is no other adequate remedy in a court are subject to judicial review.”).

⁷⁵ See, e.g., *Citizens to Preserve Overton Park, Inc. v. Volpe*, 401 U.S. 402, 410 (1971).

⁷⁶ *Franchi v. Manbeck*, 972 F.2d 1283, 23 U.S.P.Q.2d 1847 (Fed. Cir. 1992).

that 35 U.S.C. § 32 stated:

The U.S. District Court for the District of Columbia, under such conditions and upon such proceedings as it by its rules determines, *may* review the action of the Commissioner upon the petition of the person so refused recognition or so suspended or excluded.⁷⁷

Franchi nevertheless filed in Connecticut⁷⁸ — perhaps because he missed a D.C. deadline.⁷⁹ Although, as stressed above in quoted language, section 32 suggests non-exclusive jurisdiction, the Connecticut District Court granted a PTO motion to dismiss.⁸⁰ When Franchi appealed, the case was transferred from the Second Circuit to the Federal Circuit.⁸¹ The Federal Circuit affirmed, holding that: “When Congress provides ‘an orderly administrative mechanism’ for review of agency action, that mechanism is to be respected.”⁸²

The primacy of statutory review is also illustrated by *Hitachi Metals, Ltd. v. Quigg*⁸³ that began when Allied-Signal (“Allied”) attempted to enforce a patent in an International Trade Commission (“ITC”) proceeding.⁸⁴ The ITC eventually found its patent unenforceable due to material misrepresentations, but Allied’s appeal was not considered on the merits because it was not timely.⁸⁵ Allied sought to cure defects in its patent by asking the PTO to reissue it.⁸⁶

⁷⁷ *Id.* at 1285, 23 U.S.P.Q. at 1850 (emphasis added).

⁷⁸ The court stated that Franchi’s request was apparently based in part on 28 U.S.C. § 1361 (1988) (Action to compel an officer of the United States to perform his duty): “The district courts shall have original jurisdiction of any action in the nature of mandamus to compel an officer or employee of the United States or any agency thereof to perform a duty owed to the plaintiff.” *Id.* at 1284 n. 1, 23 U.S.P.Q.2d at 1849.

⁷⁹ *Id.* at 1289, 23 U.S.P.Q.2d at 1853 (“This court will not aid an apparent attempt to avoid the deadlines imposed by the District of Columbia court . . .”). But for that, presumably the Connecticut court could have transferred the case directly to the D.C. district court.

⁸⁰ *Id.* at 1285, 23 U.S.P.Q.2d at 1850. *See also, e.g., Ramey*, 9 F.3d at 134 (stating that 31 U.S.C. § 755(a) provided that certain actions “may be reviewed by the . . . Federal Circuit,” but the D.C. Circuit found that language to contain “more than sufficient indicia of exclusivity.”).

⁸¹ *Franchi*, 972 F.2d at 1286, 23 U.S.P.Q.2d at 1850-51 (“the Second Circuit transferred the appeal to this court pursuant to 28 U.S.C. § 1631”).

⁸² *Id.* at 1288, 23 U.S.P.Q.2d at 1852 (citing *Califano v. Sanders*, 430 U.S. 99, 102 (1977)).

⁸³ 776 F. Supp. 3, 20 U.S.P.Q.2d 1920 (D.D.C. 1991).

⁸⁴ *Id.*, 20 U.S.P.Q.2d at 1922.

⁸⁵ *Id.*, 20 U.S.P.Q.2d at 1922.

⁸⁶ *Id.*, 20 U.S.P.Q.2d at 1922.

Apparently a target of the ITC proceeding, Hitachi Metals (“Hitachi”) challenged the reissue. It urged that Allied was collaterally estopped to pursue the reissue due to Allied’s material misrepresentations and that the PTO should, therefore, strike Allied’s reissue application.⁸⁷ Yet, Hitachi’s arguments were cut short when the Commissioner announced that the PTO would no longer consider, much less act on, prosecution fraud in accordance with an existing rule.⁸⁸

After Allied’s reissue patent was allowed, Hitachi filed suit. It questioned whether the PTO could change its policy by merely making an announcement.⁸⁹ Hitachi also questioned the PTO’s failure to apply its rule.⁹⁰

