

# The Trademark Reporter®

## TTAB DELAY: A “QUALITATIVE” VIEW

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### I. INTRODUCTION

John M. Murphy’s article, “Playing the Numbers: A Quantitative Look at Section 2(d) Cases Before The Trademark Trial and Appeal Board,”<sup>1</sup> reveals some causes of the frustrations many of us have felt litigating Board proceedings, and does so in a cooler, more analytical manner than we sometimes choose to vent those frustrations. Trademark Trial and Appeal Board (TTAB or “Board”) litigation often takes longer than it could or should. Final decision time from filing of a Notice of Opposition or Petition to Cancel in Murphy’s sample of 67 Board cases ranges from 216 days (good) to 18.2 years (far past sublime). Median resolution time was 3.2 years, with about 60% of the cases taking more than three years and 22% taking more than four.<sup>2</sup> Many of the delays in the present Board system are unnecessary, and it is still true that “waiting justice sleeps.”<sup>3</sup>

TTAB delay is a serious problem for the trademark system in the United States. The earliest adjudication of *inter partes* proceedings consistent with achieving a just result should be a very high priority of the Board, those who practice before it and the entire United States trademark community.<sup>4</sup> This problem is

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1. 94 TMR 800 (2004), hereinafter, “Murphy.”

2. *Id.* at 801-02.

3. J.G. Holland, *The Day’s Demand*—according to Bartlett, *Familiar Quotations* (13th ed. 1955).

4. This is not to suggest that those who create delay are necessarily blameworthy. An attorney’s first duty is to his or her client, not to the overall efficacy of the U.S. trademark system. When a client’s best interest is to delay, the attorney representing that client is obliged to seek such delay as is available and ethical to pursue. This article is written as a concerned observer of the trademark system. As an advocate of clients’ interests, however, the author believes he is obligated to take the system as it exists, and to operate within it to pursue the interests of his clients ethically and most effectively. That can occasion, and has occasioned, delay that, as a concerned observer, the author deplors.

of particular concern with respect to Intent-to-Use (ITU) applications, for two reasons:

*First*, when they were introduced in 1989, ITU applications were intended to afford trademark applicants an opportunity to pre-clear their rights before using new marks. If an ITU application is opposed, however, the opposer—with determination, a modicum of imagination, an almost-clear conscience and even the flimsiest of claims—can easily delay that day of approval four or more years from the publication date.<sup>5</sup> “Clearance” to use after five years or more (it takes a year or so to get from application to the point a mark may be opposed) negates any meaningful notion of pre-clearance of a mark. Five years is a long time in the marketplace—indeed, in the videogame and some other marketplaces, it can be a few product generations.

*Second*, another major facet of the ITU regime is the award of constructive priority as of the application filing date upon issuance of a registration from such an application. Once a notice of allowance is issued, the applicant has three years in which to make commercial use of its mark or, in effect, abandon it. That is a long time for another entity that might like to use a similar (or the same) mark to wait to find out if it may do so. Adding even more years of delay occasioned by unnecessarily lengthy oppositions exacerbates the problem by effectively allowing applicants to “reserve,” or at least appear to “reserve,” marks for the better part of a decade. That, of course, is anti-competitive in the sense that the mark, when searched, will appear to be off limits for far too long.

The case against undue delay in cases of cancellation proceedings against registrations resulting from, and oppositions to, use-based applications is less compelling for three reasons: (1) the prejudice occasioned by delay is more often confined to the parties; (2) at least in the case of possibly confusing marks, there often is recourse to court litigation with the possibility of interim

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5. For those who have not yet figured it out: the statute gives 120 days from publication to oppose, sixty essentially for the asking, another sixty upon consent (often not difficult to obtain if one hints at possible settlement); after the filing of the Notice, there is a delay to institute the proceedings (usually a few days, although paper filing can gain an extra week or two); if all goes as scheduled, the matter will be ripe for decision in 490 days unless one party requests oral argument (this can delay matters as much as six months, in the author’s recent experience); motions to dismiss, compel (or resist) discovery and for summary judgment result in suspensions of proceedings; written decisions on such motions (from which both reconsideration and appeal to the Commissioner are possible, albeit very rarely successful) usually take at least a few weeks, and have been known to take a few months (or even more in the case of summary judgment); final decision also can take a few months or more. This list does not even include such relatively esoteric means of delay as requests to remand to the Examiner or motions to disqualify or sanction opposing counsel (or even to disqualify Board members for interest or bias).

