

PUBLICATION UPDATE

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Court of Appeals for the Federal Circuit: Practice & Procedure

Publication 261

Release 49

December 2020

HIGHLIGHTS

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- The following units in **Court of Appeals for the Federal Circuit: Practice and Procedure** have been revised during Release 49:

VOLUME 1

- **CHAPTER 1** Introduction to the Federal Circuit
- **CHAPTER 2** Procedures in the Patent and Trademark Office
- **CHAPTER 3** Preliminary Procedure in the Federal Circuit
- **CHAPTER 4** Briefs
- **CHAPTER 5** Oral Argument and Submission on Briefs
- **CHAPTER 6** Decision

- **CHAPTER 8** Motions Practice

VOLUME 2

- **CHAPTER 9** Petitions for Extraordinary Writs
- **CHAPTER 10** Miscellaneous Matters
- **CHAPTER 11** Appeals from District Courts
- **CHAPTER 12** Appeals from the International Trade Commission
- **APPENDIX A** Rules of Practice United States Court of Appeals for the Federal Circuit
- **APPENDIX A3** United States Court of Appeals for the Federal Circuit Rules for Judicial Conduct and Judicial Disability Proceedings
- **APPENDIX H** 2020 Sum-

Revisions and Analysis added to the Publication.

Release 49 features analysis and discussion including:

Special Update: Notice Regarding Rule Changes

Effective July 1, 2020, the Federal Circuit adopted amendments to the Federal Circuit Rules of Practice. The revised rules apply to all appeals filed or pending on or after July 1, 2020, to the extent practicable, unless otherwise ordered. The revised rules are available in Appendix A. A summary of the revisions provided by the clerk's office is available in Appendix H.

Volume 1, Chapter 2: § 2.01[b] Appeals to the Federal Circuit from Final Written Decisions of the PTAB in Post-Grant Review, Covered Business Method Review, Inter Partes Review, and Derivation Proceedings

• The Supreme Court held that 35 U.S.C. § 314(d) precludes judicial review of the Board's decision whether to institute inter partes review based on application of § 315(b)'s time bar. *See Thryv, Inc. v. Click-To-Call Techs., LP*, 140 S. Ct. 1367 (2020). The Supreme Court held that the Board's application of § 315(b)'s time limit is closely related to its decision whether to institute inter partes review and is therefore rendered nonappealable by § 314(d).

• The Supreme Court's decision in *Thryv v. Click-To-Call* overruled the Federal Circuit's decision in *Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364, 125 U.S.P.Q.2d 1269 (Fed. Cir. 2018) (en banc) holding that, in an appeal of a final written decision of the Board, judicial review is available for a patent owner to challenge the Board's determination that the petitioner satisfied the timeliness requirement of 35 U.S.C. § 315(b) governing the filing of petitions for inter partes review. The Supreme Court's decision in *Thryv v. Click-To-Call* also calls into question other Federal Circuit holdings relying on similar logic to *Wi-Fi One v. Broadcom*. This includes the Federal Circuit's holding that it has jurisdiction to review the Board's determination of whether assignor estoppel bars a party under 35 U.S.C. § 311(a) from filing a petition for inter partes review. *See Arista Networks, Inc. v. Cisco Sys.*, 908 F.3d 792, 128 U.S.P.Q.2d 1497 (Fed. Cir. 2018) holding that "whether Section 311(a) contemplates application of assignor estoppel is not closely related to the preliminary patentability determination or the exercise of discretion not to institute" but finding assignor estoppel to be inapplicable in inter partes review proceedings (quotation omitted)).

• Also called into question is the Federal Circuit's holding that 35 U.S.C. § 315(c) does not authorize same-party joinder or the joinder of new issues. *See Facebook, Inc. v. Windy City Innovations, LLC*, 953 F.3d 1313, 1324-25 (Fed. Cir. 2020)

“The plain language of § 315(c) indicates that the exception to the time bar offered by the joinder provision only applies if there is an instituted IPR, meaning that a first petition must have been timely under § 315(b), among other requirements.”.

- Note that the Federal Circuit applied its now-overruled *Wi-Fi One* en banc decision in a number of cases—the holdings of which are all called into question by the Supreme Court’s decision in *Thryv v. Click-To-Call*.

Volume 1, Chapter 3: § 3.06 Content of the Record and the Appendix

- Parties must compile a designation of material for the appendix no later than 45 days prior to the deadline for the appellant’s principal brief (Fed. Cir. R. 30(b)). If the parties cannot agree within this timeframe, the appellant must serve its designation on the appellee along with a statement of the issues no later than 30 days prior to the deadline for the appellant’s principal brief (Fed. Cir. R. 30(b)).