The court, however, granted the PTO motion to dismiss for lack of jurisdiction, saying that the Office had rebutted the presumptive reviewability of its actions with “fairly discernible” evidence that Congress intended third parties to have a limited role.⁹¹ Moreover, it said:

Although Congress precluded third-party protestors from seeking judicial review of PTO decisions, Congress explicitly provided for the redress of injuries such as those alleged by Hitachi by authorizing targets of infringement suits to raise the defense of patent invalidity in any infringement action brought against them or to bring an action for declaratory judgment against patent owners threatening them with an infringement suit.⁹²

Yet, even when jurisdiction is found, and other fundamental hurdles such as standing⁹³ and ripeness⁹⁴ are overcome, the merits remain.

⁸⁷ *Id.*, 20 U.S.P.Q.2d at 1922.

⁸⁸ *Id.* at 5-6, 20 U.S.P.Q.2d at 1922. *Compare Digital Equip. Corp. v. Diamond*, 653 F.2d 701 (1981) (refusing to uphold a PTO decision to strike a reissue application). *Digital* is discussed briefly below.

⁸⁹ *Id.* at 5, 20 U.S.P.Q.2d at 1922. Hitachi claimed, under 5 U.S.C. § 706 (scope of review), that the waiver of 37 C.F.R. § 1.56 violated 5 U.S.C. § 553 (informal rulemaking).

⁹⁰ *Id.*, 20 U.S.P.Q.2d at 1922. Hitachi claimed, under 5 U.S.C. § 706, that the Commissioner’s reissue of Allied’s patent violated 37 C.F.R. § 1.56 and exceeded the Commissioner’s authority under 35 U.S.C. § 251.

⁹¹ *Id.* at 7, 20 U.S.P.Q.2d at 1924. It also said “Even if the Court had subject matter jurisdiction over plaintiff’s suit, and the suit were reviewable under the APA, the Court would dismiss plaintiff’s claims due to plaintiff’s failure to satisfy the constitutional and prudential requirements for standing.” *Id.* at 10, 20 U.S.P.Q.2d at 1926.

⁹² *Id.* at 12 n. 18, 20 U.S.P.Q.2d at 1927 n. 18. *Compare Animal Legal Defense Fund v. Quigg*, 932 F.2d 920, 18 U.S.P.Q.2d 1677 (Fed. Cir. 1991), where parties denied standing would have little, if any, opportunity for collateral review.

⁹³ *See, e.g., Hitachi*, 776 F. Supp. at 10, 20 U.S.P.Q.2d at 1926.

⁹⁴ *See, e.g., Wembley, Inc. v. Commr. of Patents*, 352 F.2d 941 (D.C. Cir. 1965).

Nonstatutory challenges rarely succeed,⁹⁵ but that is true of PTO review generally.⁹⁶

In one of few successful nonstatutory challenges,⁹⁷ *Digital Equip. Corp. v. Diamond*,⁹⁸ Digital Equipment Corporation (“DEC”) upset a decision⁹⁹ following the type of PTO inquiry that Hitachi later sought to have continued.¹⁰⁰ Yet, success does not come easily. While the First Circuit ruled in DEC’s favor,¹⁰¹ the district court had not.¹⁰²

IV. THE FEDERAL CIRCUIT’S APPELLATE JURISDICTION

Beyond the original jurisdiction to review PTO decisions discussed

⁹⁵ Recent failures include, e.g., *Harley v. Lehman*, 981 F. Supp. 9, 11, 44 U.S.P.Q.2d 1699, 1701 (D.D.C. 1997) (withdrawing a patent from issue was “unusual but hardly unreasonable.”); *R.R. Donnelley & Sons Co. v. Dickinson*, 123 F. Supp. 2d 456, 461 (N.D. Ill. 2000) (refusing to require the PTO to accept a late fee).

⁹⁶ See, e.g., Fred E. McKelvey & Richard E. Schafer, *Appeals to the Federal Circuit from PTO*, 1120(2) Off. Gaz. Pat. Off. 22 (1990) (stating undifferentiated success of much less than 20%); see also Erica U. Bodwell, *Published and Unpublished Federal Circuit Patent Decisions: A Comparison*, 30 IDEA 233, 241 (1990) (stating about 20% had at least one claim allowed on statutory review).