relief—at a pretty price, to be sure; and (3) registration in those cases conveys no priority that the common law does not.<sup>6</sup>

This essay addresses four identified causes of TTAB delay: (1) parties stipulating to seemingly endless extensions and suspensions; (2) the TTAB's opting-out of several federal rules for case management; (3) a culture to which case management is alien; and (4) seemingly unnecessary delays in the decisional process. Under each category, certain possibilities for reform will be identified and discussed. This is not intended to be a blueprint for Board future practice. It is intended to propose a tentative agenda of possible changes in Board practice for consideration and discussion.

## II. "QUALITATIVE" ANALYSIS

In the social "sciences," there are two kinds of research—quantitative and qualitative. Quantitative is statistical. Qualitative may be a misnomer, but, as represented in its most frequently-seen form, the focus group, it consists of an amalgam of anecdotal events, perceptions and individual opinions, the meaning (if any) of which is usually discerned (or invented) in a written analysis. Both have their uses, and marketers often use both to address issues of serious concern. Murphy provided a quantitative analysis of TTAB *inter partes* litigation. This essay offers a qualitative one.

"Qualitative" research by its very nature is limited by the experience and perspective of the individual research subjects. It is doubtful that anyone outside the Board has the breadth of experience and access to information to know what really is happening. Those of us who practice before the TTAB see only pieces of the puzzle, and it will take many more pieces than any of us possess before the total picture begins to appear.

By the same token, however, those of us who have a practice that encompasses litigation in federal (or state) courts have been exposed to systems and adjudicatory cultures it is believed most TTAB members have not. There is much in Board practice—civility, modesty, respect for attorneys and genuine desire to get everything "right"—that commend themselves to many courtrooms. Board members, individually, are friendly, approachable and helpful. We should change no more of that more than is absolutely necessary, which, fortunately, seems to be very little.

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6. That, at least, is the theory. While the reality is somewhat more subtle and complex, the theory is generally correct.

### III. BILATERAL EXTENSIONS AND SUSPENSIONS

Murphy attributes some of the length of TTAB proceedings to the Board's willingness to grant virtually whatever extensions of time or suspensions upon which the parties mutually agree. The Board may be of the view that if the parties jointly do not care when, if ever, a matter gets decided, there is no reason to prod them on to a faster track when both the effort of prodding and the act of deciding will delay matters for other parties earnestly desiring early resolution.

That reasoning can be questioned. Most such suspensions are obtained to pursue settlement negotiations, and the author's experience is that settlement frequently is reached, although often it is pursued sporadically over a period that can exceed a year. Mutually-agreed upon settlement suspensions are universally granted—and have been ordered *sua sponte* by the Board—in increments of six months. But proceedings are not resumed until the Board issues an order resuming them, and the Board's taking of that action is often anything but prompt.

Similarly, extensions of the close of discovery, of periods to take testimony, and of filing dates for briefs are granted routinely upon consent. While eventually there comes a time when the Board attaches final limits to the extensions, that time can be as long as a year in coming. It is the author's observation that most such delay is occasioned by attorneys and clients attaching a low priority to moving Board proceedings, buttressed by the belief that there is no need to do so.

The reason the Board should scrutinize requests for extensions and suspensions is that people other than the parties—third parties desiring to adopt the opposed mark, for example, and the public in general—have interests that are prejudiced by delay. While the need to eliminate that damage by delay seems less urgent than the need to resolve issues between contesting parties, at least one of which wants early resolution, there are simple steps that can be taken to discourage the present practice. Among those that could be considered are:

1. Require fees for stipulated extensions of time or suspensions. Putting proceedings in and out of suspension has administrative costs; those desiring the accommodation should pay that cost and perhaps a bit more.

