

January 19, 2016

Daniel E. O'Toole, Esq.
Circuit Executive & Clerk of Court
U.S. Court of Appeals for the Federal Circuit
717 Madison Place, N.W.
Washington, D.C. 20439

Via email: chiefdeputyclerk@cafc.uscourts.gov

Re: AIPLA Comments on Proposed Changes to the Rules of Practice of the U.S. Court of Appeals for the Federal Circuit

Dear Admiral O'Toole:

The American Intellectual Property Law Association (“AIPLA”) appreciates the opportunity to comment on recently proposed changes to the Rules of Practice for the U.S. Court of Appeals for the Federal Circuit. These comments are submitted at this time pursuant to the invitation for public comment posted on the Court’s website, and pursuant to an extension of the filing deadline communicated to AIPLA by email from General Counsel for the Court J. Douglas Steere.

AIPLA is a national bar association of approximately 14,000 members who are primarily lawyers engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public’s interest in healthy competition, reasonable costs, and basic fairness.

After reviewing proposed changes to the Court’s Rules of Practice, AIPLA offers the following comments on a selection of the published revisions.

Rule 15

Rule 15, entitled “Review of an Agency Order–How Obtained,” as amended at Rule 15(a)(1) sets out the process for appealing decisions of the Patent Trial and Appeal Board, the Trademark Trial and Appeal Board, and the Director of the U.S. Patent and Trademark Office. One of the revisions would change the number of copies of the notice of appeal to be filed with the Court from “three” to “one.” However, Rule 25(b) only permits the filing of paper case-initiating documents by pro se parties.

If the proposed amendment to Rule 15 contemplates the submission of a paper copy, it arguably conflicts with the requirement of proposed Rule 25(b)(1) that non-pro se parties use CM/ECF for case-opening documents. AIPLA suggests the following replacement for the second sentence of Rule 15(a)(1):

“Notwithstanding Rule 25(b)(1), the appellant must simultaneously send to the clerk of court one paper copy of the notice and pay the fee set forth in Federal Circuit Rule 52.”

Rules 27(m) and 28(d)

Rules 27(m) and 28(d) set out the requirements for motions and briefs that contain material subject to a protective order. The proposed revisions would create a new Rule 27(m)(1) and a new Rule 28(d)(1) to spell out the requirements for marking material as confidential. Specifically, both provisions would limit the information marked as confidential to 15 words, absent a motion that justifies exceeding that limit. According to the proposed revisions, motions to exceed the limit must establish “that the additional confidentiality markings are appropriate and necessary pursuant to a statute, administrative regulation, or court rule.”

AIPLA believes that the proposed limit of 15 words that may be marked as confidential is too low. That number represents barely 0.1 percent of a 15,000-word brief. AIPLA is concerned that 15 words may be insufficient to preserve confidentiality in the majority of cases that have confidential material at issue, may cause numerous disputes between parties who believe that additional material must be maintained as confidential, and may increase motions practice before the Court. Thus, while we appreciate the public nature of appeals and hearings before the Court, we believe that this revision is too restrictive to adequately protect the confidential business information of parties to the action and of third parties.

AIPLA recommends that the proposed word limit on marking material as confidential be increased. We believe that a higher limit will allow the majority of briefs with confidentiality issues to be filed without additional motion practice. In any event, AIPLA urges that motions to exceed the word limit be granted “for good cause shown,” and that this phrase (shown below with emphasis) be added to the end of the fifth sentence of Rules 27(m)(1) and 28(d)(1) as follows:

“A party seeking to mark confidential more than fifteen words must file a motion with this court establishing that the additional confidentiality markings are appropriate and necessary pursuant to a statute, administrative regulation, or court rule **for good cause shown.**”

With the addition of the new Rules 27(m)(1) and 28(d)(1), the successive subparagraphs are renumbered, such that the current Rules 27(m)(2) and 28(d)(2) are renumbered as 27(m)(3) and 28(d)(3). Those two provisions, entitled “Service,” currently spell out the requirements for serving paper copies of confidential and nonconfidential material. They are revised to eliminate the paper copy service requirements for nonconfidential motion papers and briefs, requiring paper copy service only confidential motion papers and briefs.

In order to ensure that every party receives the same copy of each brief that the Court receives, AIPLA recommends that revised Rules 27(m)(3) and 28(d)(3) require a single paper copy of the motion papers and briefs submitted to the Court also be served simultaneously on opposing counsel. This would involve minimal additional cost since the printed brief must already be prepared for the Court, and would ensure that opposing counsel and the Court have the exact same copy. It would also avoid the risk that, due to technical or printing issues, opposing counsel and the Court receive different versions of the same brief.

Rule 29

Rule 29, entitled “Brief of an Amicus Curiae,” includes a proposed revision of paragraph (a) to require that amicus curiae submit six paper copies of its brief within five business days of the acceptance of the electronic version of its brief. The revision includes the introductory phrase “After the court grants a motion for leave to file the brief.”

AIPLA believes the revision’s reference to a motion for leave to file is confusing since that requirement is frequently waived when the Court invites amicus briefing, as often occurs in *en banc* cases. Moreover, we believe it is unnecessary since the timing for filing the required six paper copies of the brief is triggered by the clerk’s acceptance of the electronic brief, which will not take place absent some evidence of permission to file.

AIPLA suggests the following replacement for the second sentence of Rule 29:

“Amicus curiae must file six paper copies of its brief within five business days of the clerk of court’s acceptance of the electronic version of its brief.”

Rule 30(a)(7)

Rule 30(a)(7), as revised, would delete the requirement to serve two copies of the appendix on counsel for each separately represented party, would require service of a paper copy of the appendix on each pro se party, and would make service of an appendix via CM/ECF sufficient for all parties represented by counsel.

AIPLA believes the proposed rule, as worded, might cause confusion if confidential material is in the appendix. Though Rule 30(h)(3) covers confidential versions of the appendix, the general rule may cause confusion unless it includes the word “nonconfidential” or references Rule 30(a)(7).

AIPLA recommends the following replacement sentence as a substitute for the second sentence of Rule 30(a)(7):

“In a case in which all parties are represented by counsel, service of non-confidential material is made through CM/ECF and no paper copies are required to be served to the parties.”

AIPLA Proposal on Designations of Confidentiality

The proposed changes to provisions on removing designations of confidentiality (Rules 11(c), 17(e), and 30(h)) do not provide the designating party or a third party seeking to maintain information as confidential the opportunity to consent or object to the disclosure of their information.

AIPLA recommends that the rules include a simple mechanism for curing inadvertent or unauthorized release of confidential information. In particular, the rules might provide for motions to redact/seal confidential information filed within a reasonable time (perhaps 3 days) by or on behalf of the party whose designated information has been disclosed. Under the revised rules, there appears to be no “claw back” remedy for “inadvertent” or unauthorized release of protected information by the designating party other than seeking relief from the originating tribunal to request sanctions due to a violation of the protective order. Such a remedy is inadequate because it does not remove the information from this Court’s public docket or provide a mechanism to otherwise maintain the information as confidential.

AIPLA is grateful for the opportunity to comment on the proposed revisions to the Court’s Rules of Practice, and for the Court’s consideration of the suggestions submitted. We remain available for any further assistance we can provide.

Respectfully submitted,

A handwritten signature in blue ink that reads "Denise W. DeFranco". The signature is written in a cursive style.

Denise W. DeFranco
President
American Intellectual Property Law Association