⁹⁷ Other instances are discussed below: *Dubost v. U.S. Patent & Trademark Off.*, 225 U.S.P.Q. 713 (D.D.C. 1984), *rev’d* 777 F.2d 1561, 227 U.S.P.Q. 977 (Fed. Cir. 1985); *Athridge v. Quigg*, 655 F. Supp. 779 (D. D.C. 1987), *trans’d* 852 F.2d 621, 7 U.S.P.Q.2d 1577 (D.C. Cir. 1988), *dismissed* 889 F.2d 1098 (Fed. Cir. 1989); and *Merck & Co., Inc. v. Kessler*, 903 F. Supp. 964, 36 U.S.P.Q.2d 1727 (E.D. Va. 1995), *aff’d in part*, 80 F.3d 1543 (Fed. Cir. 1996). See also, *Patlex Corp. v. Mossinghoff*, 771 F.2d 480, 483, 226 U.S.P.Q.2d 985, 987 (Fed. Cir. 1996) (“Although administrative convenience must be considered, ‘administrative convenience or even necessity cannot override the constitutional requirements of due process.’”) (quoting *Cella v. U.S.*, 208 F.2d 783, 789 (7th Cir. 1953)).

⁹⁸ 653 F.2d 701, 210 U.S.P.Q. 521 (1st Cir. 1981).

⁹⁹ *Id.*, 210 U.S.P.Q. at 521.

¹⁰⁰ *Id.* at 703, 210 U.S.P.Q. at 527. See *Hitachi* discussion, *supra* n. 83.

¹⁰¹ *Id.* at 726, 210 U.S.P.Q. at 547. Despite stating that “As an initial matter, we are not persuaded that decisions of the Assistant Commissioner of Patents striking applications on grounds of fraud would not be appealable” *Id.* at 713, 210 U.S.P.Q. at 535. Had that been true, the district court apparently would have lacked jurisdiction. See, e.g., *Franchi*, *supra*, and 35 U.S.C. § 145 (1994 & Supp. 1999) (statutory district court review limited to D.C.).

¹⁰² In the district court, DEC argued that it was entitled to a hearing, but, relying in part on *Cogar*, discussed *supra* n. 46, the court ruled against it. *Digital Equip. Co. v. Parker*, 487 F. Supp. 1104, 1110-12 (D.Ma. 1980). DEC dropped its due process challenges. 653 F.2d at 714, 210 U.S.P.Q. at 536.

in part II, 28 U.S.C. § 1295(a)(4)(D) explicitly confers appellate jurisdiction over the same class of *patent* cases when initiated in D.C. District Court under 35 U.S.C. §§ 145 or 146.¹⁰³ Moreover, section 1295(a)(1)¹⁰⁴ confers exclusive appellate jurisdiction over *patent* suits¹⁰⁵ if original jurisdiction was based “in whole or in part” on 28 U.S.C. § 1338.¹⁰⁶

Patent infringement suits clearly fall within the ambit of section 1295(a)(1), but, beyond that, its reach has been debated. The first opportunity for the Federal Circuit to consider the matter seems to have been offered by Dominique Dubost’s challenge to a refusal to award him a patent application filing date for failure to sign a check.¹⁰⁷ The Federal Circuit briefly considered jurisdiction, although neither party had raised the issue.¹⁰⁸ Judge Newman dissented on the merits,¹⁰⁹ but, despite saying that the majority’s jurisdictional analysis “oversimplif[ie]d” the issue, she concurred on that point.¹¹⁰

The following year, when Stephen Wyden appealed in *Wyden v. Commissioner of Patents & Trademarks*¹¹¹ to vindicate a grievance identical to the one that later induced Franchi to sue,¹¹² however, the PTO Solicitor questioned jurisdiction. The Federal Circuit then addressed *en banc* whether it needed to transfer the appeal to the D.C. Circuit. Yet, ironically, and during the pendency of that appeal, the Department of Justice, in *Jaskiewicz*,

¹⁰³ See, e.g., *Fregeau v. Mossinghoff*, 776 F.2d 1034, 1035, 227 U.S.P.Q.2d 848, 849 (Fed. Cir. 1985) (review initiated under § 145); *Winner Intl. Royalty Corp. v. Wang*, 202 F.3d 1340, 1342, 53 U.S.P.Q.2d 1580, 1581 (Fed. Cir. 2000) (review initiated under § 146).