2. Suspend proceedings to allow for settlement negotiations in no more than sixty day increments.

3. Cap the number of suspensions to negotiate settlement at a finite number (such as one—there is rarely any good reason why parties cannot settle a matter in sixty days, if they are going to), and set similar ceilings (for example, thirty days) on extensions of time and discovery periods (sixty days might be appropriate).

4. More time probably should be allowed upon a truly compelling showing of hardship, and of diligent effort to complete the task before the deadline, but the presumption should be against such further extension.

5. The Board would have to implement a mechanism for ruling on these matters promptly. Step one would be to require electronic submission of all such requests. Another suggestion will be noted below.

#### IV. THE UNUTILIZED FEDERAL RULES

Absent provision to the contrary, Board practice and procedure in *inter partes* proceedings is, “whenever applicable and appropriate . . . governed by the Federal Rules of Civil Procedure.”<sup>7</sup> However, “[t]he provisions of the Federal Rules of Civil Procedure relating to automatic disclosure, scheduling conferences, conferences to discuss settlement and to develop a discovery plan, and the transmission to the court of a written report outlining the discovery plan” do not apply to Board *inter partes* proceedings.<sup>8</sup>

The Federal Rules are binding only on federal courts; the Board is not required to adopt them. It has done so, presumably because it views the Federal Rules as a wise resolution of many procedural questions. When the Federal Rules were amended in 1993, however, the Board “opted out” of many of the amendments (as did some district courts, at least in part). The Federal Rules not applicable in Board proceedings, which are discussed in turn below, are amended Rules 16(b), 26(a)(1)-(4), 26(b)(4), 26(d) [first sentence], 26(e)(1), 26(f), 26(g)(1), 30(a)(2)(C), 33(b) [last sentence, first paragraph], 33(a) [last sentence], 34(b) [last sentence, first paragraph], 36(a) [last sentence, first paragraph], 37(a)(2)(A), 37(c)(1) and 37(g).<sup>9</sup>

After more than a decade of practical judicial experience with the new rules—and of Board experience without them—it is worth considering anew the currently inapplicable Federal Rules to assess whether they offer Board practice some benefits that were not perceived the first time around.

*Rule 16(b)* is the crux. It requires the trial court judge or magistrate judge to hold an early scheduling and planning pretrial conference. Mandatory subjects at that conference include limiting the time to: join other parties (not a frequent occurrence in Board proceedings), amend pleadings, file motions and complete discovery. In contrast, present Board practice follows a “one size

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7. Trademark Rule of Practice [37 C.F.R. §] 2.116(a).

8. *Id.* at § 2.120(a).

9. TBMP § 401.

fits all” philosophy of setting completion of discovery at 180 days from mailing the initial scheduling order,<sup>10</sup> and follows a lockstep timetable thereafter for completing proceedings, at least in theory.

On the surface, the Rule 16(b) conference appears to have little to offer since the Board’s scheduling order seems to supplant the need for one. But there is more here than meets the eye. Case management in Board proceedings is left largely to the parties. They are free to make motions whenever they choose.

The effect of that practice is plain. Every potentially dispositive motion<sup>11</sup> results in a suspension of all activity in the proceeding (other than litigating the motion) until it is resolved.<sup>12</sup> Potentially dispositive motions normally are dealt with by a three-member Board panel.<sup>13</sup> If the panels act no more rapidly than they do in deciding the cases sampled by Murphy, an average 224 days from the close of briefing<sup>14</sup>—which itself can consume another two or three months or more—this results in significant delay, particularly if the outcome is not dispositive (that is, if the motion is denied).

While potentially dispositive motions are perhaps the most time-consuming, discovery motions can consume months—particularly if they elicit cross-motions that invite more retaliatory motions. Experience and common sense suggest that cases take longer if parties make more motions, dispositive or non-dispositive.