- Parties must include in the appendix sufficient surrounding record and transcript pages to provide context for a cited excerpt, as well as the transcript cover page identifying participating counsel if it is included in the record (Fed. Cir. R. 30(a)(1)(B)).

- An individual appendix volume should be limited to 400 printed sheets of paper (equating to 800

pages if filed electronically) (Fed. Cir. R. 30(a)(4)).

Volume 1, Chapter 3: § 3.10 Filing of Papers in Court

- Note that Federal Circuit Rule 25 requires electronic filing of documents and authorizes electronic service of documents, with certain limited exceptions. *See* § 3.10 Filing of Papers in Court. Filing of a document electronically constitutes service at the time of filing to a user’s email address registered with the court’s electronic filing system. Thus, no certificate of service is required for documents filed electronically if all parties are represented by counsel registered with the court’s electronic filing system (Fed. Cir. R. 25(e)(1)). Note that three additional days are not added to the time to file a responsive document when the proponent’s service is through the electronic filing system because such service by email is considered to be delivered when transmitted (Fed. Cir. R. 26(c)).

- Confidential documents cannot be served electronically (Fed. Cir. R. 25(e)(3)). Such documents may be served by hand delivery, mail, commercial carrier, or email with consent in writing (FRAP 25(c)). A certificate of service is required for confidential filings (FRAP 25(d)).

- The Federal Circuit rule permitting filing of corresponding briefs on CD-ROM has been eliminated.

- Federal Circuit Rule 25(g) specifies the requirements for an electronic signature for electronically filed documents. Of note, the Clerk of Court will only accept a document

with an electronic signature when the name of the electronic signer matches the name on the account used to file the document. If multiple signatures are present on a document, the document must meet the requirements set forth in Federal Circuit Rule 32(g)(3).

Volume 1, Chapter 4: § 4.01 Briefs Generally

- Federal Circuit Rule 28(a)(12)(B) requires that “the language of a patent claim at issue” must appear on the inside of the front cover of each principal brief (or immediately following the front cover if the language requires more space) and that this language does not count toward the word limit provided the same language is included in the brief.

- In cases involving cross-appeals, counsel are advised that in the third brief the reply argument on the appeal issues should not exceed the length that would be permitted if there were no cross-appeal and the fourth brief must be limited to the issued presented by the cross-appeal (Practice Note to Fed. Cir. R 28.1). Moreover, the court has advised that in all cases, counsel should be prepared to defend at oral argument the filing of a cross-appeal and the propriety of arguments presented in the fourth brief (Practice Note to Fed. Cir. R 28.1).

- If a party seeks to raise new authority at argument that was not previously submitted to the court should provide a copy of the new authority to the opposing party in advance of argument by email or, if

time permits, by filing a citation of supplemental authority pursuant to Federal Rule of Appellate Procedure 28(j) (Practice Notes to Fed. Cir. R 34).

Volume 1, Chapter 5: § 5.01 Date, Location, Length of Hearing, and Composition of Panel

- Absent leave of court (requested at least 7 days prior to argument), no more than two counsel may argue on behalf of each side and no more than one counsel may argue on behalf of each party (Fed. Cir. R 34(e)(2)).

Volume 1, Chapter 6: § 6.01 Opinion, Decision, Judgment, and Mandate

- Pursuant to Federal Circuit Rule 32.1, there is no longer a prohibition or restriction on citing nonprecedential dispositions.

Volume 2, Chapter 8: § 8.01 Introduction

- Effective July 1, 2020, new Federal Circuit Rule 25.1 consolidates all confidentiality rules into a single rule. In most cases, the rule imposes a limit of 15 unique words for the marking of confidential material in briefs and motions absent motion with required justification. Federal Circuit Rule 25.1(e)(2) requires the filing party to submit a certificate of compliance with confidentiality requirements. Counsel should be prepared to justify at oral argument any claim of confidentiality (Practice Note to Federal Circuit Rule 25.1).

- Federal Circuit Rule 26(b)(4) provides that “[a]t any time before the expiration of a filing deadline, the

filer may notify the court that additional time is needed to resolve confidentiality issues, and the court will provide a one-time per document extension of five (5) days to file the document.” The rule requires that the notice include an affidavit or unsworn declaration of counsel or an unrepresented party under penalty of perjury under 28 U.S.C. § 1746 certifying

that additional time is needed to resolve confidentiality issues. Under Federal Circuit Rule 26(b)(4), any additional requests for extension to resolve confidentiality issues are by leave of court.

- Pursuant to Federal Circuit Rule 31(c), certain motions suspend the briefing schedule.

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Publication 261 Release 49

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