¹⁰⁴ 28 U.S.C. § 1295(a)(1). Confers exclusive appellate jurisdiction over final decisions of U.S. District Courts if their jurisdiction is based, at least in part, on 28 U.S.C. § 1338. While section 1338 includes both patent and trademark cases, section 1295(a)(1) exempts the latter.

¹⁰⁵ All appellate jurisdiction over trademark cases appears to be excluded. See, e.g., 28 U.S.C. § 1295(a)(4)(D). Although district court review of trademark appeals is also possible under 15 U.S.C. § 1071(b) (2000), the failure to reference such review is conspicuous. Also, both 28 U.S.C. § 1295(a)(1) and 15 U.S.C. § 1121(a) deny appellate jurisdiction over trademark suits commenced in district courts.

¹⁰⁶ See 28 U.S.C. § 1338(a) (1994 & Supp. V 1999).

¹⁰⁷ *Dubost v. U.S. Patent & Trademark Off.*, 777 F.2d 1561, 1532, 227 U.S.P.Q.2d 977, 977 (Fed. Cir. 1985).

¹⁰⁸ *Id.* at 1564-65, 227 U.S.P.Q.2d at 978-79.

¹⁰⁹ *Id.* at 1566, 227 U.S.P.Q.2d at 980.

¹¹⁰ *Id.* at 1568, 227 U.S.P.Q.2d at 982.

¹¹¹ 807 F.2d 934, 231 U.S.P.Q. 918 (Fed. Cir. 1986).

¹¹² See *Franchi v. Manbeck*, 972 F.2d 1283, 23 U.S.P.Q.2d 1847 (Fed. Cir. 1985).

had persuaded¹¹³ the D.C. Circuit that:

An action for review of a decision of the Commissioner . . . pursuant to 35 U.S.C. § 32 arises under an Act of Congress relating to patents. Therefore, jurisdiction in the District Court is based at least in part on 28 U.S.C. § 1338, and appellate review of that court's decision is granted exclusively to the Federal Circuit by 28 U.S.C. § 1295(a). Accordingly, pursuant to 28 U.S.C. § 1631, this case shall be transferred . . .¹¹⁴

That decision went far toward convincing the Federal Circuit that it had jurisdiction. Indeed, Judge Markey was the sole dissenter.¹¹⁵ His lively opinion challenged the idea of exclusive jurisdiction over appeals based on any connection with patents, however remote, and however unrelated to Congressional objectives. He said: “This is not a patent case, involves no patent, and deals only with administrative law.”¹¹⁶ He also noted that: “Neither the majority here nor the panel in *Jaskiewicz* points to any indication, in the legislative history or otherwise, that Congress had the slightest intent to place oversight of PTO administration exclusively in this court. Nor can they.”¹¹⁷

Still, had Judge Markey's view prevailed, it could have created an awkward dispute similar to one that arose between the Federal and Seventh Circuits two years later in *Christianson v. Colt Indus. Operating Corp.*¹¹⁸ Indeed, aside from that notable exception, the court seems not to have objected to any transfer related to PTO oversight or patent-related matters. While the Supreme Court ultimately agreed with the Federal Circuit's conclusion that the latter lacked jurisdiction over the case transferred by the Seventh Circuit, it ruled that “if the transferee court can find the transfer decision plausible, its jurisdictional inquiry is at an end.”¹¹⁹

That year, in *Athridge v. Quigg*,¹²⁰ Thomas Athridge, a government attorney who passed the PTO patent bar examination, was denied registration.¹²¹ When he challenged the underlying PTO rule on

¹¹³ *Wyden*, 807 F.2d at 936, 231 U.S.P.Q. at 919.

¹¹⁴ *Jaskiewicz v. Mossinghoff*, 802 F.2d 532, 536, 231 U.S.P.Q. 477, 481 (D.C. Cir 1986).

¹¹⁵ *Wyden*, 807 F.2d at 937, 231 U.S.P.Q. at 921.

¹¹⁶ *Id.* at 938, 231 U.S.P.Q. at 921 (emphasis in original).