There is a way to minimize the delays inherent in TTAB motion practice, a method that is tested and proven. Some of the more effective federal court judges have found that taking control of motion practice at its onset can eliminate, or at least minimize, much such delay. Either at an initial scheduling conference or by their own individual rules, a number of judges forbid motions, or even stipulated adjournments or suspensions, without first having a pre-motion conference at which one party proposes the motion and the other responds. That process affords the following opportunities for streamlining the motion procedure:

1. The parties can often reach a compromise as a result of mediation by the judge or other officiant.
2. The officiating person can sometimes dissuade parties from making futile motions, or at least narrow the issues to be decided by motion.

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10. Trademark Rule of Practice [37 C.F.R. §] 2.120(a).

11. Potentially dispositive motions are motions to dismiss for failure to state a claim for relief under Fed. R. Civ. P. 12(b)(6), motions for judgment on the pleadings under Fed. R. Civ. P. 12(c), and motions for summary judgment pursuant to Fed. R. Civ. P. 56.

12. Trademark Rule of Practice [37 C.F.R. §] 2.127(d).

13. TBMP § 502.04.

14. Murphy, 94 TMR at 802.

3. If the motion is inevitable, the officiant can set briefing schedules and page limits that will result in considerably expedited disposition of the motion. Not every motion requires fifteen days to make, to answer and to reply; nor do most motions require 25 pages to brief.<sup>15</sup> Nor does every case necessarily require six months of discovery.

The dispositive motion illustrates how effective such management could be.

Current practice is to submit each potentially dispositive motion to a panel of three Board members.<sup>16</sup> It is probably reasonable, although not mandated by statute, to have a panel of three make final rulings in opposition and cancellation proceedings, which, of course, includes granting dispositive motions. But it seems that only a small minority of potentially dispositive motions turns out to be dispositive. As Murphy points out,<sup>17</sup> summary judgment was denied in the cases sampled in 2003 more than 80 percent of the time.<sup>18</sup> Furthermore, judgments dismissing for failure to state a claim or on the pleadings are frequently granted with a right to replead, which means that such judgments are necessarily non-final.

The author's experience suggests that many motions for potentially dispositive relief are ill-conceived because many Board litigants either fail to grasp the essentials of the motions, or seek delay at any cost. The test for a motion to dismiss is whether, taking all the averments of the complaint as true, some claim for actionable relief has been stated. That critical allegations may be proven false or that there will be insufficient evidence to support the claim are irrelevant to the motion. If the case as stated somehow justifies relief, a claim has been pled. In this era of "notice pleading," it is fairly difficult not to state a claim. Judgment on the pleadings is so difficult to obtain that one rarely sees such a motion. In summary judgment motions, the search is for a disputed fact that might change the outcome—which often is not very difficult to find. Summary judgment motions frequently fail because trademark cases normally are intensely factual, and

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15. Trademark Rule of Practice [37 C.F.R. § ] 2.127(a) allows 25 pages for briefing and opposing a motion, ten pages for reply. There are attorneys who will use all pages available to argue anything. Overlong briefs waste the adversary's and decision-maker's time.

16. TBMP § 502.04.

17. Murphy, 94 TMR at 802-03.

18. It's hard to know what to make of this statistic. If it is attributable to the Board's attempting to follow the law declared by the Federal Circuit Court of Appeals (*see* Murphy, 94 TMR at 802-03), it is as unfortunate as is that law, but obviously beyond the power of the Board to correct, no matter how unwise. If it is attributable to the high percentage of ill-conceived motions for summary judgment, the result seems sound, but the expenditure of effort excessive.

the most critical facts are usually disputed. So, many potentially dispositive motions are non-starters.

It does not take three Board members, or even one, to weed out these obvious losing motions. An interlocutory attorney well-grounded in the legal bases for the motions should spot them rather quickly. Under present practice, however, seriously flawed potentially dispositive motions may be filed freely, and demand response (often requiring more than the thirty allocated days to prepare, in the case of summary judgment),<sup>19</sup> meaning an average delay of several months per motion.

