



## American Intellectual Property Law Association

October 3, 2022

Proposed Rules Comments 2022  
Clerk's Office  
U.S. Court of Appeals for the Federal Circuit  
717 Madison Place, N.W.  
Washington, D.C. 20439  
Via email: [FederalCircuitRules@cafc.uscourts.gov](mailto:FederalCircuitRules@cafc.uscourts.gov)

**Re: AIPLA Comments on 2022 Proposed Changes to the Rules of Practice of the  
U.S. Court of Appeals for the Federal Circuit**

Dear Col. Marksteiner:

The American Intellectual Property Law Association ("AIPLA") appreciates the opportunity to comment on the September 2, 2022, proposed changes to the Rules of Practice for the U.S. Court of Appeals for the Federal Circuit. AIPLA's comments are submitted at this time pursuant to the invitation for public comment posted on the Court's website.

Founded in 1897, AIPLA is a national bar association constituted primarily of practitioners in private and corporate practice, in government service, and in the academic community. AIPLA represents a wide and diverse spectrum of individuals from law firms, companies, and institutions involved directly and 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.

AIPLA was formed to maintain a high standard of professional ethics, to aid in the improvement in laws relating to intellectual property and in their proper interpretation by the courts, and to provide legal education to the public and to its members on intellectual property issues.

**Addendum Requirements under Rules 28 and 30**

Proposed Federal Circuit Rule 28(c)(1)(B) would require that, "if the appeal involves a patent or patent application, [the Addendum to the Principal Brief shall include] all patents or applications at issue on appeal reproduced in their entirety." Proposed Federal Circuit Rule 30(a)(1)(A)(iii) would require the same content in the appendix.

The "at issue" language is ambiguous in that it could be interpreted narrowly, to reference only the patent or application that is the subject of the controversy on appeal, or broadly, to reference any patent or application referenced in the appeal, including prior art.

AIPLA recommends clarifying whether “at issue” refers to a patent or patent application that is the subject of an appeal, cited prior art, or both. We suggest that it be limited to the subject of an appeal. Parties would need to include relied on prior art in the appendix, but may not know when filing the principal brief what art is at issue for an appeal. Prior art may include both patent and non-patent literature, and limiting prior art in the addendum to patent literature may be too limiting. By contrast, expanding the addendum to include non-patent literature could become unwieldy. Thus, we recommend further clarifying that “at issue” for Rules 28 and 30 refers to patents or patent applications that are the subject of the appeal, and that relied on prior art should be included in the appendix, but not the addendum.

### **Service of Paper Copies**

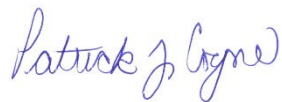
While not specifically addressed in the proposed rule changes, we recommend updating Rule 31(b) regarding the number of paper copies provided to opposing counsel. We encourage a clarification stating that one paper copy should be provided to opposing counsel. Under the current rules, parties file paper copies with the Court only and are not required to serve a paper copy on the other side. However, at oral argument, the Court expects the parties to have printed copies of the briefs and appendices accessible. To ensure that all parties and the Court have access to the same materials, it would be helpful to require that the responsible party provide one paper copy of the briefs and appendices to the other side.

### **Scheduling Conflicts**

While we do not object to the Court delegating its authority to impose limitations on scheduling conflicts to the Clerk of Court, we suggest that the Court provide guidance to the Clerk’s office on what may be acceptable “good cause.” At present, the Court limits scheduling conflicts to 10 days over a 6-month period. The Court generally considers vacations to constitute “good cause,” but routinely denies scheduling conflicts due to bar association-related conflicts. We ask that the Court and the Clerk’s office consider bar association conflicts for volunteers appointed to association leadership positions in particular. While we appreciate rejecting conflicts for persons attending associations meetings to collect routine CLE credits, we ask that the required attendance for an association’s volunteer leadership ranks be given weight when accessing oral argument conflicts.

Thank you for the opportunity to provide these comments. AIPLA would gladly discuss our views on these issues in further detail if desired.

Sincerely,



Patrick J. Coyne  
President  
American Intellectual Property Law Association