¹¹⁷ *Id.*, 231 U.S.P.Q. at 922.

¹¹⁸ 486 U.S. 800, 818, 7 U.S.P.Q.2d 1109, 1117 (1988) (stating that the Federal Circuit erred, despite initial objection, in accepting transfer of an antitrust case from the Seventh Circuit).

¹¹⁹ *Id.* at 818-19, 7 U.S.P.Q.2d at 1117.

¹²⁰ 655 F. Supp. 779, 3 U.S.P.Q.2d 1391 (D.D.C. 1987).

¹²¹ *Id.* at 779-80, 3 U.S.P.Q.2d at 1391-92.

constitutional and related grounds, the district court concluded: “that defendants acted arbitrarily and capriciously when they denied plaintiff registration solely because he was employed by the government” and found the rule in question not to “rationally relate to justifiable considerations.”¹²²

Because he did not receive everything he sought, Athridge appealed to the D.C. Circuit.¹²³ Despite his protest, that court, however, transferred the case, saying: “The distinctions cited by Athridge between his case and those of Jaskiewicz and Wyden do not require a different result. We hold that the Federal Circuit, not this court, has jurisdiction over this appeal”¹²⁴

Yet, Judge Robinson cautioned:

Though I would not reach the jurisdictional question, I must voice my uneasiness I have serious reservations as to whether a claim that turns on an interpretation of 18 U.S.C. §§ 203, 205 (1982), which are conflict-of-interests provisions, is based in whole or in part upon 28 U.S.C. § 1338, which concerns federal jurisdiction over patent cases. . . . Delineation of the precise boundaries of § 1338 and the corresponding boundaries of 28 U.S.C. § 1295(a)(1) . . . , is a complex and delicate endeavor that is ill-served by cursory treatment.¹²⁵

More recently, several political-action groups sued in California alleging that the Commissioner failed to satisfy APA rulemaking requirements by making an announcement concerning the patentability of living organisms.¹²⁶ After their complaint was dismissed and their Ninth Circuit appeal was transferred, the Federal Circuit stated:

The parties do not dispute here the legality of the Ninth Circuit’s transfer and do not question whether a suit seeking compliance with the APA notice and comment provisions in administering the patent laws is a suit “arising under” the patent laws in accordance with 28 U.S.C. § 1338(a). . . . The case having been transferred. . . , we do not address this issue ourselves, as we are wary of the Supreme Court’s recent admonition against circuit courts playing ping pong with an appeal.¹²⁷

¹²² *Id.* at 782, 3 U.S.P.Q.2d at 1393.

¹²³ 852 F.2d 621, 623, 7 U.S.P.Q.2d 1577, 1578 (D. C. Cir. 1988).

¹²⁴ *Athridge*, 852 F.2d at 623, 7 U.S.P.Q.2d at 1578..

¹²⁵ *Id.* at 625 n. 18, 7 U.S.P.Q.2d at 1580 n. 18 (dissenting on the basis of mootness). *See also, In re Thomas P. Athridge, Jr.*, 4 U.S.P.Q.2d 1656 (Com’r 1987). This is apt to account for eventual dismissal of the appeal. *Athridge v. Quigg*, 889 F.2d 1098 (Fed.Cir. 1989) (table).

¹²⁶ *Animal Legal Def. Fund v. Quigg*, 710 F. Supp. 728, 729, 9 U.S.P.Q.2d 1816, 1816 (N.D. Cal. 1989).

¹²⁷ *Animal Legal Def. Fund v. Quigg*, 932 F.2d 920, 924 n. 5, 18 U.S.P.Q.2d 1677, 1681 n. 5 (Fed. Cir. 1991) (citations omitted).