The Rule 16(b) conference will not, in and of itself, impose responsible case management, but it is a start, and it is difficult to conceive of an effective case management system without an early conference. Rule 16(b) is the initial step for establishing case management. The pre-motion conference model has proven itself repeatedly in those federal courts that embrace it and handle it efficiently. It should expedite many Board proceedings significantly.

*Rule 26(a)(1)-(4), Rules 26(b)(4), 26(g)(1), 37(a)(2)(A) and 37(c)(1)* generally provide for “initial disclosure,” “disclosure of expert testimony” and “pretrial disclosure.” They are generally geared to more complex litigations than Board proceedings, and, as such, certainly do not merit automatic adoption for Board proceedings. For example, identifying “each individual likely to have discoverable information that the disclosing party may use to support its claims or defenses . . .”<sup>20</sup> may be excessive for a Board proceeding, particularly if likelihood of confusion or secondary meaning is an issue.<sup>21</sup>

Nevertheless, Board jurisdiction being as limited as it is, certain subjects arise repeatedly, and certain mandatory disclosures on such issues should be considered. To list a few possible examples: the file wrapper of any registration pled and relied upon by the party; annual sales in units and dollars over the last five years of any mark pled to be owned or used by a party, or to be strong, have acquired secondary meaning or to be famous; specimens of advertising and trademark use; and all known dictionary, press or other generic uses of a term pled to be generic. The subjects and specifics should be carefully considered, but

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19. 37 C.F.R. § 2.127(c)(1).

20. Fed. R. Civ. P. 26(a)(1)(A).

21. That is because thousands, even millions, of people may have evidence of secondary meaning and likelihood of confusion (as long as actual confusion is a factor). While only a tiny slice of those people is likely to be identifiable, that still may comprise a lot of people. This is not to suggest that the rule is less burdensome in court litigations, which are not the subject of this article. The only point is that something a bit less burdensome at the outset might be appropriate for Board proceedings.

certain specified matters of mandatory disclosure well might expedite discovery.

One benefit of mandatory, limited disclosure could be lessening reliance on interrogatories for discovery. At least one district court has eliminated all interrogatories other than those seeking names of witnesses and computation of damage.<sup>22</sup> There is no doubt that in trademark cases interrogatories can be by far the most efficient means of obtaining certain kinds of information, such as sales under a mark, and of ferreting out contentions. The Trademark Rules, however, permit interrogatories numbering up to “seventy-five, counting subparts,”<sup>23</sup> and the Board has developed elaborate protocols for counting the subparts,<sup>24</sup> obviously a bad omen. Indeed, the Board’s interrogatory practice is contentious and easily lends itself to harassment. Making certain disclosures compulsory, while drastically reducing the number of permitted interrogatories, offers some promise for streamlining discovery.

Expert disclosure is not required, or even permitted, at present. “A party need not, in advance of trial, specify in detail the evidence it intends to present, or identify the witnesses it intends to call, except that the names of expert witnesses intended to be called are discoverable.”<sup>25</sup> That can put the party not calling the witness at a significant disadvantage when testimony is taken; requiring disclosure of an expert’s identity and production of any report thirty days in advance would seem reasonable.<sup>26</sup>

The remaining unutilized Federal Rules<sup>27</sup> govern various aspects of the process by which federal litigants confer, submit reports and generally allow discovery only after the adoption of a discovery plan. The process has some virtue in exceedingly complex cases, which are rare before the TTAB. More often than not, they would appear to be dilatory in Board proceedings (as they can be in court cases). The Board now permits discovery upon its notification that a proceeding has been commenced, and there seems to be no compelling reason for changing that process.

Murphy makes several astute observations about what are decisive issues. The bottom line is that it appears that many TTAB cases are over-litigated, given the relative simplicity of the issues

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22. Local Civil Rule 33.3, Southern District of New York.

23. Trademark Rule of Practice [37 C.F.R. §] 2.120(d)(1).

24. TBMP § 405.03(d).

25. TBMP § 414(7).

26. Discovery of the expert normally should not be necessary. Board testimony is taken by deposition, and the Board reviews the testimonial transcript (not even videos of the testimony can be submitted for review). Without a jury, or a “live” trial, many of the objections to, in effect, deposing the expert in “trial testimony” subside.