Finally, and most recently, an appeal¹²⁸ was taken from a Virginia district court.¹²⁹ The suit challenged PTO interpretations of 35 U.S.C. §§ 154 and 156, but the primary target was the FDA that had relied on them.¹³⁰ While the district court was reversed in part based on a different reading of the statutes in question, the Federal Circuit agreed that the PTO lacked authority to make an authoritative interpretation.¹³¹

Neither decision explicitly treated jurisdiction as it has been discussed here. Although the district court's opinion centers on the amount of deference due to the PTO's views, suggesting that APA provisions were considered, it does not mention jurisdiction.¹³² Also, while the Federal Circuit had a short discussion entitled "jurisdiction," it refers to ripeness, not to section 1295.¹³³

V. SUMMARY AND RECOMMENDATIONS

As discussed in part II, the Federal Circuit has original jurisdiction over a finite set of challenges to the PTO. Limits have been debated within the court and its predecessor, but debate has not clarified them.¹³⁴ Moreover, given lack of jurisdiction despite seemingly unambiguous statutory language, in one instance,¹³⁵ it would be surprising if jurisdictional boundaries did not continue to confound.

At least where a challenge has facial merit and confusion is justifiable, the court will presumably transfer to a more appropriate forum.¹³⁶ Where confusion is less justifiable, the PTO could be more helpful. That its

¹²⁸ *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543, 38 U.S.P.Q.2d 1347 (Fed. Cir. 1996) [hereinafter *Merck II*].

¹²⁹ *Merck & Co., Inc. v. Kessler*, 903 F. Supp. 964, 36 U.S.P.Q.2d 1727 (E.D. Va. 1995) [hereinafter *Merck I*].

¹³⁰ *Merck II*, 80 F.3d at 1543, 38 U.S.P.Q.2d at 1347.

¹³¹ *Id.* at 1549-50, 38 U.S.P.Q.2d at 1351-52.

¹³² *Merck I*, 903 F. Supp. At 966, 36 U.S.P.Q.2d at 1729 ("A substantial portion of the defendants' brief is directed to the deference owed an agency's determination. In the court's view, this is not an issue in the case. Resolution of what the court perceives to be the issues involved here is a straightforward matter of statutory interpretation.").

¹³³ *Merck II*, 80 F.3d at 1549, 38 U.S.P.Q.2d at 1351 ("Upon review of all of the circumstances, we hold that the constitutional limitation on review is satisfied.").

¹³⁴ See, e.g., *supra* nn. 25-28, 30-31 (discussing *Haas*).

¹³⁵ See *supra* nn. 10-13, 15-16 (discussing *Marriott*).

¹³⁶ See *supra* nn. 45-46 (discussing *Trustees for Alaska*).

rules address *statutory* review¹³⁷ but ignore *nonstatutory* review may, itself, mislead. In any case, it is difficult to understand why the situation continues.¹³⁸ It seems at best inefficient for the PTO to point out nonstatutory alternatives only after challenges have been inappropriately filed.¹³⁹

Where statutory limits are less clear, wary parties may file in district court. The D.C. District Court has both statutory and nonstatutory jurisdiction over challenges to PTO *patent* decisions.¹⁴⁰ Moreover, all district courts usually have both statutory and nonstatutory jurisdiction over challenges to PTO *trademark* decisions.¹⁴¹ Any of those courts should also have general jurisdiction to entertain constitutional challenges or conduct APA review.¹⁴²

As discussed in part III, one type of statutory review, as well as all constitutional and APA review of PTO patent decisions, must — begin in district court. Yet, as discussed in part V, all appeals thus far in such cases seem to have gone to the Federal Circuit directly or by transfer. The need to make future transfers could be avoided by amending 28 U.S.C. § 1295. It should provide explicitly that the Federal Circuit has appellate jurisdiction over 35 U.S.C. § 32 appeals as well as over all forms of nonstatutory PTO patent review.

Last, original Federal Circuit jurisdiction to review *all* PTO action, whether involving patents or trademarks, should be seriously considered. When introducing new evidence is impossible or unwarranted,¹⁴³ little seems

¹³⁷ See, e.g., 37 C.F.R. §§ 1.301-304 (2001) (patent review) & § 2.145 (2001) (trademark review).

¹³⁸ No references were found to “5 U.S.C. § 706” in these Westlaw databases: FIP-CFR (rules), FIP-MPEP (Patent Examiners’ manual), FIP-TMEP (Trademark Examiners’ manual) or FIP-PTO (intramural decisions).

¹³⁹ See *In re James*, 432 F.2d 473, 476, 167 U.S.P.Q. 403, 405 (CCPA 1970); see also *In re Hengehold*, 440 F.2d 1395, 1404, 169 U.S.P.Q. 473, 480 (CCPA 1971).