27. Rules 26(d)(1), 26(f), 26(g)(1), 30(a)(2)(C), 33(a) [last sentence], 34(b) [last sentence, first paragraph], 36(a) [last sentence, first paragraph], 37(a)(2)(A) and 37(c)(1).

that are most frequently decisive.<sup>28</sup> Experience suggests that the appearance is the reality. Many attorneys over litigate everything, including five-minute breaks. That is what lawyers do—at least a lot of them.

The thesis of this section is that the most efficient means to expedite Board proceedings would be to adopt case management; case management starts, but does not end, with an early conference devoted to the subject. Provisions that could be considered and implemented in any pretrial management order resulting from such a conference include: (1) adjusting discovery cutoff dates; (2) directing that no motion whatever be filed without a pre-motion, telephonic conference;<sup>29</sup> (3) directing that any party wishing to move for summary judgment first serve and file a proposed statement of uncontested facts, to be answered within three working days by the opponent—all before the motion conference.

## V. DEVELOPING A CASE MANAGEMENT CULTURE

The TTAB as a whole appears to be inclined toward passive case management. Most TTAB litigation is managed by the attorneys for the parties, conjuring images of inmates running an asylum. The Board, its members and its staff attorneys appear to see themselves more as referees than as managers. It also appears that most Board members and interlocutory attorneys today are career USPTO/Administrative law attorneys, very well-versed in trademarks, trademark law and Board procedure and practice, but reluctant to take command of the proceedings before them—unless sufficiently provoked.

It also appears that those whose lifelong career is not in the USPTO tend to stop there early, rather than late, in their careers.<sup>30</sup> Consequently, it does not appear that many members of the Board, or its interlocutory attorneys, have come from the careers in which they became seasoned litigators before either the Board or courts.

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28. See Murphy, 94 TMR at 808-09.

29. To take one example, if a motion to amend pleadings is contemplated and a conference is held Monday, a reasonable scenario would be: (1)(a) have prospective movant state the motion and grounds succinctly; (b) hear the opposition briefly; (c) canvas both sides for points of agreement and disagreement; (2) set a briefing schedule and page limits; (3) issue an order (served electronically) listing points of agreement and remaining issue(s) along with briefing schedule and page limits; (4) movant electronically files a three-page letter brief Wednesday; (5) opposing party electronically files a three-page opposition letter Friday; (6) movant electronically files a one-page reply the following Monday before noon; and (7) Board representative rules and serves electronic decision and order Thursday.

30. This assertion is based on observation over more than three decades. There certainly are exceptions, as there are to every generality.

In short, unlike trial judges, many of whom have practiced before the benches to which they ascended, the Board collectively appears to have rather little experience on the other side. If it is to solve the problem, it will have to address issues it is not well-equipped to tackle by experience. This will require resolve, and quite likely, training or consultation with the TTAB bar. To its credit, the Board has long sought and acted upon input from its “users.”

Conferences are not totally alien to Board practice. The Rules provide that “Whenever it appears . . . that a motion filed in an inter partes proceeding is of such nature that its resolution by correspondence is not practical, the Board may, upon its own initiative or upon request made by one or both parties, resolve the motion by telephone conference.”<sup>31</sup>

The existing practice has its limitations, however. It comes into play only after a motion is made; the process, on its face, does not countenance pre-motion conferences.<sup>32</sup> Anecdotal observation indicates that some Interlocutory Attorneys disfavor conferences. One Staff Attorney, in the course of deciding an accumulation of several pending motions in a written opinion, refused a request for supervision by conference on the ground that since more than a year’s worth of pending motions had been decided, there was no need for further supervision, and the case was clear to proceed on (its re-set) schedule. It took mere weeks for more motions to begin accumulating. Others, it has been complained, use the conference procedure to eliminate a full hearing of the parties’ positions and thus decide issues without benefit of argument.