¹⁴⁰ See 35 U.S.C. §§ 145, 146 (1994 & Supp. V. 1999).

¹⁴¹ See 15 U.S.C. § 1071(b) (2000).

¹⁴² See 28 U.S.C. § 1331 (1994 & Supp. V 1999). see also, e.g., *Patlex Corp. v. Mossinghoff*, 585 F. Supp. 213, 216 n. 2, 220 U.S.P.Q. 342, 345 n. 2 (E.D. Pa. 1983).

¹⁴³ In that regard, it is important to distinguish constitutional and APA challenges. See, e.g., *Rydeen v. Quigg*, 748 F. Supp. 900, 906, 16 U.S.P.Q.2d 1876, 1881 (D. D.C. 1990), *aff’d* 937 F.2d 623 (Fed. Cir. 1991) (“When reviewing constitutional challenges to agency decisionmaking, courts make an independent assessment of the facts and the law.”). However, aside from the limited circumstances when *de novo* review may be available, APA review rests on the record before the agency. *Id.* at 903-04, 16 U.S.P.Q.2d at 1879.

Also, where trademark registrations are concerned, any constitutional rights are at best thin. See, e.g., *In re McGinley*, 660 F.2d 481, 484, 211 U.S.P.Q. 668, 672 (CCPA 1981)

to be accomplished by *requiring* parties to file in district court. If original jurisdiction over statutory challenges does not burden the court, it is difficult to see how original jurisdiction over the less frequent challenges discussed in part III would.

It is not, however, recommended that the Federal Circuit's jurisdiction be exclusive; parties who wish to file in district court for whatever reason should have that option. Rather, challengers should have the choices they now have for most statutory review. That would give the court jurisdiction over trademark challenges that cannot now reach it directly or on appeal. Expanded jurisdiction could be useful because it might help the court develop an administrative jurisprudence that reflects the full spectrum of PTO responsibilities.

Concern about standards of review instead of jurisdiction as such might motivate the PTO to object.¹⁴⁴ If so, it should consider the extent to which that concern could be offset by possibly having more control of its destiny. The Department of Justice controls,¹⁴⁵ but it seems to exert its influence more in cases filed in district courts¹⁴⁶ than those filed in the Federal Circuit.¹⁴⁷

(“There is, of course, a limited statutory right to registration, which carries certain benefits. Although, as appellant notes, these are more procedural than substantive, that right cannot be denied without compliance with Fifth Amendment due process requirements.”) *But see In re International Flavors & Fragrances Inc.*, 183 F.3d 1361, 1368, 51 U.S.P.Q.2d 1513, 1518 (Fed. Cir. 1999) (“There is no constitutionally protected right to federal registration of any mark.”).

¹⁴⁴ *See, e.g., Dubost v. U.S. Patent & Trademark Off.*, 777 F.2d 1561, 227 U.S.P.Q. 977 (Fed. Cir. 1985) (vacating the final decision of the District Court of the District of Columbia which denied a filing date). *See DEC, supra*, at n. 98; *see also, supra*, n. 30-31. Courts of appeal may be less deferential.

¹⁴⁵ 28 U.S.C. § 516 (1994) (“Except as otherwise authorized by law, the conduct of litigation in which the United States, an agency, or officer thereof is a party, or is interested . . . is reserved to officers of the Department of Justice . . .”). Nothing has been found to provide otherwise.

¹⁴⁶ *See supra* text accompanying nn. 111-17 (discussing *Wyden* and *Jaskiewicz*).

¹⁴⁷ *But see In re Zurko*, 142 F.3d 1447, 1449 n. 2, 96 U.S.P.Q.2d 1691, 1693 n. 2 (Fed. Cir. 1998). Only after the court agreed to rehear *en banc* was it argued, apparently at the behest of the Department of Justice, that 5 U.S.C. § 706(2)(E) (2000) rather than § 706(2)(A) (2000) furnishes the proper standard of review.

See also Ramey v. Boshner, 9 F.3d 133, 134 n. 1 (D.C. Cir. 1993). As mentioned there, the Board's General Counsel (the apparent equivalent of the PTO Solicitor) filed an amicus brief supporting the appellant.