Whatever the validity, or generalized applicability, of these observations, it can safely be concluded that: (1) there is no provision for, and there appear to be few if any, case management conferences at the outset of *inter partes* proceedings; (2) there may not be any consistency of approach or attitude by the Interlocutory Attorneys who do hold such conferences; and (3) there is no apparently overwhelming desire within the Board to institutionalize case management by conference.

However delay is to be addressed—if it is to be addressed at all—it will require a significant change in the Board and its approach to its job. The debate most likely will begin with whether the system is “broke” and could benefit from “fixing.” If it is concluded that change is in order—and this perception appears to be far more prevalent among the Board’s customers than the Board itself—serious consideration and planning will be required.

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31. Trademark Rule of Practice [37 C.F.R. § ] 2.120(a)(1).

32. The author has, however, seen an Interlocutory Attorney direct that all future requests for relief of a certain type (suspension of proceedings) be initiated by telephone call to that Attorney.

## VI. CHANGING THE WAY THE BOARD DECIDES CASES

Independent of any other changes, certain decisional practices should be re-examined. Assigning three Board Member panels to unscreened, potentially dispositive motions is one already mentioned. There are at least two others.

*First*, every Board decision appears to get the full three-Board member, full written decision treatment, yet the vast majority of those decisions is non-precedential.<sup>33</sup> What justifies such an expenditure of effort in research, review and summation of the record and writing decisions of no possible use to anyone except the parties? To be sure, the parties, and the Federal Circuit in event of appeal, deserve an explanation of why the case was decided the way it was, but something quite short of the effort put into a full-blown precedential opinion reviewed by a panel of three could and should accomplish that goal.

*Second*, there has long been a propensity for the Board to deal with every issue presented in every case, to summarize all of the evidence on each such issue and to summarize all arguments made as to each issue. If precedent were being made, that might be worthwhile, if frequently tedious. But most decisions are non-precedential. Courts long ago learned to decide what was necessary to a result, to state the reasons without necessarily recapitulating the applicable record and arguments on both sides in their entirety, and to give little or no attention to the rest.<sup>34</sup> Why can't the Board?

It appears that there can be a more efficient allocation of its decision-making resources by the Board. How much it would reduce average decision time is uncertain, but it should help.

## VII. CONCLUSION

Opposition and cancellation proceedings all too often place applications or registrations in limbo for a few years, which serves

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33. During calendar 2003, for example, fourteen precedential *inter partes* (and eleven *ex parte*) decisions were published; a total of sixteen Board Members sat on those cases (three per case). Author's study of vols. 65-68 of U.S.P.Q.2d. Occasional calls for more precedential decisions appear to have fallen on deaf ears. That the Board is producing such a dearth of citable authority each year might be a problem, but it is not the one addressed here.

34. It is possible that ignoring issues that seem unnecessary to the result will result in an occasional remand when the issue the Board thinks is decisive is ruled wrongly decided. It happens to trial courts. It also happens that appellate courts remand for reconsideration of the issue thought to be determinative below. The energy expended in attempting to make every decision "remand-proof" likely far exceeds the energy required to deal with the occasional remand that (perhaps) could have been averted by a more comprehensive opinion.

neither the public interest nor, normally, the applicant's or registrant's. The delay appears to be attributable in large part to existing USPTO practices, particularly the motion practice which (i) often is more dilatory than necessary for the motion in question, and (ii) is almost always available to any litigant who wants to make a motion. The problem can be attributed to the lawyers and their clients, but neither lawyer nor client should be expected to sacrifice the client's interest to the public interest.

One solution to the problem lies in case management of the proceedings—a practice the Board thus far has shown only halting signs of adopting. Several suggestions for implementing sound case management practices have been made, and certain other suggestions to make TTAB litigation more efficient have been advanced.

The purpose of this comment is not to dictate a solution, but rather to encourage a joint search for solutions by the Board and its users. The suggestions made here are not necessary components of any solution to the problem, although they seem to the author to be both reasonable and likely to reduce delay significantly.

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